

A LEGAL SCHOLARSHIP

JUBILEE

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JUBILEE

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Plagiarize This Press

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FOREWORD

On September 11, 2020, an informal meeting was held in the Benevolent Dictator's mind, for the purpose of considering the question of establishing a law journal to be published by the students of the tradition of Humankind. The result was a unanimous resolution to form an association which should undertake the issuing of a law journal, and to that end to invite the co-operation of time and attention span. That same day, a permanent subdivision of Plagiarize This Press, with an editorial board and business management as indicated above, was effected.

This first number of A LEGAL SCHOLARSHIP JUBILEE appears at a time when there is a marked legal renaissance throughout the world. The vast processes of social, economic, and political change caused by Everything have led to the adaptation of old law and the creation of new law: and those processes of evolution are still in progress. The law has, in truth, its epochs of ebb and flow; and the full flow of the law is impelled by the dominant movements of society. These dominant social tendencies not only force the growth of the law, they force also, as a consequence, the growth of legal studies.

In this spirit, this humble effort begs to introduce itself to an indulgent public. The editorial work is entirely in the hands of someone who has never been a law student, one who has had no previous experience with work of this character. It is hoped that the crudities of this first effort in the line of published comment on the work of the courts may be less glaring in the future numbers when the editor has become more experienced.

THE FORTAS FILM FESTIVAL AND THE DIALECTIC OF OBSCENITY

Whitney Strub*

The story of Jack Smith's film Flaming Creatures and the "Fortas Film Festival" illustrates the dialectic of obscenity. The obscenity doctrine expresses the conventional wisdom that the First Amendment actually protects art, and protects pornography only by extension. But Flaming Creatures and the Fortas Film Festival suggest that obscenity is dialectical. The obscenity doctrine provides the thesis: art protects pornography, by justifying the protection of sexual expression. Flaming Creatures and the Fortas Film Festival provide the antithesis: pornography protects art, by normalizing sexual expression. The history of obscenity law provides the synthesis: art and pornography protect each other. In other words, art transgresses and pornography reifies.

I. INTRODUCTION

Obscenity is like a Cheshire cat. Over the years, it gradually disappeared, until nothing remained but a grin. Until the 1960s, pornography was obscene, and obscenity prosecutions were relatively common. And until the 1970s, obscenity prosecutions targeted art, as well as pornography. But today, obscenity prosecutions are rare and limited to the most extreme forms of pornography.

So why did obscenity largely disappear? The conventional history of obscenity is doctrinal, holding that the Supreme Court's redefinition of obscenity in order to protect art inevitably required the protection of pornography as well. In other words, art and literature were the vanguard of pornography.

But the conventional history of obscenity is incomplete. While it accounts for the development of obscenity doctrine, it cannot account for "pornography's convoluted dialectic with American history." As Michel Foucault observed, the repression of sexuality produces discourses on sexuality. Accordingly, the history of obscenity

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must account for both regulation and demand. Censorship created pornography by distinguishing it from art and produced a dialectic of obscenity.

The story of *Flaming Creatures* and the so-called "Fortas Film Festival" illustrates the dialectic of obscenity. When President Johnson nominated Justice Fortas to replace Chief Justice Warren in 1968, Fortas's opponents investigated his record, hoping to justify a filibuster. Among other things, they discovered *Jacobs v. New York*, in which Fortas alone voted to reverse obscenity convictions for showing *Flaming Creatures*, an obscure art film that featured a transvestite orgy. Senator Thurmond showed *Flaming Creatures* to several senators, convinced them to join the filibuster, and blocked the Fortas nomination.

Under the dialectic of obscenity, art protected pornography, and pornography protected art. Doctrinally, the protection of art required the protection of pornography. But politically, the protection of art required the protection of pornography. Art and pornography are social categories. When the Supreme Court tried to protect art, but not pornography, it failed to recognize that those categories were in flux. Art became subversive as pornography became mainstream. As a result, many people were more offended by some of the art the Court protected than the pornography it did not, and the Court found its obscenity cases increasingly difficult to justify. Eventually, it realized that only the protection of pornography could justify the protection of art.

This article uses *Flaming Creatures* and the Fortas Film Festival to explain the dialectic of obscenity. Part I provides a historical overview of the obscenity doctrine. Part II describes the making and presentation of *Flaming Creatures*. Part III chronicles the proceedings in *Jacobs v. New York*. Part IV follows the Fortas nomination. Part V shows how the Fortas Film Festival illustrates the dialectic of obscenity.

II. A BRIEF HISTORY OF OBSCENITY

A. What is Obscenity?

Obscenity is a category of speech that is not entitled to First Amendment protection because of its sexual content. However, while the category of obscenity still exists, the definition of obscenity has narrowed over time. Originally, the common law defined obscenity as any expression that tends "to deprave and corrupt those whose minds are open to such immoral influences." In other words, under the common law, obscene meant inappropriate for children.

The common law obscenity test was generally understood to prohibit the depiction or description of sex, without exception for works of art and literature. Accordingly, it permitted the suppression of works like Edmund Wilson's *Memoirs of Hecate County* and James Joyce's *Ulysses*. Embarrassed by the philistinism of the common law obscenity test, the Court finally reformed the obscenity doctrine in *Roth v. United States*, holding that an expression is obscene only if "to the average person, applying contemporary community standards, the dominant theme of the material taken as a whole appeals to prurient interest." Justice Brennan's plurality opinion added that an expression is obscene only if it is "utterly without redeeming social importance." Essentially, Roth held that the First Amendment protects art, but not pornography.

But the Court soon discovered that distinguishing art and pornography is difficult, as both are in the eye of the beholder. As Justice Stewart famously remarked, "I know it when I see it." Accordingly, the justices were obliged to review each smutty book and dirty movie. Justices Black and Douglas refused to participate, concluding that the First Amendment protects all sexual expressions.

B. The Rise & Fall of the Pandering Test

The Court was in a quandary. Under the Roth test, in order to identify obscenity, it had to be able to distinguish art from pornography. Fortas convinced the Court that it could solve the problem by adopting the pandering test, which imposed a scienter requirement on obscenity.

The pandering test was based on Chief Justice Warren's concurring opinion in Roth, which held that an expression is obscene if its purveyor is "plainly engaged in the commercial exploitation of the morbid and shameful craving for materials with prurient effect." Under the pandering test, if "the purveyor's sole emphasis is on the sexually provocative aspects of his publications, that fact may be decisive in the determination of obscenity." Essentially, the pandering test assumes that anything sold as pornography is obscene and anything sold as art is not.

The Court adopted the pandering test in a pair of cases: *Ginzberg v. United States* and *Memoirs v. Massachusetts*. In *Ginzberg*, the Court affirmed obscenity findings for *Eros* magazine; *Liaison* magazine; and *The Housewife's Handbook on Selective Promiscuity*, erotic publications distributed by Ralph Ginzburg by mail order from Middlesex, Pennsylvania, because "each of these publications was created or exploited entirely on the basis of its appeal to prurient interests." By contrast, in *Memoirs*, it reversed an obscenity finding for John Cleland's *Fanny Hill, or Memoirs*

of a Woman of Pleasure, an eighteenth-century erotic novel published by G.P. Putnam's Sons, because "the mere risk that the book might be exploited by panderers because it so pervasively treats sexual matters cannot alter the fact . . . that the book will have redeeming social importance in the hands of those who publish or distribute it on the basis of that value." In other words, Ginzberg's publications were sold as pornography and *Fanny Hill* was not.

Initially, the Court voted to affirm both Ginzburg and Memoirs. Fortas was horrified by the prospect of banning *Fanny Hill* and used the pandering doctrine to convince Brennan to change his vote in *Memoirs*:

> I was alarmed by Brennan's vote at Conference to affirm the ban on Fanny Hill. So contrary to my principles, I went to work, suggested the 'pandering' formula to Bill (which I think is as good as any for this cess-pool problem) and came out against Ginzburg.—I guess that subconsciously I was affected by G's slimy qualities—but if I had it to do over again, I'd reverse at least as to all except his publication of 'Liaison.' Well, live and learn.

Later, Fortas insisted that *Memoirs* and Ginzburg "wouldn't have happened without me. I worked every one of those guys over."

However, Fortas supported the pandering test only because he worried that the Court would permit the suppression of art. In theory, he rejected the obscenity doctrine, but he knew that public opinion insisted on suppressing obscenity. He accused Black and Douglas of "whoring after principle." In any case, the pandering test never caught on. In 1966, the Court held a slew of obscenity cases, including Jacobs, pending its decision in *Redrup v. New York*. The Court voted to reverse in *Redrup* and assigned the opinion to Fortas, who circulated draft opinions reversing on the basis of the pandering test. But the Court ultimately rejected Fortas's draft and decided *Redrup* on the facts in a per curiam opinion. After *Redrup*, the Court disposed of the rest of its obscenity cases in the same way, including Jacobs. And for several years, the Court continued to decide obscenity cases on the facts in per curiam opinions.

C. The Miller Test

The Court finally revisited the obscenity doctrine in 1973, holding in *Miller v. California* that "prurient" and "patently offensive" material is obscene if "the work, taken as a whole, lacks serious literary, artistic, political, or scientific value." In *Paris Adult Theater I v. Slaton*, decided the same day as *Miller*, the Court also held

that the First Amendment does not protect the public exhibition of obscenity to consenting adults, explaining, “The States have a long-recognized legitimate interest in regulating the use of obscene material in local commerce and in all places of public accommodation, as long as these regulations do not run afoul of specific constitutional prohibitions.” In theory, *Miller* provided a more objective definition of obscenity.

Gradually, the Court refined the *Miller* standard. For example, in *Smith v. United States*, it held that the value test “is particularly amenable to appellate review.” And in *Pope v. Illinois*, it held that the value test is objective, not subjective. In addition, the Court tried to make the value element of the obscenity test an objective, affirmative defense.

More importantly, the Court recognized that the First Amendment does not protect certain categories of sexual expression, other than obscenity. Specifically, it held in *New York v. Ferber* that the “test for child pornography is separate from the obscenity standard enunciated in *Miller*.” However, *Miller* remains the governing standard with respect to sexual expression other than child pornography.

D. The Aftermath of Miller

After Miller, obscenity prosecutions gradually slowed to a trickle. Through the 1970s and ‘80s, the government aggressively prosecuted pornography. But it generally ignored art, and obscenity prosecutions of art were rarely successful. For example, when Ohio prosecutors pursued obscenity charges against a Cincinnati museum for showing photographs by the artist Robert Mapplethorpe—including five photographs of men in sadomasochistic poses and two images of naked children with exposed genitals—the jury returned a verdict of not guilty. For artists, the issue was no longer obscenity prosecutions, but rather the availability of federal grants.

Under President Clinton, the Department of Justice decided to stop pursuing obscenity and focus on child pornography. As a result, federal prosecutors pursued less than 200 obscenity cases. Under President George W. Bush, the Department of Justice changed its priorities and began pursuing obscenity as well as child pornography. However, it achieved only limited success, pursuing obscenity prosecutions. Under President Obama, the Department of Justice de-emphasized adult obscenity and prosecutions returned to Clinton-era levels. Today, pornography is ubiquitous and essentially legal.

III. *Flaming Creatures*

> The only thing to be regretted about the close-up of limp penises and bouncing breasts, the shots of masturbation and oral sexuality, in Jack Smith's *Flaming Creatures* is that it makes it hard simply to talk about this remarkable and beautiful film, one has to *defend* it.

By any measure, Jack Smith's *Flaming Creatures* is an unusual film. A 43-minute featurette, the film is a pastiche of campy costume melodramas. It consists of a series of tableaux, several of which include garishly dressed men and women with exposed genitalia engaging in a pantomime of sexual activity. Susan Sontag, an early champion of *Flaming Creatures*, offered the following description of the film:

> For the record: in *Flaming Creatures*, a couple of women and a much larger number of men, most of them clad in flamboyant thrift-shop women's clothes, frolic about, pose and posture, dance with one another, enact various scenes of voluptuousness, sexual frenzy, romantic love and vampirism—to the accompaniment of a sound track which includes some pop Latin favorites (Siboney, Amapola), some rock-'n-roll, some scratchy violin playing, bullfight music, a Chinese song, the text of a wacky ad for a new brand of "heart-shaped lipstick" being demonstrated on the screen by a host of men, some in drag and some not; and the chorale of flutey shrieks and screams which accompany the group rape of a bosomy young woman, rape happily converting itself into an orgy.

By contrast, Smith considered *Flaming Creatures* a comedy. "I started making a comedy about everything that I thought was funny. And it was funny. The first audiences were laughing from the beginning all the way through. But then that writing started – and it became a sex thing."

Today, *Flaming Creatures* is generally considered an artistic masterpiece. It strongly influenced many contemporary artists, including Andy Warhol and John Waters. It is the subject of many books and articles. And it regularly shows at art museums and in college classrooms.

But in the 1960s, *Flaming Creatures* was quite polarizing. While many artists and intellectuals championed the film, most people abhorred it. One film critic described *Flaming Creatures* as "a faggoty stag-reel." And a senator who saw the film exclaimed, "That film was so sick, I couldn't even get aroused." *Flaming Creatures* was weird and queer and made people uncomfortable.

A. The Making of Flaming Creatures

Jack Smith made *Flaming Creatures* during the late summer and early fall of 1962. He stole expired film from the bargain bin at Camera Barn, constructed a ramshackle set on the roof of the Windsor Theatre, and recruited a cast of friends and acquaintances. Smith filmed *Flaming Creatures* himself, often perched on a makeshift catwalk. The performers were often intoxicated and in various states of dishabille. Smith finished filming in October and spent several months editing. Musician and filmmaker Tony Conrad created the soundtrack, a collage of records from Smith's collection. Apparently, the total cost of *Flaming Creatures* was about $300.

B. The Introduction of *Flaming Creatures*

During the winter of 1963, Smith showed versions of *Flaming Creatures* to his friends. He first presented it to the public on March 9, 1963, at a benefit hosted by Piero Heliczer at Jerry Jofen's loft on West 20th Street. Jonas Mekas, the doyen of avant-garde cinema, attended the benefit and lavishly praised *Flaming Creatures* in his influential *Village Voice* column, *Movie Journal*:

> Jack Smith just finished a great movie, *Flaming Creatures*, which is so beautiful that I feel ashamed even to sit through the current Hollywood and European movies. I saw it privately, and there is little hope that Smith's movie will ever reach the movie theatre screens. But I tell you, it is a most luxurious outpouring of imagination, of imagery, of poetry, of movie artistry—comparable only to the work of the greatest, like Von Sternberg.

Mekas soon proved himself wrong. On April 29, 1963, he premiered *Flaming Creatures* in his Underground Midnights series at the Bleecker Street Cinema, on a double bill with Blonde Cobra, a film by Ken Jacobs that starred Jack Smith, Jerry Sims, and Bob Fleischner. The Bleecker immediately cancelled Underground Midnights, ostensibly because it thought that the "low quality of the underground" would ruin its reputation.

In fact, the Bleecker was worried about the police. New York law prohibited the public exhibition of unlicensed films, and *Flaming Creatures* was unlicensed in spades. The Motion Picture Division of the New York State Education Department examined films submitted for review and issued a license, unless the film was "obscene, indecent, immoral, inhuman, sacrilegious, or is of such a character that its exhibition would tend to corrupt morals or incite to crime." Needless to say, the

Motion Picture Division would not have licensed *Flaming Creatures*, if anyone had dared to ask.

Mekas excoriated the Bleecker for cancelling Underground Midnights, dubbed *Flaming Creatures* the exemplar of "Baudelairean cinema," and founded the Filmmakers' Showcase, a weekly film series at the Gramercy Arts Theater. The Filmmakers' Showcase attempted to avoid the license requirement by purporting to present private screenings. Rather than charge admission, Mekas cheekily requested donations to the "Love and Kisses to Censors Film Society."

The Filmmakers' Showcase surreptitiously showed *Flaming Creatures* twice in August 1963. Advertisements in the *Village Voice* cryptically announced "a film praised by Allen Ginsberg, Andy Warhol, Jean-Luc Godard, Diane Di Prima, Peter Beard, John Fles, Walter Gutman, Gregory Corso, Ron Rice, Storm De Hirsch, and everybody else." Mekas and Jacobs also presented an impromptu midnight screening of *Flaming Creatures* and *Blonde Cobra*—"two pieces of the impure, naughty, and 'uncinematic' cinema that is being made now in New York"—at the annual Flaherty Seminar in Brattleboro, Vermont.

While Mekas championed *Flaming Creatures*, others dismissed it as trash. For example, when film critic Arthur Knight saw *Flaming Creatures* in Los Angeles, he was appalled. "A faggoty stag-reel, it comes as close to hardcore pornography as anything ever presented in a theater . . . Everything is shown in sickening detail, defiling at once both sex and cinema."

In the meantime, Smith started a new film, titled Normal Love. Andy Warhol admired *Flaming Creatures* and arranged for Smith to film Normal Love at a house in Old Lyme, Connecticut. Warhol also filmed the production of Normal Love and made a little newsreel that he titled Jack Smith Filming Normal Love.

In December 1963, Mekas's magazine Film Culture gave its fifth Independent Film Award to Jack Smith for *Flaming Creatures*, stating:

> In *Flaming Creatures*, Smith has graced the anarchic liberation of new American cinema with graphic and rhythmic power worthy of the best of formal cinema. He has attained for the first time in motion pictures a high level of art that is absolutely lacking in decorum; and a treatment of sex which makes us aware of the restraint of all previous film-makers.
>
> He has shown more clearly than anyone before how the poet's license includes all things, not only of spirit, but also of flesh; not only of

> dreams and of symbol, but also of solid reality. In no other art but the movies could this have so fully been done; and their capacity was realized by Smith.
>
> He has borne us a terrible beauty in *Flaming Creatures*, at a time when terror and beauty are growing more apart, indeed are more and more denied. He has shocked us with the sting of mortal beauty. He has struck us with not the mere pity or curiosity of the perverse, but the glory, the pageantry of Transylvania and the magic of Fairyland. He has lit up a part of life, although it is a part which most men scorn.
>
> No higher single praise can be given an artist than this, that he has expressed a fresh vision of life. We cannot wish more for Jack Smith than this: that he continues to expand that vision, and make it visible to us in flickering light and shadow, and in flame.

Film Culture announced that it would present the award to Smith on December 7, 1963 in a midnight ceremony at the Tivoli Theater that would include a showing of *Flaming Creatures* and excerpts from *Normal Love*. But when the Tivoli discovered that the films were unlicensed, it canceled the event at the last minute, locking several hundred attendees out of the theater. Eventually, Mekas climbed onto a parked car and presented Smith's award.

Later that month, the notoriety of *Flaming Creatures* increased when it was censored in Belgium. The Third International Film Exposition in Knokke-le-Zoute took place onboard a cruise ship named the *Casino*. Mekas was one of the nine members of the festival jury and brought several American underground films, including *Flaming Creatures*, which the other members of the jury would not allow him to show. "The jury said it recognized the film's artistic qualities but said it found it impossible to show under Belgian law."

Mekas quit the jury in protest and called on American filmmakers to withdraw their films from the festival, but the boycott failed when the festival refused to release any of the films. Mekas responded by presenting midnight shows of *Flaming Creatures* in his hotel room, to an audience that included Jean-Luc Godard, Agnes Varda, and Roman Polanski.

Mekas also tried to sneak *Flaming Creatures* onto the festival screen. He first replaced a reel of Stan Brakhage's film Dog Star Man with a copy of *Flaming Creatures*, but the projectionist noticed and stopped the film. He tried again on New Year's Eve, the closing night of the festival; the festival presented Andy Warhol's

film *Sleep*, and Mekas slipped a copy of *Flaming Creatures* between the reels. The projectionist agreed to let Mekas show *Flaming Creatures* but asked to be tied to a chair, in order to create the appearance that he had objected. As Mekas started to show *Flaming Creatures*, a festival employee realized what was happening and unplugged the projector. Mekas struggled with the festival employee and called for help from "all those present who believe in the freedom of the screen," at which point the director of the festival ordered the staff to cut power to the room.

When the lights came back on, M. Pierre Vermeylen, the Belgian Minister of Justice and the honorary head of the festival, announced that there was no censorship in Belgium, but that films containing "outrages against decency" could not be shown. That included *Flaming Creatures*, which he considered "pornographic and inartistic." The festival Pre-Selection Committee was outraged and awarded *Flaming Creatures* a specially created *film maudit* or "cursed film" prize.

C. The Persecution of Flaming Creatures

In 1964, New York City stepped up enforcement of obscenity laws, trying to clean up the city in time for the World's Fair. Targets included beatnik coffeehouses, gay bars, and underground movies. *Flaming Creatures* was soon caught in the dragnet.

On February 3, 1964, the Filmmakers' Showcase presented *Flaming Creatures* and rushes from *Normal Love* at the Gramercy Arts Theatre. Two weeks later, its license to show films at the Gramercy Arts was terminated because it had failed to respond to a citation for showing unlicensed films. Mekas moved the Filmmakers' Showcase to the New Bowery Theater, a 92-seat theater at 4 St. Marks Place that he subleased from Diane Di Prima and The American Theatre for Poets, Inc.

On February 20, the Filmmakers' Showcase presented *Flaming Creatures*, rushes from *Normal Love*, and Warhol's newsreel *Jack Smith Filming Normal Love* at the New Bowery. Mekas advertised a "surprise program" in the *Village Voice* and hung a sign over the door reading, "TONIGHT FLAMING SURPRISE PROGRAM." Unbeknownst to Mekas, the audience included two undercover police officers from the anti-obscenity squad, Detectives Arthur Walsh and Michael O'Toole.

On March 3, the Filmmakers' Showcase repeated the program. The undercover police officers also returned. According to one of the detectives, *Flaming Creatures* "was hot enough to burn up the screen." About halfway through *Flaming Creatures*, they stopped the show and arrested Kenneth Jacobs, the projectionist; Florence Karpf, the ticket-seller; and Gerald Sims, the usher. When Mekas heard about the

bust, he rushed to the theater and demanded to be arrested as well. The detectives also seized the films, the projector, and the screen. However, most of the audience members got a refund.

Mekas, Jacobs, Karpf, and Sims spent an uncomfortable night in prison. According to Jacobs, it "was a bad scene, with movie-imitating killer cops, and I feared Jonas was going to bring it down on us. We were 'fags' and 'weirdos' (intellectuals) and 'commies.'" The next day, all four were arraigned, charged with showing an "indecent, lewd, and obscene film," and released without bail.

On March 6, Mekas, Jacobs, Karpf, and Sims were each charged with a misdemeanor violation of New York Penal Law Section 1141, based on Detective Walsh's sworn declaration that *Flaming Creatures* was "garbage . . . indecent, lewd and obscene." Mekas was charged with supplying and distributing a lewd and obscene film, Karpf was charged with selling tickets to and assisting in the projection of a lewd and obscene film, Jacobs was charged with exhibiting a lewd and obscene film, and Sims was charged with taking tickets for a lewd and obscene film.

Mekas immediately went on the offensive, presenting Jean Genet's film *Un Chant d'Amour* at the Writers' Stage Theatre on East 4th Street as "a benefit for the *Flaming Creatures* defense fund." Genet was a prominent French novelist; playwright; and poet, and *Un Chant d'Amour* is a 22-minute film about two imprisoned men who fall in love, which includes images of the men masturbating and a dream sequence that suggests oral sex. Mekas wanted the police to bust *Un Chant d'Amour* because he thought it would be easier to defend than *Flaming Creatures*.

The police were happy to oblige. When Mekas presented *Un Chant d'Amour* on March 7, nothing happened. But when he presented it again on March 13, undercover police officers John Fitzpatrick and Walter Lynch attended a midnight show. After watching the film, they paid the suggested $2 donation. Then they arrested Mekas and his ticket-taker, French film critic Pierre Cottrell. They also seized the film and all of the projection equipment. Mekas and Cottrell spent the night in prison and were released the next day on $1,500 bail.

At that point, the city lost its patience. When the Filmmakers' Showcase presented two unlicensed Japanese films on March 17, 1964, the director of the License Department stopped the show. The License Department also cited the New Bowery Theater for showing an unlicensed film. Theodora Bergery, the owner of the theater, was livid. Ultimately, the License Department suspended the New Bowery Theatre's license for 30 days, and the American Theatre for Poets found a new home.

Mekas also hosted private screenings of *Flaming Creatures*, hoping to gin up support. He met with mixed success. Susan Sontag loved *Flaming Creatures* and published a review in the Nation arguing that it was "a brilliant spoof on sex." But Mekas soon learned that audiences expecting pornography were less receptive:

> One of the most revealing experiences I had was during a screening of *Flaming Creatures* to a group of New York writers, upper-class writers who write for money, who expected to see another "blue movie"—I had never met such violent reactions, such outbursts of uncontrolled anger. Someone was threatening to beat me up. They would have sat happily through a pornographic movie, which they were expecting to see and which the host had promised them that night—but they could not take the fantasies of Jack Smith.

IV. *Jacobs v. New York*

A. Flaming Creatures in New York State Court

The *Flaming Creatures* trial was originally scheduled to begin on April 6, 1964, and the *Un Chant d'Amour* trial was scheduled to begin a week later, on April 13. Both were postponed, and the *Flaming Creatures* trial began on June 2, before a three-judge panel of the Criminal Court of the City of New York: former mayor Vincent R. Impelliteri, Thomas E. Rohan, and Michael A. Castaldi. Jacobs, Mekas, Karpf, and Sims were each charged with one count of violating New York Penal Law Section 1141 by showing an obscene movie. All four pleaded not guilty. Assistant District Attorney Harris represented the State. Emile Zola Berman and David G. Trager represented the defendants.

The State argued that *Flaming Creatures* was obscene principally by showing the film to the court. Harris called only two witnesses: Detectives Arthur Walsh and Michael O'Toole. They testified that the District Attorney ordered them to bust *Flaming Creatures*, that they seized the film two days later, and that they did not obtain search or arrest warrants. Walsh also testified that *Flaming Creatures* was "garbage" and that it was "indecent, lewd and obscene." Then, Harris presented *Flaming Creatures* to the judges, the defendants, and a few reporters. The judges, "two of them munching cigars, watched impassively as the movie was shown in chambers."

The defense responded that *Flaming Creatures* is not obscene because it is a work of art. Berman called eleven witnesses, most of them experts, to prove it. But

Harris repeatedly objected that expert testimony on artistic merit is irrelevant to obscenity, and the court sustained his objections, over Judge Rohan's dissent.

The court excluded the testimony of Berman's first three witnesses as inadmissible. Louis Allen, a producer, would have testified that *Flaming Creatures* "was a serious, talented work of art that poetically and wittily satirized advertising, fashion, love, and society's use of sex." Willard Van Dyke, a documentary filmmaker and film festival judge, would have testified about the cinematic qualities of *Flaming Creatures*. Herman Weinberg, a professor of film history at the City College of New York, would have testified that *Flaming Creatures* "was an aesthetic production that satirized sex and an experimental film that employed artistic technique." Harris objected to all of this testimony and the court sustained his objections.

Berman's next witness was Susan Sontag. The court admitted into evidence Sontag's review of *Flaming Creatures* and allowed her to testify about the meaning of the review. Among other things, Sontag defined the avant-garde film movement as "a small group of people who are doing experimental work that is usually just mainly followed by critics and by other artists." Sontag also pointed to "posters outside Times Square movie theatres that advertise war movies with sadistic atrocity pictures" as an example of pornography. However, Harris objected to Sontag's testimony that *Flaming Creatures* is a work of art and the court sustained his objection.

After Sontag testified, Berman moved for a mistrial, arguing that the court was preventing the defendants from presenting any evidence because it had already decided that *Flaming Creatures* was obscene. The court denied the motion and reasserted its evidentiary rulings, Rohan continuing to dissent.

While the court allowed some of Berman's remaining witnesses to testify, it did not allow any of them to testify that *Flaming Creatures* is a work of art. Shirley Clarke, a filmmaker and professor at Columbia University, testified that the Film-Makers' Cooperative distributes avant-garde films, including *Flaming Creatures*. Joseph Kaster, a professor at the New School for Social Research, testified that he showed *Flaming Creatures* to his class as an illustration of the Dionysius myth. Richard Leslie Trumbull, a volunteer clerk at the Film-Makers' Cooperative, which distributed *Flaming Creatures*, testified that the defendants were arrested at a benefit screening advertised in the *Village Voice*. Allen Ginsburg, a poet, testified that he knew Jack Smith and had seen *Flaming Creatures*. Ginsburg also defined the avant-garde as "a group of people up front looking to experiment with their own consciousness, their own hearts, their own feelings, in an attempt to communicate

with other human beings." Harris objected to Ginsburg's testimony that *Flaming Creatures* has "aesthetic and artistic value as well as social importance," and the court sustained the objection.

Harris stipulated to the testimony of Berman's remaining witnesses. Charles Levine, who attended the March 3 presentation of *Flaming Creatures*, would have testified that the audience was well behaved. Psychiatrists Dr. Edward Hornick and Dr. John Thompson would have testified that *Flaming Creatures* is a work of art. Harris objected to the admission of this testimony, and the court sustained his objection. Oddly, Berman did not call Jack Smith as a witness. Smith was quite a colorful character and Berman apparently wanted to keep him out of the courtroom.

On June 12, 1964, Berman concluded the case for the defense and moved to dismiss the complaints against all four defendants on the ground that the state failed to prove beyond a reasonable doubt that *Flaming Creatures* is obscene. Harris responded that artistic merit does not disprove obscenity. The court denied the motion to dismiss and convicted Mekas, Jacobs, and Karpf. The court acquitted Sims, finding that he was not responsible for presenting *Flaming Creatures* because he was hired as a ticket taker at the last minute.

The *Un Chant d'Amour* trial was scheduled to begin on June 19, but was postponed until after the *Flaming Creatures* sentencing hearing. The sentencing hearing was held on August 7, 1964 before another three-judge panel of the Criminal Court of the City of New York: Simon Silver, Edward J. Greenfield, and Charles S. Whitman.The judges watched Flaming Creatures before sentencing the defendants. Jacobs and Mekas got sixty days in the city workhouse, execution of sentence suspended, and Karpf got a suspended sentence. When the sentences were entered, the state dismissed the charges involving *Un Chant d'Amour*, "on condition, agreed to by Mekas, that the import not be shown anywhere in New York State before all appeals from the '*Flaming Creatures*' conviction had been finally disposed of."

Crusaders against obscenity relished the victory. New York Assistant District Attorney Richard H. Kuh crowed, "Despite anguished squeals of 'persecution of the avant-garde,' and howls of 'censorship' by those who seemed to relish their kinship to martyrdom, Mekas was tried and convicted for showing '*Flaming Creatures*.'" Even some of Mekas's allies criticized his approach. For example, Amos Vogel complained, "it is highly debatable whether '*Flaming Creatures*' should have been used as a test case" because "despite flashes of brilliance and moments of perverse, tortured beauty, [it] remains a tragically sad film noir, replete with limp genitalia and limp art."

Jacobs, Mekas, and Karpf appealed their convictions, without success. Berman filed a notice of appeal in the Appellate Term of the Supreme Court, First Judicial Department, and on December 9, 1965, that court entered an order without opinion affirming the convictions below. Berman also filed an application for leave to appeal to the Court of Appeals, and on April 15, 1966, Judge Stanley H. Fuld denied permission to appeal.

B. Flaming Creatures in the Supreme Court

Their state appeals exhausted, Jacobs, Mekas, and Karpf appealed to the United States Supreme Court. On July 13, 1966, Berman filed a notice of appeal to the Supreme Court of the United States in the Criminal Court of the City of New York, New York County, and on October 11, he filed a jurisdictional statement for *Jacobs v. New York* in the Supreme Court of the United States.

Berman's jurisdictional statement argued that New York Penal Law Section 1141 violated the First Amendment as applied because: (1) it excluded expert testimony on artistic merit, educational value, social importance, prurient appeal, and community standards; (2) it prohibited the portrayal of indecent conduct; (3) it excluded evidence of the context in which a film was shown; and (4) it permitted an obscenity conviction without a finding of pandering.

Essentially, Berman argued New York Penal Law Section 1141 was unconstitutional because it did not require pandering. *Flaming Creatures* was presented "in the setting of an avant garde group sincerely devoted to the arts," not as "an attempt to pander to prurient interests." In other words, "we have a film the showing of which was motivated by a legitimate artistic purpose and not for the commercial exploitation of sex in cinema." This argument was calculated to appeal to Fortas, and it succeeded.

On November 11, 1966, New York filed a motion to dismiss or affirm Jacobs, arguing that it was moot because appellants' suspended sentences had lapsed and because the trial court properly found *Flaming Creatures* obscene. The motion emphasized the subject matter of the film, describing it in explicit detail:

> It is comprised of several separable sequences, all of them depicting some form of transvesticism or abnormal sexual behavior. One of the sequences concerns a sexual attack upon a female by four individuals, some dressed as women, with the camera focusing at times on the "victim's" bare breast which is being violently shaken by a participant in the assault, and dwelling at other times on the subject's uncovered

> pubic area which is being massaged by another attacker. In other sequences there are numerous scenes of male masturbation. Such depictions of penises and pubic regions, portrayed in the perverse manner they are here, debase both the sexual act and the human body and are clearly hard-core pornography.

Berman filed a reply to New York's motion to dismiss or affirm on November 30, 1966. He argued that Jacobs was not moot because the obscenity convictions injured appellants by preventing recovery of the confiscated film and equipment, limiting the availability of motion picture licenses and staining their reputations. Berman also reiterated that Jacobs, Karpf, and Mekas were not panderers, by arguing that "[n]ot only is any evidence of commercial exploitation wholly absent here, but the opposite isestablished by the record." In fact, they "considered the film as well as the many other films produced by the members of Film Makers Cooperative as works of art, treated them as such and expected others to do likewise."

Berman's focus on pandering was quite timely because the Court was wrestling with the pandering test when he appealed Jacobs. In fact, Berman filed the jurisdictional statement in Jacobs on the day that oral arguments in *Redrup* concluded. And the Court noticed Berman's focus on pandering. For example, Justice Douglas's law clerk Lewis B. Merrifield drafted a memorandum concluding that Jacobs should be reversed for lack of pandering:

> It seems to me that a good argument can be made that Appellants cannot be convicted under the *Ginzburg* rule. If "pandering" can be used to convict a person, it should be used to acquit as well. Many autoerotic films are considered works of art - due to their symbolism. If a film of this kind is directed to a group of people who appreciate experimental, avant guard films, and exhibited by people who desire to promote film art, an inverse use of *Ginzburg* should protect them.

On December 9, Edward de Grazia and John R. Kramer of the National Students Association filed an amicus brief in Jacobs, with the consent of the parties. The National Students Association emphasized that Jacobs, Mekas, and Karpf were not panderers, but "members of a cooperative society of experimental film-makers" who showed "an avant-garde motion picture for the benefit of society." And it argued that courts hearing obscenity cases must consider expert testimony on artistic and social value, in order to protect "the work whose artistic and social values are apparent only to and appreciated only by a minority on the frontiers of artistic expression and human knowledge, i.e., the avant-garde."

The Court expected *Redrup* to clarify obscenity doctrine by emphasizing the pandering test. So, on January 6, 1967, it held eighteen obscenity cases pending its decision in *Redrup*, including Jacobs. But when the Court finally decided *Redrup* on May 8, 1967, it punted; Rather than clarify obscenity doctrine, it issued a per curiam opinion reversing on the facts.

The Court planned to decide the *Redrup* line of obscenity cases in conference on May 26, 1967. However, it was forced to postpone them again because it had not yet received the films at issue in *Jacobs v. New York* and *Schackman v. California*. The Court eventually received *Flaming Creatures* on June 2, as well as *O-7*, *O-12*, and D-15, the stag films at issue in *Schackman*. Presumably, the films were shown for the Court, but there is no record of who attended. A few of the justices also saw *Un Chant d'Amour*, the film at issue in *Landau v. Fording*. According to Stewart, "the film is not as the Cal SC described it - no scenes of sodomy etc. The worst thing was a very fleeting scene of masturbation."

The Court finally voted on the obscenity cases in conference on June 8, 1967. The justices voted to reverse many of the cases. But in *Jacobs*, a majority of the justices voted to either affirm the convictions or dismiss the appeal as moot. On the merits, Justices White, Brennan, Harlan, Clarke, and Warren voted to affirm; Justices Fortas, Stewart, and Douglas voted to reverse; and Justice Black did not vote. However, Justices White, Stewart, Harlan, Clark, and Black also voted to dismiss Jacobs as moot.

The Court decided the *Redrup* line of obscenity cases on June 12, 1967. Most of the cases were decided in per curiam opinions, reversing under *Redrup*. *Jacobs* was also decided in a per curiam opinion, but it was dismissed as moot. Brennan noted his vote to affirm and Fortas noted his vote to reverse. Warren dissented from the dismissal of Jacobs as moot, arguing that it allows states to insulate convictions from review by imposing short suspended sentences. Fortas added that he would affirm the convictions on the merits because *Flaming Creatures* "falls outside the range of expression protected by the First Amendment according to the criteria set out in Roth." Douglas also dissented from the dismissal of Jacobs as moot, arguing that denying review of obscenity convictions would cause people "to comply with what may be an invalid statute" and "steer wide and refrain from showing or selling protected material." He closed by noting that the film and the motion picture equipment would be forfeited if the Court dismissed the appeal.

While the Court ultimately dismissed Jacobs as moot, the vote count on the merits is strange. There should have been five votes to reverse. At the June 8

conference, Fortas, Stewart, and Douglas voted to reverse. But in theory, White and Brennan should have voted to reverse as well. White's unwritten test for obscenity was "no erect penises, no intercourse, no oral or anal sodomy," so "no erections and no insertions equaled no obscenity." Brennan applied a similar "limp dick" test, under which obscenity required an erection. Under Brennan's rule, "[o]ral sex was tolerable if there was no erection."

Flaming Creatures is replete with limp dicks and conspicuously lacks erections and intercourse. Nevertheless, both White and Brennan found it obscene. Perhaps they were disturbed by its unfamiliar form and homosexual content. Notably, they also voted to affirm the *Un Chant d'Amour* conviction in *Landau v. Fording*, with Justices Black, Douglas, Stewart, and Fortas voting to reverse.

C. The Continuing Prosecution of Flaming Creatures

As Jacobs wended its way through the courts, the notoriety of *Flaming Creatures* increased. In 1966, Vincent Canby of the *New York Times* described it as "a film record of a transvestite orgy." The following year, Rosalyn Regelson offered the more charitable assessment that "Jack Smith's still-banned '*Flaming Creatures*' depicts the exotic 'pageantry of Transvestia and the magic of Fairyland' as the Film Culture award puts it, in phantasmagoric terms." But Time dismissively concluded, "Jack Smith's . . . *Flaming Creatures*, an incredibly tedious parody of a sexploitation feature, demonstrates how easy it is to fall asleep in the steamy midst of an hour-long transvestite orgy."

College film societies also began to present *Flaming Creatures*, and several were busted. On April 1, 1965, the Albuquerque police busted a presentation of *Flaming Creatures* at the University of New Mexico. Municipal Judge James Malone watched the film and concluded that it was obscene, but the city attorney declined to prosecute because the people who showed it did not intend to promote pornography. Apparently, a student named Bill Dodd had rented *Flaming Creatures* sight unseen because its star Mario Montez was an alumnus of the University of New Mexico.

Similarly, on November 9, 1966, the Austin police busted a presentation of *Flaming Creatures* at the University of Texas. The show was arranged by an art student named Cynthia Smagula and sponsored by Students for a Democratic Society. Smagula canceled the show when the police arrived in order to avoid arrest, even though the police said they did not intend to arrest anyone.

Most notably, on January 18, 1967, the Ann Arbor police busted a presentation of *Sins of the Fleshapoids* and *Flaming Creatures* at the University of Michigan. About

600 people attended the show, which was arranged by Mary E. Barkey, hosted by the University of Michigan Cinema Guild and sponsored by Students for a Democratic Society. A professor had filed a complaint about the show, so Detective Lieutenant Eugene Staudenmeier attended as well. Staudenmeier ignored *Sins of the Fleshapoids*, which lacked explicit sexual content, but he seized Flaming Creatures about seven or eight minutes after it began, tucking the film under his coat and trying to leave the theater. The audience erupted, trying to stop Staudenmeier from leaving the projection booth and chasing him out of the theater. About 100 students protested the seizure of *Flaming Creatures*, demonstrating in front of the police department and staging a four-hour sit-in at city hall.

The next day, the police arrested four members of the Cinema Guild: Ellen P. Frank, Mary E. Barkey, Elliot S. Cohen, and Hubert I. Cohen, the faculty adviser. Each was charged with violating the Michigan obscenity law. Municipal Judge S. J. Elden released the defendants without bail but described *Flaming Creatures* as "a smutty purveyance of filth [that] borders on the razor's edge of hard-core pornography" and "would sexually arouse and excite transvestites and homosexuals." The defendants responded by moving to suppress the evidence and filing a civil rights claim in federal court and requesting both an injunction against the seizure of art films and $15,000 damages. The obscenity trial began on December 12 and ended immediately when Mary Barkey pleaded guilty to a lesser charge. On February 7, 1968, Barkey was ordered to pay a $235 fine, and charges against the other three defendants were dropped. The Ann Arbor police kept the confiscated print of *Flaming Creatures*, which featured in the Fortas Film Festival later that year.

V. THE FORTAS FILM FESTIVAL

Flaming Creatures is probably the only avant-garde film ever shown in the Capitol, and it is certainly the only avant-garde film to have prevented a Supreme Court confirmation. When Johnson nominated Fortas to replace Warren as Chief Justice, Fortas's opponents had to justify a filibuster. *Flaming Creatures* was their ace in the hole.

On June 13, 1968, Warren informed Johnson of his intention to retire and sent a resignation letter stating, "I hereby advise you of my intention to retire as Chief Justice of the United States, effective at your pleasure." In a separate letter sent the same day, Warren stated that he was retiring because of his age. While Johnson immediately decided to nominate Fortas as Warren's replacement, he kept Warren's

retirement under wraps. He needed time to build support for Fortas and he wanted to ensure that Warren could withdraw his retirement if Fortas was not confirmed.

However, Johnson's attempt at secrecy was remarkably unsuccessful. Rumors of Warren's retirement and Fortas's nomination began to circulate the next day. Johnson knew that Fortas needed support from Republicans and southern Democrats, so he quickly started lining up votes, beginning with Republican Senator Everett Dirksen, the powerful minority leader. When Johnson decided to nominate Judge Homer Thornberry as Fortas's replacement, Senator Richard Russell, the leader of the southern Democrats, agreed to support both nominees. But Senator James O. Eastland, the Chairman of the Judiciary Committee, was adamantly opposed to Fortas. Fatefully, he did agree to let the nomination out of committee "at my own time." And Republican Senator Robert P. Griffin was among the first to come out publicly against the Fortas nomination. Johnson had announced that he would not seek a second term, and Griffin argued that the Senate should refuse to confirm any nomination made by a "lame-duck President."

Finally, on June 26, 1968, Johnson announced his acceptance of Warren's retirement, "effective at such time as a successor is qualified," and nominated Fortas and Thornberry. The battle lines were already drawn. Many Republicans opposed Fortas because they expected Nixon to win the upcoming presidential election and wanted him to appoint the new Chief Justice. And many southern Democrats opposed Fortas because they hated his liberal politics. Their weapon was delay. While Fortas had enough votes in the Senate to break a filibuster, he could not keep them for long.

A. The Fortas-Thornberry Hearings

When the Senate Judiciary Committee met on July 27 to discuss the Fortas and Thornberry nominations, Senator Sam Ervin stalled by suggesting that Johnson's conditional acceptance of Warren's retirement meant that no vacancy existed. The committee discussed this issue for several days before scheduling hearings on the nominations to begin on July 11. Eastland invited Attorney General Ramsay Clark to testify on the vacancy issue at the hearings. Eastland also invited Fortas to testify at the hearings. Against his better judgment, Fortas agreed.

On July 1, the Fortas nomination suffered a crippling blow when Russell withdrew his support. Russell had recommended Alexander Lawrence for a district court vacancy and Johnson was stalling the nomination because Attorney General Clark opposed it. Russell retaliated by withdrawing his support for the Fortas and

Thornberry nominations. Johnson immediately nominated Lawrence, but the damage was done.

The committee hearings began on July 11 with Attorney General Clark's testimony on whether the conditional acceptance of Warren's retirement created a vacancy on the Court. On July 12, Griffin testified against "cronyism" and "lame duck" nominations and alleged that Fortas had violated the separation of powers by consulting with Johnson on executive decisions. Senator Ralph Yarborough also introduced Thornberry, who made a brief appearance, followed by the representatives of several fringe organizations that opposed the Fortas nomination.

Fortas first appeared before the committee on July 16. Eastland and Senator John L. McClellan asked him whether he had consulted with Johnson on executive decisions after he was appointed to the Supreme Court. Fortas admitted that he had, but insisted that he had not "recommended anybody for any public position" or "initiated any suggestions or any proposal." These assertions were false. In fact, Fortas had recommended many candidates for public office and had pressed many policy proposals. Ervin spent the rest of the day and the following day asking Fortas an interminable series of questions about his judicial philosophy and the decisions of the Warren Court, to which Fortas gave carefully vague replies.

On July 18, Senator Strom Thurmond stepped up to the plate and started swinging. For hours, Thurmond barraged Fortas with questions about various Supreme Court decisions, which Fortas refused to answer on constitutional grounds. The climax of Thurmond's attack came when Fortas refused to answer questions about *Mallory v. United States*, a 1957 case in which the Supreme Court unanimously reversed a rape conviction because the defendant was held too long before arraignment. Thurmond intoned, "Does not that decision, *Mallory*—I want that word to ring in your ears—Mallory—the man happened to have been from my State, incidentally—shackle law enforcement? Mallory, a man who raped a woman, admitted his guilt, and the Supreme Court turned him loose on a technicality." Suddenly, Thurmond became Fortas's leading opponent.

Thurmond continued to question Fortas on the morning of July 19, before yielding the floor to McClellan, who returned to Fortas's role in the Johnson administration. Fortas admitted to discussing political issues with his friends but denied passing messages for Johnson or consulting on legislation. When Fortas finished testifying, Eastland closed the Fortas hearings. While the papers criticized Fortas for advising Johnson, they considered it a venial sin. But Fortas's opponents smelled a rat. Griffin launched an investigation of Fortas's finances. Thurmond asked

Eastland to reopen the Fortas hearings. The Thornberry hearings opened on July 20 to an empty house, with only four committee members present. Eastland began by announcing that he was reopening the Fortas hearings because he had promised to allow "Liberty Lobby and another group" to testify. Liberty Lobby was an anti-Semitic conservative organization, which opposed Fortas because he was a liberal Jew. The other group Eastland referred to was Citizens for Decent Literature (CDL), a nonprofit organization that opposed pornography. When Thornberry finished testifying on July 21, he went home, already sure the nomination was dead.

On July 22, the Senate Judiciary Committee heard the testimony of W.B. Hicks, Jr. of Liberty Lobby, James J. Clancy, and Charles Keating of CDL. The committee ignored Hicks, but CDL got its attention. CDL argued that Fortas was soft on obscenity and brought a pile of examples to prove it. According to Clancy, Fortas's "judicial philosophy" on obscenity was not "spread on the record" because Fortas had joined many summary reversals of obscenity convictions. Clancy pointed out that "the U.S. Supreme Court reversed 23 of 26 state and Federal obscenity determinations" during the October 1966 term, including twenty summary reversals, and Fortas voted to reverse in every case. The summary reversals did not "discuss the facts or conduct of the case and the reasoning involved," so "the materials and facts involved in these cases are very effectively 'buried' in the records of the Court below."

CDL dug them up. Clancy filed as an exhibit a "summary of these cases, including the subject matter involved." He also stated that CDL had created *Target Smut*, "a 35-millimeter slide film documentary of the October 1966 term decisions" that "traces the history of the 26 cases from their origin in the trial court, up to the final decision of the U.S. Supreme Court and shows pictorially the materials involved."

Clancy emphasized that "[w]ithout an understanding of the material that the Court is passing on, the Court's judgments lose much of their significance." He then used one of those judgments to illustrate Justice Fortas's philosophy of obscenity:

> A more precise understanding of [Fortas's] philosophy in the obscenity area can be gained from a consideration of his vote in Schackman v. California decided in June of 1967. In that case, three striptease films entitled "*O–7*," "*O–12*," and "*D–15*" were ruled hard-core pornography by Federal District Judge Hauk, a Los Angeles jury, and the California appellate system. Those determinations were reversed in the U.S. Supreme Court by a 5–4 decision, with Justice Fortas casting the

> deciding vote. This judgment is representative of his actions in the other cases."

Clancy filed a copy of *O-7* as an exhibit and quoted Judge Hauk's description of the film:

> The model wears a garter belt and sheer transparent panties through which the pubic hair and external parts of the genitalia are clearly visible . . . At one time the model pulls her panties down so that the pubic hair is exposed to view . . . the focus of the camera is emphasized on the pubic and rectal region, and the model continuously uses her tongue and mouth to simulate a desire for, or enjoyment of, acts of asexual nature.

Clancy claimed that Schackman caused a porn explosion because "the 1966 term reversals were the causative factor which brought about, subsequent to June 1967, a release of the greatest deluge of hard-core pornography ever witnessed by any nation." Thurmond agreed and suggested that the obscenity cases "were reversed without any opinion to discuss the facts and conduct of the case and the reasoning involved" because the Court was "ashamed of the decisions, and ashamed to write in detail their reasoning."

Thurmond was determined to share the facts of those obscenity cases with the committee and the press. When the committee declined Clancy's offer to show *Target Smut* and *O-7*, Thurmond asked him to show *O-7* after the hearing ended. Some found Thurmond's request distasteful. Hart remarked, "I confess it is almost obscene to sit around here and anticipate we are going to look at dirty movies," and a New York Times reporter "suggested that they think of it not as a witch hunt but as a bitch hunt." Nevertheless, when the hearing ended, Clancy showed *O-7* to Thurmond and about twenty reporters.

While Thurmond insisted that *O-7* "shocked Washington's hardened press corps," some of the reporters disagreed:

> Mostly, the press corps giggled. For one thing, there was no screen in the room, and *O-7* was shown on a wooden panel, which made the girl in scanties look as if she were molting. For another, many of the reporters made rude jokes to one another.

Apparently, senators have more delicate sensibilities than reporters. Before Clancy testified, McClellan, Fong, Hart, and Miller had previewed *Target Smut* and *O-7*. Hart refused to defend the film. Miller, Fong, and McClellan agreed that it was

"hard-core pornography" and "something no civilized country can tolerate." It became clear that Clancy would have another opportunity to share *O-7* with the committee when Fong added, "All the members are anxious to see it, and I think they should." Thurmond's aides immediately started pitching *O-7* to the media, describing it as "a vulgar, filthy, subjective thing of a woman disrobing down to her transparent panties."

The hearings ended on July 23, with the testimony of Deputy Attorney General Warren Christopher. While Ervin asked Christopher about Fortas's judicial opinions, Thurmond ostentatiously studied a nudist magazine titled *Nudie-Fax*. When Ervin finished, Thurmond asked Christopher's opinion of the material at issue in the Court's obscenity cases. Christopher professed ignorance. Thurmond gave Christopher another nudist magazine titled Weekend Jaybird and stated that he had "sent a member of my staff today down the street just to see if material of the kind you have there was available in the city in which you live." When Thurmond asked how to suppress pornography, Christopher could not respond. When the committee invited Fortas to return and discuss obscenity, he wisely declined. Fortas's opponents had discovered their theme.

B. The Return of Flaming Creatures

When the hearing ended, Fortas still had enough votes for cloture, so his opponents had to keep the nomination bottled up in committee. Luckily for them, procedure was on their side. On July 24, Hart made a motion to vote on the Fortas and Thornberry nominations. In response, McClellan requested a mandatory one-week delay, stating that he "wanted to know a good deal more about the obscenity film before a decision was made on Fortas." He had seen *O-7* and "was convinced that any Senator who saw it would vote against the nomination." The delay was granted. Thurmond and McClellan announced that they would spend the week showing *O-7* to the rest of the committee.

Fortas's opponents quickly realized that *O-7* provided the perfect excuse for voting against the Fortas nomination. As Senator Smathers explained to Johnson:

> So, here it is, Fortas is lined up having voted for this circulation, or the allowance of the circulation of this thing, pornographic movie. So what happened is a lot of guys that don't want to be recorded as for, that are looking for some reason to be against him . . . I've seen a number of fellows who have been talking about it –a number of senators are talking about it: "You know, God, I can't be for a fella that let this kind of literature out on the newsstand, and be showing it." As usual, they

> are making a lot of exaggerated statements in connection with it–such as, that it was being shown in public movies, and it's your mother and your sister and your daughters, and everybody to go see this damn thing.

However, Fortas's opponents knew that they needed more ammunition. While *O-7* was obviously pornographic, it was actually pretty tame—a silent striptease with no sexual intercourse. According to Smathers, when Hart saw the film, "he didn't think it was so bad, although when he told me that, 'I've seen many just like that, and I'm sure most every fella just has, everyone belonging to sort of a man's club.'" CDL also filed a copy of *O-12*, but it was essentially identical to *O-7*.

Then, the committee discovered *Flaming Creatures*. CDL's summary of the obscenity cases decided by the Supreme Court during the October 1966 term referred to *Flaming Creatures* and *Un Chant d'Amour* as "two home-made 16mm. so-called 'underground' films." It further described *Jacobs v. New York* as follows:

> In the New York case, Jacobs and Mekas were convicted by a 3-judge trial court in New York County for exhibiting the film "*Flaming Creatures*" in violation of the state obscenity statute. The home-made film, produced by Jack Smith, has gained a notorious reputation for its homosexual content. The 40-minute film presents five unrelated, badly filmed sequences, which are studded with sexual symbolisms. Amapola and other recordings are heard as background music. Included in the first sequence of 17 minutes is a mass rape scene involving two females and many males, which lasts for 7 minutes, showing the female pubic area, the male penis, males massaging the female vagina and breasts, cunnilingus, masturbation of the male organ, and other sexual symbolisms. The second sequence which lasts approximately three minutes shows lesbian activity between two women. The third sequence, about 7 minutes in duration, shows homosexual acts between a man dressed as a female, who emerges from a casket, and other males, including masturbation of the visible male organ. The fourth and fifth scenes show homosexuals dancing together and other disconnected erotic activity, such as massaging the female breasts and group sexual activity. Jacobs and Mekas were found guilty by the trial court and sentenced to 60 days in the New York City workhouse, but execution of the sentence was suspended. The Appellate Court in New York refused to
> reverse the conviction.

CDL went on to explain the Court's disposition of the case: In New York v. Jacobs, the Court refused to render a judgment on the home-

> made 16mm. film “Flaming Creatures”, which depicted a 7-minute rape scene and other sexual deviate acts. . . . While the Court voted the underground film “*Un Chant d’Amour*” obscene 5-4, the same majority of five was unable to get together on a lower grade film, “*Flaming Creatures*”, which depicted a 7-minute rape scene, acts of oral intercourse, fondling of the female vagina and breasts, masturbation of the visual penis, and the like, some of which were suggested but never shown in the film, ‘*Un Chant d’Amour*’. The Court held the issues in that case “moot”, to avoid a decision.”

CDL’s description of *Flaming Creatures* must have caught Eastland’s eye because one of his aides located a copy of the film in Michigan and brought it to Washington. On July 30, Senators Eastland, McClellan, Long, Miller, and McGee and several reporters watched *Flaming Creatures* in “a small basement studio in the Capitol.” They were appalled by what they saw. One senator described *Flaming Creatures* as “a candid exploration of transvestitism.” Another senator exclaimed, “That film was so sick, I couldn’t even get aroused.” Eastland refused to comment, and McClellan “termed the film ‘crude vulgarity.’”

The next day, Long described his reaction to *Flaming Creatures* on the Senate floor:

> I have never before seen things like that. We said, “Let us just take a look and see what Judge Fortas is trying to do.” And when I saw it, I said, “I am not going back. I have seen one Fortas film—I have seen enough.”

According to the Chicago Tribune, “Even some of the strongest backers of Fortas found [*Flaming Creatures*] filthy and disgusting.” Fortas’s opponents smelled blood. CDL announced its intention to send copies of *O-7*, *O-12*, and *Flaming Creatures* “to women’s groups and civic clubs.” And Thurmond focused his considerable energy on sharing the films with his colleagues. Suddenly, dirty movies were Fortas’s biggest problem.

C. In and Out of Committee

The committee failed to make a quorum before the August recess, so the Fortas nomination was postponed until September. Thurmond spent the recess hammering away at Fortas's record on obscenity, claiming, "The effect of the Fortas decisions has been to unleash a floodtide of pornography across the country. Those who exploit youth and human weakness now have no fear of conviction, and openly distribute and sell the grossest materials."

On September 4, the committee failed once again to make a quorum. Eastland "was unable to say when he would attempt to have another meeting" and confirmed that he would vote against reporting the nomination to the Senate and against confirmation, if necessary. McClellan added that *O-7*, *O-12*, and *Flaming Creatures* "ought to be shown at a committee hearing and made a part of the record" before the committee acted on the Fortas nomination, calling them "degrading."

Thurmond took the opportunity to approach "colleagues who are on the fence to invite them to private showings" of the films:

> [L]ast week, the reruns began. And since then in the Senate recording studio and in darkened Senate offices, the films have been shown more than a dozen times. . . .
>
> The films are entitled: "*O-7*," "*O-12*," "D-15," and "Flaming Creatures." The first three, from a California case, are shown together, in descending order of pornography, that is, going from bad strip tease to worse. "*Flaming Creatures*," an underground film which displays some attempt at sexistentialist art, was seized in Ann Arbor, Mich., where it was being privately shown. In the dim Senate offices, as the rather unattractive long-legged young ladies in their altogether pranced and posed on the flickering screens, Senate aides and newsmen chortled and made wisecracks.
>
> But not the distinguished gentlemen of the Senate. Those who have viewed the films have sat stonily silent, with appalled expressions on their faces.
>
> A single private showing of the film this week, one Fortas opponent claimed, converted two senators – Milton Young, R-N.D., and Mark Hatfield, R-Ore., a liberal. Neither senator would comment on the claim. . . .

> Griffin said the three numbered films are clearly within the bounds of obscenity. And one of his aides cracked: “If you want to find a socially redeeming feature in the films, you can say they provided work for the models, the photographer and the film developer.”
>
> Fortas supporters say the case involving “Flaming Creatures,” which includes a scrambled montage of a rape scene not unlike the one in the hit “Rosemary’s Baby,” was overturned because the court ruled the film was illegally seized. But opponents of Fortas point out that he said hewould have protected the right to show the film.

About 20 senators saw the films. The committee soon added all three films to the record. Mansfield and Dirksen publicly warned Johnson that opposition to the Fortas nomination was “hardening.” Privately, they explained that “floor debate on pornography will be dirty, that Thurmond smells blood now . . . and that the movies were what the opposition needed to make their positions jell.”

Fortas’s supporters realized that his position on obscenity was a problem and tried to respond to Thurmond’s attacks. Attorney General Ramsey Clark complained that the “obscenity cases issue is itself obscene” and that Thurmond’s film shows were “outrageous.” And Dean O’Meara of Notre Dame Law School wrote an open letter defending Fortas’s record on obscenity, insisting that the attacks were “unfair, misleading and dangerous” because Schackman and Jacobs were per curiam opinions, and Fortas did not “issue a separate statement of his own views” in either case. O’Meara claimed that the cases presented “unique” issues, explaining that Schackman “involved a ‘peep-show’ of a filmed burlesque performance not unlike those presented fairly widely in burlesque houses throughout the country.” O’Meara further argued that Jacobs “involved a nearly private screening of what we are told was a seriously intended, if unconventional, underground art film, and the show was not advertised in any way to the public at large”; O’Meara repeated the canard that Schackman “presented the question of illegal police seizure.” Notably, O’Meara also correctly attributed the Court’s adoption of the pandering test to Fortas and argued that it “broke the impasse which had developed over the obscenity issue in the years before his appointment.” While O’Meara’s letter appeared in many newspapers and was printed in the Congressional Record, it was already too late.

On September 11, Eastland reluctantly agreed to schedule a vote on the Fortas nomination. Thurmond insisted on additional hearings before the vote, and Eastland invited Fortas to appear “at his convenience” to discuss “certain films and cases involving the issue of obscenity.” The committee also asked several people to testify

about Fortas's role in the Johnson administration. Thurmond was determined to ensure that the hearing focused on pornography, so he asked Sergeant Donald Shaidell of the Los Angeles Police Department, the arresting officer in Schackman, to testify about the seizure of *O-7*, *O-12*, and D-15. Thurmond specified that Shaidell "will bring new films with him."

Fortas declined the committee's invitation to testify, as did everyone asked to discuss his role in the Johnson administration. So on the morning of September 13, the hearing opened with the testimony of Dean B.J. Tennery of American University Law School, who answered questions about a class that Fortas had conducted over the summer. But the committee's attention returned to pornography when Shaidell testified that afternoon. Shaidell told the committee that California "was being flooded with filthy movies and books" because Schackman had left its obscenity laws "in a state of chaos."

As promised, Shaidell also brought a new film: *Un Chant d'Amour*, described rather primly as "an half-hour film depicting incidents between penitentiary inmates." Once again, Hart objected to watching the film, stating, "It is almost obscene for us to sit around here and contemplate that we are going to look at dirty movies." But after some debate, the committee agreed to a private screening of *Un Chant d'Amour*, which it had not yet seen. The committee noted that Fortas "was one of four members of the court who said they would have reversed the California courts and cleared the movie legally."

Finally, on September 17, the committee approved the Fortas nomination by an 11 to 6 vote. But Eastland observed, "I do not think Mr. Fortas will be confirmed by the Senate," and Thurmond promised a filibuster. Hart angrily replied that the first filibuster of a Supreme Court nomination would be "a miserable precedent." And Dirksen made a short-lived proposal to strip federal jurisdiction over obscenity cases, ostensibly "in an effort to take some of the steam" out of the obscenity issue.

D. The Filibuster

Thurmond was undeterred by such criticism and responded by firing up his movie projector once again:

> Day after day last week, Thurmond buttonholed his colleagues to watch the films in darkened Senate offices. One aide of Richard Nixon called it "the Fortas Film Festival." The Senators were not titillated but shocked, and they left the showings in a grim mood. The screenings apparently swayed some votes away from Fortas. Senators know that

middle-class opposition to pornography is rising, and the subject—like the Supreme Court itself—has become a symbol of what is wrong in the U.S.



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The media lampooned the Fortas Film Festival, referring to Thurmond as "the gentleman Torquemada from South Carolina." An Oliphant cartoon showed a group of senators leering at movie screen. And a Herblock cartoon pictured "Strom Thurmond - U.S. Obscenator" in an office full of pin-ups, whispering to passersby, "Psst – Want to see some dirty pictures?" The New York Times complained that the Fortas hearings were "dominated by Senator Thurmond of South Carolina, whose gutter-level assault on Justice Fortas is based on movies the Senator has been showing Congressmen behind the scenes." Even the *Wall Street Journal* objected, claiming "Senator Thurmond was unnecessarily discourteous to Mr. Fortas. Pornography is not one of the nation's truly burning issues, and showing stag films is not our idea of how to run the world's greatest deliberative body."



A 1968 Herblock Cartoon, copyright by The Herb Block Foundation.

Nevertheless, Thurmond's strategy was working. "Evidently the showing of the movies has become the nub of the effort to recruit new members for the anti-Fortas Senate group, and turn it into a majority rather than a filibustering one-third-plus minority." Public pressure on obscenity was intense, as "[l]etters poured in . . . from persons aroused about the high court's obscenity rulings."

Fortas was now "Mr. Obscenity," and his supporters were on the defensive. Hart complained that the Fortas Film Festival had "soiled" public perception of the Senate, giving the impression that Senators "have been slipping into innumerable private showings" of obscene films. And he insisted, "Those who hold up reels of film as an indictment of the Supreme Court should, in fairness, point out that the Supreme Court never commented on the content of those films."

The committee report on Fortas recommended confirmation, warned that a filibuster would set "a dangerous precedent," and urged senators to "shun support of such an ignoble venture." But minority reports from Fortas's opponents rejected the majority's conclusions and continued to hammer away at Fortas's record. McClellan singled out *Flaming Creatures*, emphasizing that it "comprised of several separable sequences, all of them depicting some form of transvesticism or abnormal sexual behavior," and that Fortas was the only vote to reverse. "Apparently Mr. Justice

Fortas felt that the film had some social value, did not go beyond customary limits of candor in representing sexual matters, and that the average person would not consider it as appealing to a prurient interest." Even Fortas's supporters conceded that confirmation was increasingly unlikely.

On September 25, the Senate debate on the Fortas nomination opened, and the filibuster began. Fortas's opponents took the floor and ponderously repeated every criticism they had already levied against Fortas, reserving special attention for his record on obscenity. McClellan singled out *Flaming Creatures* as a particularly disturbing example of a film protected by Fortas. "One film that came out in New York is called 'Flaming Creatures.' And, brother, that is an understatement. It makes one sick to look at it. It is despicable. Depraved acts are displayed in the film." Thurmond also used *Flaming Creatures* to illustrate Fortas's extreme position on obscenity, insisting that "it is evident from reading Chief Justice Warren's dissent and from the descriptions of the film by Senators who have seen it, that the Court as well as most citizens would agree that '*Flaming Creatures*' is obscene." He continued, "I think it is very significant to note that Justice Fortas stated in this case that he would have reversed the lower court's decision."

The filibuster was still going strong when Dirksen announced on September 27 that he would not vote for cloture. Without Dirksen's support, the nomination was doomed. When the Senate took a cloture vote on October 1, the count was 45 in favor and 43 against—14 votes short of the two-thirds majority needed.

At Fortas's request, Johnson withdrew the nomination the following day. Fortas's opponents had won. And they owed their hard-fought victory to smut. Lausche spoke for many of his colleagues when he explained that he had voted against cloture because "a Court majority including Mr. Fortas 'approved' the showing of 'dirty' movies in obscenity cases." As Eastland later observed, "I think there is one thing that hurt Fortas, hurt him very badly, and that was the pornography decisions."

E. The Aftermath

Fortas returned to the Supreme Court in October 1968 as an associate justice, not as chief justice. Then, on May 9, 1969, William Lambert published an article in Life, alleging that Fortas had recused himself from a criminal appeal because he had a secret financial relationship with the defendant. Lambert revealed that Fortas had accepted $20,000 from the Wolfson Family Foundation for work on "educational and civil rights projects," only to return the money after Louis Wolfson "had been twice indicted on federal criminal charges" for securities fraud. Fortas denied the

allegations, but the Justice Department soon discovered that Wolfson had actually agreed to pay Fortas $20,000 every year, for the rest of Fortas's life and that of his wife. Faced with this damning evidence, Fortas resigned on May 14, 1969.

In the meantime, *Flaming Creatures* began to reach new audiences, some of which were more receptive than others. When Yale Law School staged a reprise of the Fortas Film Festival, one student described Flaming Creatures as "a harmless, stupid stag movie." A belated review in *Variety* was also quite dismissive:

> Assembled in 1963, Jack Smith's transvestivision excess, "*Flaming Creatures*," clumsily portrays sexual deviations, while pointing up not only the grossness of the physical contacts but the sadness of the emotional-mental conflicts. Homohouses might profit on a quick turn, but six-year-old film, reputedly cutoff in several U.S. cities because of offensive nature, isn't so much obscene as grotesque. Poor quality of lensing, remarkable imbalance of sound-over music, and seedy orgy add up to a naive, curiously sad film.

Flaming Creatures remained a target of occasional obscenity raids for several years. But the taint of obscenity gradually faded, as pornographic films became increasingly explicit. "Ironically, the content of *Flaming Creatures* pales or more appropriately blushes compared to the likes of Behind the Green Door, The Devil in Miss Jones, and Deep Throat – all of which have been shown on-campus this semester." Eventually, *Flaming Creatures* was widely recognized as an exceptional work of art. Today, it is the subject of many books, many more museum exhibitions, and countless presentations at movie theaters and colleges across the country and around the world.

VI. *Flaming Creatures* AND THE DIALECTIC OF OBSCENITY

Why did obscenity disappear and how did it happen? The Supreme Court redefined obscenity in order to protect art but soon held that the First Amendment protected pornography as well. According to the conventional history of obscenity, this outcome was inevitable, or at least implied by First Amendment doctrine. As Brennan ruefully observed, "the concept of 'obscenity' cannot be defined with sufficient specificity and clarity to provide fair notice to persons who create and distribute sexually oriented materials, to prevent substantial erosion of protected speech as a byproduct of the attempt to suppress unprotected speech, and to avoid

very costly institutional harms." Art and obscenity are in the eye of the beholder, so the obscenity doctrine necessarily reduces to "I know it when I see it."

But the conventional history of obscenity is incomplete because it does not account for the dialectic of obscenity. The obscenity doctrine is manifestly arbitrary and illogical. After all, "[t]he life of the law has not been logic: it has been experience." The Court tried to distinguish between art and pornography, despite the incoherence of the obscenity doctrine. Most notably, it adopted the pandering test, which theoretically demanded the conclusion that stag films are obscene, but *Flaming Creatures* is not.

Obscenity did not disappear because the obscenity doctrine was incoherent. It disappeared because the Court realized that it could not protect art unless it protected pornography as well. That is the dialectic of obscenity. Doctrinally, the protection of art required the protection of pornography because the distinction is necessarily viewpoint-based. Politically, the protection of pornography enabled the protection of art by establishing that certain categories of sexual expression are protected speech. Together, these opposing principles gradually ratcheted open the gates of obscenity.

The story of *Flaming Creatures* and the Fortas Film Festival illustrates the dialectic of obscenity. The Court adopted the pandering test in order to distinguish between art and pornography. But it was not prepared for the result. Fortas applied the pandering test and concluded that *Flaming Creatures* was a work of art, not pornography. The other justices disagreed. They realized that the pandering test was unworkable when they saw that it protected disturbing and socially unacceptable art while suppressing distasteful but socially acceptable pornography. They could stomach *O-7*, but not *Flaming Creatures*. Rejecting the pandering test allowed them to protect *O-7* and suppress *Flaming Creatures*, at least temporarily. But ironically, the protection of *O-7* ultimately required the protection of *Flaming Creatures*. If the First Amendment protected nudity in a stag film, it had to protect nudity in *Flaming Creatures* as well.

The subtext of the Fortas Film Festival was that the senators were titillated by *O-7* and shocked by *Flaming Creatures*. When Fortas's opponents saw *O-7*, they knew that smut could justify a filibuster. Many of them surely found the film distasteful, but they watched it anyway. Notably, they were able to describe the contents of the film in great detail when they criticized Fortas for voting that it was not obscene.

By contrast, the senators were horrified by *Flaming Creatures*. Many refused to watch the whole film and none could bring themselves to describe it in any detail. Recall the anonymous senator's comment, "That film was so sick, I couldn't even get

aroused." Tellingly, when Detective Shaidell testified in the second round of Fortas hearings, he brought *Un Chant d'Amour*, rather than another stag film. Fortas's opponents understood *O-7*, even if they rejected it, but they could not understand *Flaming Creatures* and *Un Chant d'Amour* and were shaken by them.

Of course, the justices, and the senators alike, were reacting primarily to the homosexual content of *Flaming Creatures* and *Un Chant d'Amour*, not their formal aesthetic qualities. While they avowedly disapproved of the depiction of naked women in *O-7*, *O-12*, and D-15, they were shocked or disgusted by the suggestion of gay sex in *Un Chant d'Amour* and the polymorphous perversity of *Flaming Creatures*. And the contours of the obscenity doctrine have tracked those feelings. Works that depict minority sexual preferences are especially vulnerable to obscenity charges because juries and judges tend to find the depiction of minority sexual preferences more offensive than the depiction of majority sexual preferences. As a result, the obscenity doctrine has historically discriminated against the depiction of gay and lesbian sex. Indeed, as obscenity prosecutions of artists petered out, the last few targeted works involved gay content, prominently including Robert Mapplethorpe.

Nevertheless, the fact remains that in the 1960s, almost everyone assumed that *Flaming Creatures* was obscene, but today almost everyone would assume that it is not. Nothing in the text of the obscenity doctrine required that change of heart. Nor does it reflect a reassessment of the artistic merit of the film. On the contrary, it is the function of a de facto loosening of the obscenity doctrine in order to protect the depiction of a much wider range of sexual conduct. When the obscenity doctrine protected only the depiction of sexual conduct in artistic works, it was easy for courts to dismiss claims that *Flaming Creatures* is a work of art. But as the obscenity doctrine gradually came to protect the depiction of sexual conduct in frankly pornographic works, it became impossible to justify the suppression of *Flaming Creatures*. By eliminating the need to judge the artistic merits of a work accused of obscenity, the obscenity doctrine finally enabled courts to effectively protect art, albeit at the expense of their ability to prohibit pornography. Perhaps we owe a debt of gratitude to the army of nameless and numberless pornographers who inadvertently helped protect the peculiar vision of *Flaming Creatures*.

VII. CONCLUSION

The conventional history of obscenity holds that art protects pornography. The story of *Flaming Creatures* and the Fortas Film Festival suggests that pornography also protects art. This relationship expresses the dialectic of obscenity.

COPYRIGHT AS CHARITY

Adam Holland*

I. ABSTRACT

Copyright and charity law are generally considered distinct and unrelated bodies of law. But they are actually quite similar and complement each other. Both copyright and charity law are intended to increase social welfare by solving market and government failures in public goods caused by free riding. Copyright solves market and government failures in works of authorship by providing an indirect subsidy to marginal authors, and charity law solves market and government failures in charitable goods by providing an indirect subsidy to marginal donors. Copyright and charity law complement each other by solving market and government failures in works of authorship in different ways. Copyright solves market and government failures in works of authorship by reducing *ex ante* transaction costs, but it increases *ex post* transaction costs. Charity solves market and government failures in works of authorship by reducing both *ex ante* and *ex post* transaction costs. Accordingly, the efficient scope and duration of copyright should reflect *ex ante* transaction costs, because charity can more efficiently reduce *ex post* transaction costs.

II. INTRODUCTION

As George Lakoff and Mark Johnson observed, "[t]he essence of metaphor is understanding and experiencing one kind of thing in terms of another." In other words, metaphors express analogies. For better or worse, legal reasoning depends on analogies. Lawyers argue cases by comparing them to other cases, and judges decide cases by comparing them to previously decided cases. Both assume that similar cases should generally produce similar results and dissimilar cases should generally produce dissimilar results. If it was negligent for a defendant to perform a particular act in a particular circumstance, we assume that it is negligent to perform similar acts in similar circumstances, but do not assume that it is negligent to perform different acts in different circumstances.

Analogical reasoning consists in determining when similarities and differences are relevant, and when they are not. Scholars disagree about the merits of analogical

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reasoning in law. Critics argue that it obscures the general theories that should determine the outcome of cases. But advocates argue that it can reveal the weaknesses of general theories by recognizing the contingent and circumstantial values that they ignore.

But what if analogical reasoning were used to compare general theories of law, rather than particular cases? Perhaps it could help identify relationships between theories that would otherwise be obscured, and thereby improve our understanding of those theories and how they apply in practice.

This Article argues that comparing the prevailing theories of

copyright and charity law reveals that they are strikingly similar and

complementary bodies of law. Copyright and charity law are both intended to increase social welfare by solving market failures in public goods caused by free riding. But they do so by reducing different kinds of transaction costs. It follows that each should be designed to focus on the transaction costs it is best suited to address.

III. WELFARE & COPYRIGHT

In his provocative article *Author's Welfare: Copyright as a Statutory Mechanism for Redistributing Rights*, Tom Bell argues that welfare and copyright are similar because both are statutory entitlements intended to increase social welfare by redistributing personal property rights from members of the general public to particular beneficiaries: "Welfare aims to improve social well-being by helping the poor, whereas copyright aims to improve social well-being by helping those who create expressive works." Welfare redistributes wealth from taxpayers to the poor, and provides the benefit of reducing poverty, at the cost of discouraging work. Copyright redistributes rights from the public to authors, and provides the benefit of increasing the supply of expressive works, at the cost of limiting their use.

More controversially, Bell argues that the success of welfare reform suggests the potential for successful copyright reform. Welfare reform reduced the subsidy provided to the poor by limiting the availability of welfare, and Bell claims that it was successful because it encouraged work without increasing poverty. Based on the success of welfare reform, Bell argues that copyright reform limiting the scope of copyright would increase the use of expressive works, without reducing their supply.

Of course, there are weaknesses in Bell's argument. To begin with, many people disagree with his assertion that welfare reform was successful, or that it encouraged

work without increasing poverty. If welfare reform was not successful, perhaps copyright reform would also not be successful.

More fundamentally, Bell's comparison of welfare and copyright is strained, because they are not as similar as he suggests. Bell himself admits that the analogy is not perfect, because copyright "looks a lot more like property than welfare does." Specifically, copyright provides rights to exclude, but welfare only provides a right to due process. He argues that his analogy still holds, because welfare and copyright are both statutory entitlements, not property rights.

But Bell ignores other differences between welfare and copyright which are fatal to his analogy. First, welfare provides a direct subsidy to the poor, but copyright provides an indirect subsidy to authors. As a result, the burden of welfare falls on the government, but the burden of copyright falls on consumers of works of authorship. Second, welfare is vulnerable to government failures caused by majoritarian politics, but copyright is vulnerable to government failures caused by rent-seeking. Third, welfare is intended to increase static efficiency by improving the allocation of wealth, but copyright is intended to increase dynamic efficiency by encouraging the creation of works of authorship. And fourth, welfare is a common-pool resource because it is rivalrous, but works of authorship are public goods because they are non-rivalrous.

While the differences between welfare and copyright render Bell's conclusions unconvincing, the analogy that he draws between welfare and copyright still improved our understanding of copyright by showing that it is best understood as a form of statutory entitlement, rather than a form of physical property. It follows that the scope and duration of copyright protection ought to be determined in relation to other statutory entitlements, rather than in relation to physical property. Moreover, even the limited success of Bell's analogy suggests that alternative analogies may further improve our understanding of copyright. Specifically, this Article argues that comparing copyright and charity law can improve our understanding of both areas of law, and show how they complement each other.

IV. COPYRIGHT & CHARITY LAW

The prevailing theories of both copyright and charity law are economic subsidy theories, which hold that copyright and charity law are justified because they increase social welfare by solving market and government failures caused by free riding. This formal similarity of the respective theories of copyright and charity law is reinforced by a substantive similarity in their purpose. The purpose of copyright is

to increase public welfare by solving market failures in works of authorship, which are a particular form of public good, and the purpose of charity law is to increase public welfare by solving market failures in charitable goods, which include. a broad range of public and quasi-public goods, including works of authorship. In other words, works of authorship are a category of charitable goods, and copyright is arguably a category of charity law, or rather, the continuation of charity by other means.

A. The Economic Subsidy Theory of Copyright

The economic subsidy theory of copyright holds that it is justified because it solves market and government failures in works of authorship caused by free riding. Works of authorship are non-rivalrous—or *public* goods—because the consumption of a work of authorship does not affect the supply. Classical economics predicts that free riding will cause market failures in public goods, because rational economic actors will consume the good without paying the marginal cost of production.

Copyright solves market failures in works of authorship by making them excludable and thereby enabling authors to recover their fixed costs and opportunity costs. In other words, copyright indirectly subsidizes authors by giving them certain exclusive rights to use works of authorship for a certain period of time. As a result, authors can internalize some of the positive externalities or *spillovers* generated by the creation of a work of authorship by charging consumers more than the marginal cost of production. Essentially, copyright provides an incentive for marginal authors to invest in the production of works of authorship.

Of course, direct subsidies can also solve market failures in works of authorship caused by free riding. For example, governments directly subsidize the production of works of authorship by distributing grants to authors. But these direct subsidies are vulnerable to government failures caused by rent-seeking and transaction costs, especially information costs. Public choice theory predicts that rent-seeking will cause governments to distribute grants inefficiently, and classical economics predicts that information costs and other transaction costs will prevent governments from distributing grants efficiently. In others words, governments cannot know which authors to subsidize, and politics creates incentives to subsidize the wrong authors.

Copyright solves government failures in works of authorship by reducing certain forms of rent-seeking and transaction costs. Copyright reduces *ex ante* rent-seeking by subsidizing all authors in relation to the economic value of their work of authorship. Copyright also reduces *ex ante* transaction costs by enabling marginal

authors to decide whether the private cost of investing in authorship is smaller than the private benefit provided by copyright. Presumably, individual authors can gather and assess relevant information more efficiently than governments.

B. The Economic Subsidy Theory of Charity

The economic subsidy theory of charity law holds that it "is justified because it solves market . . . and government failures in charitable goods" caused by free riding. Charitable goods resemble public goods because they are either actually or ideally non-rivalrous. For example, religion is actually non-rivalrous because the consumption of religion does not affect the supply; food banks are ideally non-rivalrous because they are intended to provide food to all who require it. Accordingly, "[c]lassical economics predicts that free riding will cause market failures in [charitable] goods."

Charity law solves market failures in charitable goods by enabling certain donors to deduct certain charitable contributions from their income tax base, thereby compensating for free riding on charitable contributions by indirectly subsidizing altruism. In other words, charity law indirectly subsidizes the production of charitable goods by reducing the cost of altruism. Essentially, charity law provides an incentive for marginal donors to invest in the production of charitable goods, thereby generating positive externalities.

Of course, direct subsidies can also solve market failures in charitable goods caused by free riding. Governments can and do directly subsidize the production of charitable goods by distributing grants to charities. But these direct subsidies are vulnerable to market failures caused by rent-seeking and transaction costs. Public choice theory predicts that rent-seeking will cause governments to distribute grants inefficiently, and classical economics predicts that information costs and other transaction costs will prevent governments from distributing grants efficiently. In others words, governments cannot know which charities to subsidize, and politics creates incentives to subsidize the wrong charities.

Charity law solves government failures in charitable goods by reducing certain forms of rent-seeking and transaction costs. Charity law reduces rent-seeking and transaction costs by subsidizing altruism, depending on donors to identify worthy charities. Presumably, individual donors can gather and assess relevant information more efficiently than governments.

C. Comparing Copyright & Charity Law

The structural similarity of the economic subsidy theories of copyright and charity law is obvious. Both hold that indirect subsidies are justified because they solve market and government failures in a public good and thereby increase social welfare. Copyright is justified because it increases social welfare by providing an incentive to create works of authorship, and charity law is justified because it increases social welfare by providing an incentive to make charitable contributions.

The economic subsidy theories of copyright and charity law are welfarist theories, which hold that copyright and charity law are justified because they are efficient. In other words, copyright and charity law are justified because their social benefit is larger than their social cost, so they actually increase social welfare. It follows that the justification of both copyright and charity law depends on a testable hypothesis. According to the economic subsidy theory, copyright is justified because the social benefit of increasing the production of works of authorship is actually larger than the social cost of increasing the scope or duration of copyright protection, and charity law is justified because the social benefit of increasing the production of charitable goods is larger than the social cost of reduced tax revenue. Or rather, copyright and charity law are justified because they increase social welfare on the margins. But that hypothesis is inconsistent with the doctrine and development of both copyright and charity law.

D. The Justification for Copyright

Copyright doctrine is inconsistent with its welfarist justification because the scope and duration of copyright protection is uniform for all works of authorship, even though the efficient scope and duration of copyright protection necessarily depend on the circumstances. Each work of authorship necessarily has unique fixed costs of production, and each author necessarily has unique opportunity costs. Moreover, some authors may choose to invest in the production of works of authorship even if they cannot recover their fixed and opportunity costs. In theory, the scope and duration of copyright protection should vary from author to author and from work to work.

Of course, it is practically impossible to tailor the scope and duration of copyright protection to particular authors and works. But the scope and duration of copyright protection does not even vary among categories of works with manifestly different fixed and opportunity costs. As Brad Greenberg has memorably observed, Copyright protection under the 1976 Act is like an Oprah giveaway: Everybody gets

one. An email, a novel, a home video, and a feature film all receive copyright protection of the same scope and duration.

In addition, the actual scope and duration of copyright protection were not determined in relation to its ostensible welfarist justification. Congress did not seriously consider marginal efficiency when it determined the scope and duration of copyright protection. And courts explicitly refrain from considering the marginal efficiency of copyright protection when reviewing its legitimacy.

Moreover, the economic subsidy theory assumes that copyright is justified because authors are rational economic actors, and marginal authors will decide whether to invest in creating works of authorship based on whether they can expect to recover their costs. But in practice, many authors are not exclusively rational economic actors, and choose to invest in the production of works of authorship even if they do not expect to recover their costs. In fact, because copyright automatically protects even the most trivial works of expression, copyright protection is not a salient incentive to the overwhelming majority of authors who receive copyright protection. For example, copyright protects emails and snapshots, but does not provide a salient incentive to produce those works of authorship. The economic theory holds that copyright is justified because it increases social welfare; so to the extent that copyright protection is not a salient incentive, it is not justified.

E. The Justification for Charity Law

Charity law doctrine is also inconsistent with its welfarist justification because the indirect subsidy provided by the charitable contribution deduction is unrelated to the market and government failures that it ostensibly solves. The charitable contribution deduction indirectly subsidizes the production of charitable goods by allowing certain donors to deduct certain charitable contributions from their income tax base. As a consequence, the higher the marginal income tax rate on the donor, the larger the subsidy, and the lower the marginal income tax rate on the donor, the smaller the subsidy. But there is no relationship between a donor's marginal income tax rate and the market and government failures associated with the recipient of that donor's charitable contribution. If anything, they may be negatively correlated.

In addition, the charitable contribution deduction is a salient incentive to only a small minority of donors. Taxpayers can claim charitable contribution deductions only if they itemize their deductions, but only about thirty percent of taxpayers itemize their deductions. As a result, the charitable contribution deduction is not a salient incentive for the seventy percent of taxpayers who do not itemize their

deductions, and is a considerably less salient incentive for low-income taxpayers than it is for high-income taxpayers.

Moreover, the economic subsidy theory assumes that charity law is justified because donors are rational economic actors, and marginal donors will decide whether to make charitable contributions based on whether they will receive a deduction. But in practice, many donors are not exclusively rational economic actors, and choose to make charitable contributions even though they do not expect to receive a deduction. The economic subsidy theory holds that charity law is justified because it increases social welfare, so to the extent that the charitable contribution deduction is not a salient incentive to a particular donor, it is not justified.

V. COPYRIGHT AS CHARITY

While the premises of the economic subsidy theories of copyright and charity law are inconsistent with copyright and charity law doctrine, their structural similarities illuminate their complementary relationship. The purpose of copyright is to increase public welfare by providing an incentive for marginal authors to invest in the production of works of authorship, and the purpose of charity law is to increase public welfare by providing an incentive for marginal donors to invest in the production of charitable goods.

Essentially, works of authorship are a category of charitable goods. Works of authorship and charitable goods both increase public welfare by providing a public good. In fact, charity law provides that subsidizing the production and distribution of works of authorship is a charitable purpose.

It follows that copyright and charity law ought to be evaluated in relation to one another. Under the economic subsidy theories of copyright and charity law, indirect subsidies are justified to the extent that they are efficient. If copyright is intended to increase public welfare by providing an incentive for marginal authors to invest in the production of works of authorship, copyright is justified only to the extent that it is more efficient than charity law at providing incentives for marginal authors to invest in charitable goods.

A. Copyright & Efficiency

Copyright efficiently reduces *ex ante* transaction costs that cause market failures in works of authorship by devolving the decision—whether to invest in the production of works of authorship—onto marginal authors, who are generally in the

best position to determine whether investing in a work of authorship is likely to increase social welfare. Moreover, copyright forces authors to assume the risk of their investment by providing a subsidy only if an author actually produces a work of authorship with social value. Accordingly, copyright is generally highly efficient to the extent that it enables authors to recover the fixed and opportunity costs of investing in the production of works of authorship. While many authors would choose to invest in the production of works of authorship whether or not they received a subsidy, copyright presumably provides at least a marginal incentive to authors who contemplate investing more than a nominal amount of resources in producing a work of authorship.

However, copyright is inefficient to the extent that it provides a subsidy in excess of the fixed and opportunity costs of investing in the production of works of authorship, not only because those subsidies do not provide a marginal incentive, but also because they increase transaction costs. To the extent that authors are rational economic actors, a subsidy that exceeds the fixed and opportunity costs of investing in works of authorship is inefficient; it provides an incentive to overinvest in the production of works of authorship. The purpose of copyright is to encourage authors to invest in the production of works of authorship that will increase social welfare. Increasing the subsidy to works of authorship provides an incentive to invest in the production of works of authorship even if they will not increase social welfare.

In addition, copyright increases *ex post* transaction costs by increasing the cost of consuming a work of authorship and increasing information costs relating to the use of that work of authorship. Transaction costs imposed by copyright protection are justified to the extent that they are offset by increases in public welfare. But copyright protection in excess of what is required to provide an efficient incentive to marginal authors is not justified because it creates transaction costs that are not offset by increases in public welfare. In other words, copyright protection that does not provide an efficient incentive to marginal authors provides a private benefit without generating a corresponding public benefit, and reduces public welfare.

To make matters worse, public choice theory predicts that copyright is vulnerable to rent-seeking because authors have a strong incentive to lobby the government to increase the scope and duration of copyright protection, irrespective of its efficiency. In particular, owners of valuable copyrights have an incentive to invest in lobbying the government to increase the value of those copyrights.

B. Charity Law & Efficiency

Charity law efficiently reduces transaction costs that cause market failures in charitable goods by devolving the decision—whether to invest in the production of charitable goods—onto marginal donors, who are often in good position to determine whether investing in the production of a charitable good is likely to increase social welfare. Specifically, donors are reasonably well-positioned to determine whether investing in the production of a work of authorship is likely to increase public welfare. If altruism motivates a donor to make a charitable contribution to the production of a work of authorship, it is likely that the production of that work of authorship will increase social welfare, and is thereby likely that any indirect subsidy provided by the government will be efficient. In addition, if altruism motivates a donor to make a charitable contribution to the distribution of a work of authorship or the support of an author, it is likely that the contribution will increase social welfare by enabling that author to produce additional works of authorship, and is thereby likely that any indirect subsidy provided by the government will also be efficient.

C. Comparing the Efficiency of Copyright & Charity Law

While copyright efficiently reduces *ex ante* transaction costs relating to investments in the production of charitable goods, it increases *ex post* transaction costs. By contrast, charity law reduces both *ex ante* and *ex post* costs. Copyright reduces *ex ante* transaction costs more efficiently than charity law, because authors are generally in a better position than donors to determine whether investing in a work of authorship will increase social welfare. But copyright increases *ex post* transaction costs by granting windfalls to authors and creating opportunities for rent-seeking, while charity law is associated with low *ex post* transaction costs, because it depends on altruism.

It follows that copyright should focus on providing *ex ante* incentives to marginal authors, and rely on charity law or its analogues to provide any additional subsidies to authors. Charity law is especially well-suited to this goal, because it relies on altruism, rather than self-interest. Copyright assumes that authors invest in the production of works of authorship in order to benefit themselves. By contrast, charity law assumes that donors invest in the production of works of authorship in

order to benefit the public. Charity law is likely to increase public welfare because it subsidizes donations intended to increase public welfare.

But there are additional reasons to consider reducing the scope and duration of copyright and to consider relying on charity rather than copyright to increase investment in works of authorship. Historically, transaction costs made it difficult for donors to determine which marginal authors to subsidize. Donors did not know which authors to subsidize, and did not have a convenient way to make contributions. Moreover, charity law created incentives for them to donate to charities rather than individual authors.

Accordingly, donors contributed to charitable organizations, which solved transaction costs by developing expertise in identifying which artists to subsidize and provided charitable contribution deductions. But authors and donors also developed legal workarounds, which enabled them to steer charitable contributions to particular authors. And more recently, social entrepreneurs have developed methods of using technology to solve charity failures, and more efficiently encourage and enable marginal donors to make donations in support of the production of works of authorship.

1. Fiscal Sponsorship

For example, in the arts sector, donors and authors use *fiscal sponsorship* in order to enable donors to both support particular authors or particular projects and claim a charitable contribution deduction. In theory, charity law only permits taxpayers to claim charitable contribution deductions for donations to charitable organizations that are exempt under 26 I.R.C. § 501(c)(3). As a consequence, it does not allow taxpayers to claim charitable contribution deductions for donations to individuals, which are generally treated as gifts for income tax purposes.

Donors and authors use *fiscal sponsors* in order to circumvent that restriction. A *fiscal sponsor* is a charitable organization that receives charitable contributions from donors on behalf of particular authors. The donor claims a charitable contribution deduction, the charity claims a fee, and the author receives the balance of the donation. Essentially, fiscal sponsorship is a legal fiction that enables donors to claim a deduction for a contribution to an individual. In theory, the charity receiving the contribution is not obligated to pass the donation on to its intended private recipient, and makes an independent determination that providing funds to that author is consistent with its charitable purpose. But this obligation is observed almost entirely in the breach, and charities acting as fiscal sponsors effectively function as conduits

for donations that would otherwise be ineligible for charitable contribution deductions.

Interestingly, the IRS has tolerated the practice of fiscal sponsorship, despite its apparent inconsistency with federal tax law. The best explanation for the IRS's forbearance is probably that while fiscal sponsorship may strain the letter of the law, it is generally consistent with its purpose. Charities generally exercise at least some oversight over the authors and projects they agree to sponsor, and sponsoring works of authorship is generally a charitable activity.

In addition, fiscal sponsorship may help solve market failures associated with works of authorship by reducing transaction costs associated with determining which works to sponsor. It is costly for charities to determine which authors and projects to sponsor, and it is difficult for charities to solicit funds to sponsor works of authorship in general, rather than specific projects. Fiscal sponsorship reduces these transaction costs by enabling donors and authors to make a direct connection, without a mediating charity.

In any case, the prevalence of fiscal sponsorship suggests that charity law provides a salient incentive to at least some marginal donors. In the absence of fiscal sponsorship, donors could still make gifts to individual authors. The primary purpose of fiscal sponsorship is to ensure that donors can claim a charitable contribution deduction for their donation. Presumably, the ability to claim a charitable contribution deduction motivates at least some marginal donors to give.

However, fiscal sponsorship has a critical weakness, which is a function of its reliance on leveraging the charitable contribution deduction in the service of reducing transaction costs. Because fiscal sponsorship depends on the salience of the charitable contribution deduction, it cannot provide a salient incentive to marginal donors who cannot claim the deduction. As a result, the overwhelming majority of taxpayers should be indifferent to fiscal sponsorship.

2. Crowdfunding

As I have previously shown, charity law is vulnerable to charity failures, or inefficiencies in its ability to solve market and government failures, caused by the inability of the charitable contribution deduction to provide a salient incentive to the overwhelming majority of taxpayers who do not itemize their deductions. I argue that the remarkable success of crowdfunding—which already provides more arts funding than the federal government—is a function of its ability to solve some of those charity failures. First, crowdfunding reduces transaction costs associated with

soliciting donations, by providing authors with low-cost platforms that make it easy to leverage the network effects of social media. Second, crowdfunding reduces transactions associated with making donations, by reducing search and information costs on donors. And third, reward-based crowdfunding enables authors to provide salient incentives to marginal donors who cannot claim charitable contribution deductions.

Essentially, crowdfunding is a way of using technology to solve charity failures. Of course, crowdfunding works of authorship is generally not charitable in the strictest sense, as most donations are not charitable contributions under the Internal Revenue Code. However, it is often charitable in the broader sense that the contributions include a gratuitous element and are intended to support the creation of works of authorship that will increase public welfare.

3. Open-Source

The open-source movement is another way of using technology to solve charity failures. Open-source is a development model that provides universal access to works of authorship by providing a free license to use and distribute the work, and by requiring that authors of derivative works also provide a free license to use and distribute the derivative work. The open-source movement initially focused on computer software, enabling authors to provide a free license for the public to use, distribute, and improve source code. But the open-source movement has subsequently expanded to other forms of authorship and innovation, and has inspired many related open licensing schemes, like Creative Commons. Open-source is especially prevalent in various scholarly fields, and there is an emerging norm among scholars in many fields to provide open access to all of their papers and research.

Essentially, open-source is a way of using the Internet and social media to reduce transaction costs associated with copyright and other forms of intellectual property. Historically, works of authorship were distributed by commercial intermediaries, which reduced transaction costs by enabling authors to effectively distribute works of authorship to the public. The Internet and social media have rendered many of those commercial distributors largely irrelevant by enabling authors to effectively distribute certain categories of works of authorship to the public at no cost. Many authors do not need to recover the fixed and opportunity costs of authorship. For example, most scholars produce works of authorship as a function of their employment. As a consequence, open-source is attractive to scholars, as it enables them to distribute their works of authorship at no cost to the consumer, thereby increasing its distribution in the academic gift economy.

VI. CONCLUSION

Copyright and charity law are similar because they both use indirect subsidies to solve market and government failures in public goods caused by free riding. Copyright solves market and government failures in works of authorship, a particular category of public goods. Charity law solves market and government failures in charitable goods, which include a broad range of public and quasi-public goods, including works of authorship. Copyright solves market failures in works of authorship by making them partially excludable and thereby limiting free riding, and solves government failures by reducing information costs associated with determining which works to subsidize. Charity law solves market failures in charitable goods by making certain charitable contributions deductible, and thereby compensating for free riding, and solves government failures by reducing transaction costs associated with majoritarian politics. In other words, copyright and charity law are complements that use different means to pursue similar goals.

Notably, copyright and charity law are associated with different transaction costs. Copyright efficiently reduces *ex ante* transaction costs by delegating the decision whether to invest in works of authorship onto marginal authors and by forcing them to internalize the risk associated with investing in works of authorship. But copyright increases *ex post* transaction costs by making it more difficult and expensive for consumers to use works of authorship. Moreover, copyright encourages rent-seeking by the copyright owners of works with substantial social value.

By contrast, charity law moderately reduces both *ex ante* and *ex post* transaction costs by delegating the decision whether to invest in charitable goods onto marginal donors, and by providing a relatively modest and contingent subsidy. While copyright reduces *ex ante* transaction costs associated with investment charity law more efficiently than charity law, copyright increases *ex post* transaction costs, and charity law does not. In addition, new technologies like crowdfunding and the open-source movement enable authors and donors to solve certain market and government failures previously addressed by copyright and charity law without the need for the indirect subsidies that copyright and charity law use to provide incentive to marginal authors and donors.

As a consequence, we should consider reducing the scope of copyright protection to focus on its ability to efficiently reduce *ex ante* transaction costs by enabling authors to recover their fixed and opportunities costs, and use charity law and related technologies to reduce *ex post* transaction costs associated with investment in the creation of works of authorship.

SCENES FROM THE COPYRIGHT OFFICE

Meredith Rose[*] & Blake Reid[†]

In his iconic song, "Scenes from an Italian Restaurant," Billy Joel uses a series of vignettes to describe an encounter between two former classmates, meeting again after many years. The song begins as a ballad as they exchange pleasantries, segues into jazz as they reminisce about high school, shifts to rock as they gossip about the decline and fall of the former king and queen of the prom, then returns to a ballad as they part. The genius of the song is that the banality of the vignettes perfectly captures the subjective experience of its protagonists.

This essay uses a series of vignettes drawn from Joel's career to describe his encounters with copyright law. It begins by examining the ownership of the copyright in Joel's songs. It continues by considering the authorship of Joel's songs, and it concludes by evaluating certain infringement actions filed against Joel. This Essay observes that Joel's encounters with copyright law were confusing and frustrating, but also quite typical. The banality of his experiences captures the uncertainty and incoherence of copyright doctrine.

I. OWNERSHIP

The Copyright Act (the "Act") provides, "Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression," and "vests initially in the author or authors of the work." In other words, the copyright in an original work of authorship initially belongs to the authors of the work and protects the original elements of the work. Copyright protects, inter alia, musical works and sound recordings. As a result, the authors of a song may own copyrights in both the song and in particular recordings of performances of the song.

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William Martin “Billy” Joel was born in the Bronx on May 9, 1949, and grew up in Hicksville, Long Island. He learned to play piano as a child, and on February 21, 1964, he joined the Echoes, a high-school cover band. As the popularity of the Echoes grew, Joel met the record producer George “Shadow” Morgan, who recorded him playing piano on “Remember (Walking in the Sand)” and “Leader of the Pack” for the Shangri-Las.

The Echoes soon learned that another band was using the same name, so they became Billy Joel and the Hydros, then the Emerald Lords, and finally the Lost Souls. They also started performing original songs written by Joel. In late 1965, the Lost Souls signed a recording contract with Mercury Records as the Commandos, because another band was using the name the Lost Souls. While they recorded a few songs written by Joel, they never finished the album, and Mercury eventually shelved the project.

In April 1967, Joel learned that he could not graduate from high school without attending summer school, because he had too many absences, so he quit. According to Joel, he responded, “The hell with it. If I’m not going to Columbia University, I’m going to Columbia Records, and you don’t need a high school diploma over there.”

The Commandos soon disbanded, and Joel joined the Hassles, another popular Long Island band. The Hassles signed a contract with United Artists and recorded two albums, *The Hassles* (1967) and *Hour of the Wolf* (1969), both of which featured songs written by Joel. In 1970, the Hassles disbanded, and Joel formed Attila, a “heavy metal” duo, with drummer Jon Small. Attila signed a contract with Epic Records and recorded *Attila* (1970), an album of songs written by Joel and Small, but the album was unsuccessful and Attila soon disbanded.

As an author of the original songs performed by the Lost Souls, the Hassles, and Attila, Joel may have owned some or all of the copyrights in both the underlying musical works and the sound recordings in which they were fixed. However, he probably transferred certain copyrights to Mercury, United Artists, and Epic in the recording contracts. In any case, the current owner or owners of the copyright in those works are difficult to determine with any certainty.

II. TRANSFER

Copyright consists of a set of exclusive rights to use a copyrighted work, which “may be transferred in whole or in part by any means of conveyance or by operation of law.” In other words, the author of an original work of authorship initially owns

the exclusive rights to use that work and can transfer those rights to others via contract. Recording contracts typically provide that the artist transfers some or all of the copyrights in the musical works and sound recordings to the record company in exchange for a fixed sum of money, a percentage of the profits, or both.

In 1971, Joel recorded a voice and piano demo extended play recording ("EP") of five original songs. His manager Irwin Mazur gave a copy of the EP to Michael Lang, who passed it on to Artie Ripp, the owner of Family Productions, an independent label under contract with Paramount Records. Ripp immediately called Mazur and signed Joel to a ten-record contract with Family Productions, which transferred most of Joel's copyrights to Ripp and Lang, in exchange for a monthly payment. As Joel recalled:

> The guy who managed Attila [Irwin Mazur] got me a deal somehow to make a record. I now know that to get that record deal, I signed away all my publishing, all my copyrights, most of my royalties. It was a real screw job. I didn't know what I was signing. But I probably would have signed anything to get a deal. I got an advance so I could buy a piano and pay the rent. I prepared a record thinking that the best way to get people to record my songs is to get them to hear them. And if you want to get people to hear your record, you go out on the road and tour. So it ended up being the same thing again, but I at least felt I had more control over it.

On another occasion, Joel recalled:

> "A.G.: Your first record deal as a solo performer, in 1970, was with the producer Artie Ripp and was notoriously bad.
>
> B.J.: Yeah, I pretty much gave up my publishing, my copyrights, my royalties. He had to get his pound of flesh."

In fact, Joel's contract with Ripp was so notorious in the record industry that it inspired a slang term for a one-sided contract: a Ripp- Off. As Joel observed:

> I ended up on Artie Ripp's record label and production company which is based in L.A. and did not have an attorney representing me at the time. I was 21, I was old enough to sign, I signed away my publishing, my record rights, my copyrights, my record mechanical, my touring monies. I just signed away everything, I was like 'Hey, I got a record deal!' It's an old story in the music business, no one is clean.

For years, Joel was bitter about his relationship with Ripp and Lang:

> I notice that Family Productions, the company run by Artie Ripp that signed you to Paramount Records, still has Ripp's logo, Romulus and Remus being suckled by that she-wolf, on the label of every one of your albums. Do you think that someday you'll ever be free of Ripp?
>
> [*Shaking his head in disgust*] I don't know. I get a dollar from each album I sell. Ripp gets twenty-eight cents out of that for "discovering me." Once in a while I get pissed off about it, but until the situation changes, it's not really healthy to dwell on it. I deserve that money a lot more than Ripp does, but I signed the papers, so what can I do? It was the only way I could get free of his Family Productions, although he wouldn't let me go entirely. And he seems willing to continue to take the money.
>
> *Do you own your publishing?*
>
> I have a deal with CBS' April-Blackwood Publishing; I do not own my publishing, but I do own my copyrights now - meaning that I own, like, fifty percent. [*Sighs*] Live and learn, eh?

But Joel ultimately recognized that Ripp had taken a chance on him, when no one else would:

> After all the people who passed on me, Artie Ripp was the guy who wanted me to be his artist. Nobody else heard it, nobody else wanted to sign me, nobody else was making me a deal. Artie made me a deal. He heard something. Was what he heard what I wanted to be as an artist? No. Was it my vision of what the record should be? No. Was it a good deal? No, it was a horrible deal. But he's the guy who got me on the radar screen.

Ripp produced Joel's first solo album, *Cold Spring Harbor*, and allegedly spent about $450,000 developing Joel's career. Unfortunately, the album flopped, at least in part because it was recorded at the wrong speed, so Joel sounded like one of the Chipmunks, but also because Paramount failed to promote or properly distribute it. Nevertheless, Joel was popular on tour, even though he received little of the proceeds. Then, on April 15, 1972, Joel appeared on WMMR 93.3 FM Philadelphia and performed his unreleased song "Captain Jack," which soon became an underground hit.

When the tour ended, Joel moved to Los Angeles. In the meantime, Paramount was falling apart. It stopped paying Ripp, who eventually bought out his contracts

with Paramount, including the rights to Joel's copyrights, and started looking for a new recording contract. Joel was frustrated and tried to disappear, performing in piano bars as "Bill Martin," an experience that became the basis for his signature song, "Piano Man." He later recalled:

> During this time, I got a lawyer to begin renegotiating my contract. The record company I had signed to finally figured if they didn't renegotiate, they were never going to get anything from me. I got some of the rights back. It hasn't been until recently that I've owned everything I do.

In any case, Ripp kept looking for a new recording contract for Joel. In 1973, he rejected an offer from A&M Records, then got a better offer from Atlantic Records. But at the same time, Mazur got an offer from Clive Davis of Columbia Records, and Joel insisted on signing a seven-year contract with Columbia. Columbia advised Joel that he could not break his contract with Ripp and Lang. As Ripp rather saltily explained:

> "You wanna say Artie Ripp had a very strong contract?," Ripp asks today. "There was nothing wrong with it, man. If there was something legally wrong with my position, Columbia Records and Billy Joel would have had me the f--k out of there in a day. You think Clive Davis wanted me there? Or that Columbia wanted to pay me what they had to pay me?" Their recommendation, Ripp says, would have been to "shoot the c--------r."

As a result, Joel's contract with Columbia provided that the Family Productions logo, Romulus and Remus being suckled by a she-wolf, would appear on Joel's records, and Joel would pay Ripp and Lang each about 25 cents per record sold. According to Ripp:

> My deal with Columbia was ten original Billy Joel albums, plus the 'best-of.' Anything that came from those albums was part of my deal, and my deal wasn't based on years. My deal was based on ten studio albums. You're not going to give me back the half million dollars I have in, you'll pay me this royalty, you'll pay Billy his royalty, you'll pay him, his producers, and Michael Lang his override from my company. I'm the bad guy who has the contract that couldn't be broken. I get 25 cents a record, okay, Billy didn't have to pay it to me. The record company pays it to me. And that only happened if Billy sold records.

Joel's first three albums for Columbia were modestly successful. In 1973, he recorded *Piano Man*. The title track, which eventually became Joel's signature song, peaked at #25 in 1974 on *Billboard*'s Top 100 chart. Toward the end of 1974, he recorded *Streetlife Serenade*, which reached #35 on *Billboard*'s Top Album chart, and included "The Entertainer," which reached #34 on *Billboard*'s Top 100 chart in 1975. In 1976, he recorded *Turnstiles*, which did not chart, although it included several songs that later became hits, including "New York State of Mind" and "Prelude/Angry Young Man."

Joel's career finally took off in 1977, when his fourth album, *The Stranger*, spent six weeks at #2 on *Billboard*'s Top Albums chart. The album included four Top-25 hits, "Just the Way You Are" (#3), "Movin' Out (Anthony's Song)" (#17), "Only the Good Die Young" (#24), and "She's Always a Woman" (#17), as well as "Scenes from an Italian Restaurant," which became one of Joel's best-known songs. In 1978, Joel recorded *52nd Street*, which became his first #1 album.

According to one biographer, when Joel's original contract with Columbia Records ended in 1981, his manager negotiated a new contract, which obligated Columbia to pay Ripp's percentage: "The only way Billy signed again to Columbia was they said, 'We'll pay the quarter to them. It doesn't come from your money anymore.'" Walter Yetnikoff, the President of Columbia at the time, remembered the events differently:

> I said, "I want Billy Joel's publishing back" - because it included "Piano Man" and stuff. And [Ripp] said, "It's worth a fortune." I said, "I'm going to pay you, I'll give you four hundred grand." He said, "No, no, it's far more. I'm not selling the publishing." And I grabbed him, and I said, "I'll f——n' kill you. I'm a guy from Brooklyn. You can't start with me." I said, "Let me explain something to you. Even if I can't put your head through the wall, you think you're going to succeed in this business when I'm the greatest exec and I'm going to be pissed at you? Anyone that talks to you can't talk to me. I represent CBS." I said, "Anyone who talks to you can't talk to Columbia, Epic, or anything else. You think you're going to live with that very long? As I recall, we bought it back, and I gave his copyrights to Billy as a birthday present."

Another biographer corroborates this version of events, stating that Yetnikoff gave Joel the copyrights for his twenty-ninth birthday. In any event, Joel's relationship with Columbia continues to this day:

> B.J.: Do you know how many compilations there are that people think I put out? People think I'm doing it, and it kind of dilutes what I did in

terms of the album forms. To be fair to Columbia records, I haven't given them anything since 1993, that's 20 years ago.

A.G.: What do you owe them?

B.J.: At this point, probably four or five regular albums. It's indentured servitude when you sign with a record company. I don't even own my own masters. They own the masters.

A.G.: Do you get a regular call from Columbia saying: "Billy, you're short four albums we paid for. What do you have?"

B.J.: No, they just say, "We'd like to put out this." What am I going to do, sue them? I can't stop them.

According to Richie Cannata, Joel recorded - or at least threatened to record - throwaway songs, in order to evade his contractual obligations:

> I remember at one point - and I don't know if Liberty talked about that - but he owed songs to somebody. So, we all made up songs to give him, and recorded them at "sound check." They were really crazy songs, but we made them up just to get out of this deal. "Hey we wrote ten more songs. Now, we've fulfilled that. Can we move on? Now am I out of the publishing deal?" We all kind of participated in that.

To date, Joel has recorded twelve studio albums, all of which were eventually commercially successful, as well as an album of "classical compositions" in 2001. He has written and recorded thirty-three *Billboard* Top 40 hits and has sold more than 150 million records worldwide, making him one of the best-selling recording artists of all time. But the ownership of the copyrights in his musical works and sound recordings is unclear, certainly from the outside, and probably also from the inside, as discussed below.

III. TERMINATION OF TRANSFER

The Copyright Act provides, *inter alia*, that the author of an original work of authorship can terminate a transfer or license of the copyright in that work after a specified period of time. The termination right is non-transferable and non-waivable, and can be exercised "notwithstanding any agreement to the contrary." Specifically, Section 304 of the Copyright Act provides that the author of a work copyrighted before January 1, 1978 can terminate a transfer or license of the copyright in that

work executed before January 1, 1978, "at any time during a period of five years beginning at the end of fifty-six years from the date copyright was originally secured, or beginning on January 1, 1978, whichever is later." And Section 203 of the Copyright Act provides that the author of a work can terminate a transfer or license of the copyright in that work executed on or after January 1, 1978, "at any time during a period of five years beginning at the end of thirty-five years from the date of execution of the grant."

The termination right was intended to benefit authors by enabling them to reclaim the copyright in their works of authorship, in two different ways. The Copyright Act of 1976 changed the duration of copyright from an initial term of 28 years and a renewal term of 28 years to a fixed term of the life of the author plus 50 years. Section 304 was intended to enable the authors of works created before the change in the copyright term to reclaim any extension of the copyright term. By contrast, Section 203 was intended to enable the authors of works created after the change in the copyright terms to reclaim the copyright in works that proved more valuable than originally anticipated.

Notably, a literal reading of Sections 203 and 304 appears to create a potential gap in the coverage of the termination right. Section 304 only applies to works created and transferred before January 1, 1978, and Section 203 only applies to works transferred on or after January 1, 1978. But what about works created after but transferred before January 1, 1978? For example, recording contracts typically provide for the transfer of copyright in works to be created in the future. If a recording artist signed such a contract before January 1, 1978 that covers works created after that date, the termination right arguably does not apply, although the better reading is probably that those works were constructively transferred when they were created.

In any case, the termination right lay largely dormant for 35 years, but the day of reckoning has finally arrived. Under Section 203, authors who transferred or licensed a copyright on January 1, 1978 could file a termination notice on January 1, 2011 and reclaim the copyright on January 1, 2013.

While the termination right applies to all works of authorship, it is especially salient in relation to sound recordings, for both historical and practical reasons. From a historical standpoint, federal copyright law only protects sound recordings created on or after February 15, 1972, and sound recordings created before that date are protected only by state law. As a result, the termination right only applies to sound recordings created on or after February 15, 1972. And from a practical standpoint, the

authors of sound recordings typically transfer the copyright in their works to their publisher. As a consequence, the termination right may enable the authors of many sound recordings created after January 1, 1978 to reclaim the copyright in the works they created.

Indeed, many notable artists have already filed termination notices, including Bob Dylan, Tom Petty, Bryan Adams, Loretta Lynn, Kris Kristofferson, Tom Waits, and Charlie Daniels. It appears that Joel may have filed a termination notice for his 1978 album, *52nd Street*, as well as other albums.

However, there are several statutory limitations on the termination right. It must be timely asserted and the termination notice must comply with all statutory and regulatory formalities. It does not apply to derivative works created prior to termination. And most importantly, it does not apply to works made for hire.

The Copyright Act provides that the "author" of a "work made for hire" is the employer, and it defines a "work made for hire" as:

> (1) a work prepared by an employee within the scope of his or her employment; or
>
> (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

Recording contracts typically provide that sound recordings are works made for hire. For example, the copyright registration for Joel's 1978 album, *52nd Street*, states that the copyright claimant is CBS, Inc., "employer for hire." However, the Supreme Court has held that the common law of agency determines whether a person is an "employee" for the purpose of the Copyright Act, and that the parties to a contract can effectively agree that a work is a "work made for hire" under the Copyright Act only if it falls into one of the statutory categories. As a consequence, it is a question of fact whether a particular sound recording is a work made for hire under the Copyright Act, and the facts tend to favor producers and artists.

The recording industry realized that the termination right might enable many artists to reclaim the copyright in their sound recordings and decided to intervene. In 1999, representatives of the recording industry successfully lobbied Congress to amend Section 101 of the Copyright Act and list sound recordings as one of the

statutory categories of works that can be deemed works made for hire based on an express agreement. Recording artists were outraged, and Congress repealed the amendment in 2000. So, as it stands, sound recordings can be works made for hire under the Copyright Act only if the artists and producers who created them are "employees" under the common law of agency.

As yet, no court has determined whether a typical sound recording is a work made for hire for the purpose of the termination right under Section 203. It appears that many recording artists may be using the threat of filing a termination notice to renegotiate their contracts. Indeed, it appears that the recording industry is split on the wisdom of litigating terminating notices. But we should expect to see litigation in the near future, as the number of termination notices filed grows.

Are the musical works and sound recordings created by Billy Joel works made for hire? It is hard to say without examining the factual circumstances surrounding the creation of each work. And if some or all of those musical works and sound recordings are not works made for hire, who can claim authorship?

IV. AUTHORSHIP

Under the Copyright Act, "The authors of a joint work are co- owners of copyright in the work." The Act defines a "joint work" as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole."

Courts uniformly agree that a work is a joint work only if all of the authors who contribute to the work intend to create a joint work when the work is created. But courts disagree about whether a joint author must contribute an original element to the joint work. Most courts have held that a person can be a joint author only if that person contributed an original element to the joint work. But some courts have held that a person can be a joint author even if that person did not contribute an original element to the joint work, if the other authors agree to become joint authors.

Obviously, when more than one person participates in the creation of an original work of authorship, the ownership of that work may be unclear. For example, many people may participate in the creation of a musical work or sound recording. While conventional understandings of authorship and ownership have arisen to address many of these circumstances, it is unclear whether they are consistent with copyright doctrine.

For example, when songwriters agree to collaborate on the creation of a song, they typically agree to consider each other joint authors. But what if a songwriter contributes the lyrics and melody of the song, and others contribute additional elements, like the accompaniment and rhythm? What if an entire band participates in the creation of a song? Who are the authors of the underlying musical work? And who are the authors of the sound recording? In some cases, band members may be employees, and their contributions may be works made for hire. But what if they are not?

On May 19, 2009, Joel's former drummer Liberty DeVitto filed an action against Joel in the Supreme Court of New York, New York County, alleging eleven breach of contract claims for failure to pay royalties on eleven albums recorded between 1975 and 1990. Joel and DeVitto first met as teenagers in the late 60s when their respective bands, The Hassles and The New Rock Workshop, performed at a rock club located in Plainview, Long Island named "My House." In 1975, DeVitto joined what became the Billy Joel Band.

DeVitto was a member of the Billy Joel Band from 1975 to 2005, and he performed on the Billy Joel albums, *Turnstiles*, *The Stranger*, *52nd Street*, *Glass Houses*, *The Nylon Curtain*, *Innocent Man*, *The Bridge*, *Billy Joel Kohuept (Live In Leningrad)*, *Storm Front*, *Greatest Hits Volumes 1 & 2* and *Songs In The Attic*, which collectively sold more than 100 million copies worldwide. In 2005, Joel fired DeVitto, possibly because DeVitto accused Joel of being an alcoholic.

While DeVitto was not credited as an author of any Joel's songs, DeVitto claimed that the members of the Billy Joel Band composed their own parts to each song, and that the recordings of the songs were the product of collaboration between Joel and the members of the band. As DeVitto remarked, "If Billy sang 'Only the Good Die Young' like he wanted to, it would have been a reggae song."

The relationship between Joel and the members of the Billy Joel Band was unclear. As Mark Bego, a Joel biographer observed:

> There were no formal printed contracts, and everything was still handled on a handshake kind of agreement. When it came time to record an album, the musicians in Billy's band were paid an hourly salary of "double scale," which is twice what the Musician's Union mandated as the minimum wage at the time. Billy's way of working in the recording studio was to bring in scraps of songs or melodies. He would ask for musical contributions from the members of his troupe, and they would create their parts. At the end of the day, they had all technically contributed to the musical creating and recording of the

> songs, yet only one person was getting full songwriting credits. And, it was Billy Joel who also reaped all of the monetary rewards when other singers performed these songs.

In an interview with David Sheff, which appeared in *Playboy* Magazine, Joel's description of his relationship with his band was broadly consistent with DeVitto's, reflecting a collaborative songwriting practice:

> *Playboy*: Your songs are often contradictions within themselves: A fairly tough, raw statement comes packaged in a sweet melody.
>
> Joel: That's true. Probably because my music and lyrics aren't written at the same time. I always write the music first. A lot of times I write bail-out lyrics, just to carry along the melody while I work on the real lyrics. *My Life* was originally [singing] "Welcome back, welcome back, welcome back to the real life." Those were the bail-out lyrics. *Honesty* was originally *Sodomy*. My drummer, Liberty DeVitto, will sometimes make up some dirty lyrics and we use those until it gets to the point where I say, "Uh-oh, I better write real lyrics for this or I'll have to get up onstage and sing Lib's words." I can just see getting up on stage and going [*singing*] "Sodomy, it's such a lonely word."

In April 2010, DeVitto settled his action against Joel for an undisclosed sum. Interestingly, it is unclear whether DeVitto was entitled to a settlement. Under the Copyright Act, he and the other members of the Billy Joel Band probably contributed original elements to at least some of Joel's songs. It seems undisputed that Joel intended to collaborate with his band members on the creation of the songs. But Joel probably did not intend to create a joint work with the members of his band. Ultimately, the issue probably comes down to whether the members of the Billy Joel Band were Joel's employees for the purpose of the work made for hire doctrine. Because they received a union salary and other benefits, they probably were Joel's employees for the purpose of the Copyright Act, and therefore are probably not joint authors of Joel's songs. But it is hard to say with certainty.

V. INFRINGEMENT

The Copyright Act grants authors, *inter alia*, the exclusive right to reproduce the original elements of their works of authorship and to create derivative works based on the original elements of their works of authorship, subject to certain exceptions. As a result, the use of an original element of a copyrighted work without the permission of the author is an infringing use, unless it is permitted by one of the

exceptions. So, in order to make out a *prima facie* infringement claim, a copyright owner must show that the alleged infringer actually copied an original element of the work, and that the works are substantially similar because of the copying.

The plaintiff in an infringement action can prove copying either directly or circumstantially. Direct evidence of copying is unusual, because most works are created in private and defendants rarely admit to copying. Accordingly, most plaintiffs prove copying circumstantially, by showing access and probative similarity.

A plaintiff can prove access either by showing a connection between the defendant and the copyrighted work or by showing that the copyrighted work is ubiquitous. Courts have generally found access when plaintiffs show a nexus between the defendant and the allegedly infringed work, but have not found access when the relationship is tenuous or speculative. And a plaintiff can prove probative similarity by showing that the two works share one or more elements, whether or not those elements are independently protected by copyright. In other words, shared ideas or public domain elements can show probative similarity, even though copying ideas and public domain elements cannot be an infringing use.

The plaintiff in an infringement action must also show that the allegedly infringing work copied original elements of the copyrighted work, and that the works are substantially similar because of that copying. Substantial similarity is a mixed question of fact and law, determined from the perspective of the "ordinary observer." In practice, many courts and juries seem to apply a relaxed standard for substantial similarity, finding infringement if a work copies any elements of the old work and the two works are broadly similar.

Throughout his career, Joel has been dogged with accusations of liberal borrowing from other songwriters. For example, when Joel first played "Piano Man" for Atlantic Records executives Ahmet Ertegun, Jerry Wexler, and Jerry Greenberg in 1973, Wexler observed, "You know, it's kinda like 'Bojangles.' If 'Bojangles' wasn't written, you probably wouldn't have written that, right?" To which Joel protested, "I didn't steal it. 'Mr. Bojangles' is one thing, 'Piano Man' is another thing. It's a similar structure, same chord progression. That's it."

While Joel has admitted to emulating the style of songwriters he admires, he has always denied copying them:

> Joel: I like Elvis Costello, but I have never tried to duplicate anyone. If I consciously try to emulate anybody, it's the Beatles. I've tried to compose in a certain style - for instance, I was thinking of Ray Charles when I sat down to write *New York State of Mind* - but that's different. I

> am inspired by performers, but I don't try to copy people. We didn't set out to make *Glass Houses* New Wave. We looked at it as a rock-'n'-roll album. But we knew they would throw rocks at it.

And yet, in 1983, Joel confessed his fear of being derivative to his publicist Howard Bloom:

> You have no idea how hard it is for me to write songs. It's a terrible experience. I have to lock myself in a room with a piano, and I pace back and forth, and I'm tortured. And the songs come out of me with such difficulty. And I'll tell you something about my songs, every one of them disappoints me. They're all derivative.

Bloom rejected Joel's concerns, responding, "Billy, you have no idea what you're doing. Of course it's derivative. Everything is derivative. Everything has roots, but your stuff is brilliantly original."

Others disagreed. In 1979, John Powers, an unknown songwriter from Reno, Nevada, filed a copyright infringement action against Joel, alleging that Joel's song "My Life" (1978) copied elements of Power's unpublished song "We Got to Get It Together" (1974). Powers claimed that Joel had access to his song because he sent a copy to Columbia Records, which was rejected. Initially, Joel wanted to litigate, but in 1980, he settled for $42,500 on the advice of counsel, because litigation would be risky and more costly.

Among other things, the settlement required Powers to provide a letter stating that Joel had not copied his song, but Powers did not comply. Instead, he ran advertisements alleging that Joel copied his song and made media appearances brandishing Joel's check. Joel was livid, and in a 1980 interview with *Rolling Stone*, he expressed his indignation at the infringement action and fulminated against Powers:

> Incidentally, I read recently in Random Notes about this guy [John Powers of Reno] who said that I stole his song, that he wrote "My Life." Now, my initial instinct is to just go beat the hell out of the guy, but my lawyers say I can't do that. I've had more leeches and sharks preying on me over the years, and it hasn't been dramatized in the press much because, until recently, Billy Joel wasn't very interesting to people.
>
> But I never stole anybody's song. People send me tapes through Columbia all the time, and I *do not* and *will not* listen to them. As it is,

> I'm getting sued; I've got lawsuits up the gazool, which is something that disillusions me a lot about writing. I don't want to steal from anyone, because I know the feeling - my stuff's been getting ripped off all my life.
>
> *How have things with "My Life" ended up?*
>
> Lawyers [*whistles whimsically*] It was a settlement. I said, "How much am I going to pay you if we go to court?" And the lawyers said *X*. "How much?! The guy is wrong. I never heard his song. He wants to go to court, I'll go to court. I'll kill him. I want to kill him. I'll kill anybody who says I stole his material."

Maybe he did have a melody that was copyrighted. But don't tell people I'm a thief. When they question my intentions, that bugs me. Enough about that. I never stole nobody's song.

And in a 1982 interview with *Playboy*, he expanded on those

sentiments:

> *Playboy*: You were taken to court over *My Life*, weren't you?
>
> Joel: Yeah. [*His eyes narrow and he smiles sinisterly*] Hey, you want to go to Reno and beat somebody up? That's where he lives - the creep who says I stole his song!
>
> *Playboy*: What happened?
>
> Joel: This is it: *I* wrote that song. I remember writing that song. I gave birth to that song. It's *my* song. But I got a call one day saying I was being sued by a guy who had a song with the same kind of notes that he copyrighted and sent to Columbia Records or somebody, and they sent it back, saying, "Thanks, but no, thanks." Based on the fact that I wrote the same kind of song and the fact that Columbia had his tape, he said I heard his tape and stole the song. When I heard about it, I said, "Let's go to court. Let's kill him. I want to *kill* him." But the lawyers said, "Look at it this way. You're going to go to Reno, Nevada. You're a big, successful rock star. Here's this poor little schlump. The jury's going to be from Reno. We'll have our musicologist, he'll have his musicologist. Who's to say? You can lose."

I said, “How can I lose? I *wrote* the song! I know I wrote the song! My wife is a witness!” “Your wife can’t testify.” “But she was there! I went through all hell writing this damn thing!” Anyway, they told me I should settle out of court. I said, “What! Why should I settle? I *wrote* the goddamn song!” But they advised me to settle, because life is not fair. So they settled for the minimum amount of money. After everything, the guy probably got $5000. It was a nuisance suit. But by the agreement, we were supposed to get a letter saying that I did not steal his song. I was totally against it, but I went along with the lawyers for once. So I’m supposed to have this letter. I’ve never seen this letter. And I hear that the guy does an act now and says, “This is a song I wrote that Billy Joel stole.” [He downs a glass of Scotch] I want to break his legs with my own hands.

Somebody else was going to sue me for another song: he claimed I was in a movie theater and heard a tape of his that I stole. When I heard about it, I said, “Listen, no more of this settling s--t. If somebody sues, you have to countersue. Tell the guy, ‘I’m going to countersue you for every penny you ever make, and I’ll give it all to charity. I don’t want your stinking money. You go after me, I’ll kill you!’” I never stole nobody’s song! I’m still mad at the lawyers for letting me settle. It sucks. Lawyers kind of run the country. So anyway, I don’t care how much it will cost me. If it ever happens again, I am going to go for the jugular. After my lawyers went back to tell the second guy we wouldn’t settle, we never heard from him again.

Playboy: Do you –

Joel: Man, the thing that bugged me about it was that it was like they were taking away my kid! I give birth to these songs. I go through labor pains with these songs. It’s not the money. It’s the birthright. Writing is the worst thing. It’s the scariest thing in the world. I hate to write. I absolutely hate writing. You tear your guts out of yourself.

You’re in the middle of a hot, dry desert. There’s nothing but this blank piece of paper in front of you and this piano that has 88 white teeth staring at you, waiting to bite your hands off. That’s what it’s like. It’s horrible - until you finish. Then it’s, “Don’t talk to me. I just did something really cool. Look at my child.”

For somebody to come up and say, “That’s not your child” No way. *F--k you!* So if I ever meet that guy, I’m going to break his legs,

> I'm going to break his face. That may sound real *macho* and stupid and brutal, but I don't care: Don't take my child away. That's it.

Based on those statements, Powers filed a defamation action against Joel in Nevada state court, which was eventually dismissed in 1988. The court held that Joel's statements were not defamatory as a matter of law, because "a reasonable reading of the verbiage and style of the statements makes clear that they are issued as opinion rather than assertions of fact."

In 1993, a second infringement action was filed against Joel, but true to his word, he refused to settle. Gary Zimmerman, a "struggling Long Island songwriter," alleged that Joel's songs "We Didn't Start the Fire" (1989) and "River of Dreams" (1993) copied elements of his unpublished song "Nowhere Man" (1986), and requested $10 million in damages. Zimmerman claimed that Joel had access to "Nowhere Man" via an anonymous mutual friend. He alleged that "We Didn't Start the Fire" copied "a substantial part of the melody [of 'Nowhere Land'] used as a bridge, and the phrasing and the form of the bridge . . . More than 50 percent of the defendant's song consisted of plaintiff's work." He also alleged that "The River of Dreams" copied the melody and the first two lines of "Nowhere Man." Specifically, Joel's song begins, "In the middle of the night I go walking in my sleep," while Zimmerman's begins, "It's the middle of the night, and I just can't get to sleep."

Joel denied any knowledge of Zimmerman or his song and noted that the risk of infringement litigation forced him and his peers to ignore new songwriters. "I regard my songs as my children, and I will do what any parent would do—guard them with my life. This is another example of why true, struggling songwriters can't get anybody—including me—to listen to their songs. As far as Gary Zimmerman is concerned, I have never met him, and I have never heard his music." About a year later, Zimmerman dropped his suit.

It is hard to say whether either Powers or Zimmerman had a legitimate infringement claim, because their songs are out of print - if they were ever published - and unavailable to compare with Joel's songs. But it seems unlikely that Joel ever heard either song. His lawyer's advice to settle with Powers explicitly reflected the uncertainties of copyright litigation, rather than an assessment of the merits of Powers's action. And Zimmerman's decision not to pursue his action likely reflects his or his lawyer's assessment of its merits. Nevertheless, in the absence of a concrete and objective definition of infringement, it is impossible to know with certainty whether a particular use - or even a particular similarity - will be deemed infringing.

VI. CONCLUSION

This essay has discussed copyright ownership, authorship, and infringement in relation to songs written and recorded by Billy Joel. It has shown that the status of each is unclear, at best. And it has suggested that Joel's experience of the vagaries of copyright law is the rule, not the exception.

“IT’S YOUR RIGHT . . . !”: A LEGAL HISTORY OF THE BACARDI COCKTAIL

Shane Curcuru*

And everybody wants to be special here
They call your name out loud and clear
Here comes a regular
Call out your name
Here comes a regular
Am I the only one here today?

The Bacardi cocktail was the Cosmopolitan of the Jazz Age: a sweet and sour tipple with an attractive rosy hue and a deceptively alcoholic punch. Created in about 1913, and named after Bacardi rum, it soon became one of the most popular cocktails in America. Prohibition only increased its popularity, as wealthy Americans vacationing in Cuba enjoyed Bacardi cocktails and demanded them at speakeasies and at home. Of course, every good speakeasy offered white rum (or a passable facsimile thereof) and called it “bacardi” no matter who made it.

After Repeal, the popularity of the Bacardi cocktail continued to rise as the Bacardi Company launched an ambitious advertising campaign. But for many people, “bacardi” just meant white rum. When a customer asked for a “Bacardi cocktail,” many bartenders used whatever white rum they had on hand.

So, the Bacardi Company faced a dilemma. It was thrilled to be the namesake of the “it” cocktail but feared the dilution or loss of its trademark. While it wanted everyone to drink Bacardi cocktails, it also wanted them to insist on Bacardi rum.

Accordingly, in 1936, Bacardi filed a trademark infringement action in New York state court, accusing the Barbizon–Plaza Hotel and the Wivel Restaurant of making Bacardi cocktails without Bacardi rum. After a colorful trial, the court issued an injunction, holding a Bacardi cocktail had to include Bacardi rum. It was probably the first time a court had opined on mixological law, and it became the centerpiece of the Bacardi Company’s new advertising campaign.

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But was the court right? When people ordered a Bacardi cocktail, did they actually expect the bartender to use Bacardi rum, or did they simply expect to receive a cocktail made with white rum? Was the “Bacardi” in “Bacardi cocktail” the name of the drink or the rum? And what exactly was a “Bacardi cocktail” anyway?

I. THE ECSTASY & THE AGONY OF GENERICIDE

The hope and fear of every trademark owner is to face the specter of “genericide,” or the possibility that ubiquity will transform its mark into a synonym for its product. The victims of genericide are legion, from aspirin to zipper. An untold number of names have become nouns with a corresponding loss of exclusivity.

But the path to genericide is watered with crocodile tears. The overwhelming market dominance required to trigger genericide typically renders the mark itself superfluous. When your competitors are forced to advertise your brand to sell their products, you’ve already won. Bayer still sells a lot of aspirin, and Goodrich only abandoned zippers because it found more profitable products.

And yet, trademark owners are never satisfied. They inevitably condemn comparison as “blurring” and criticism as “disparagement,” and dismiss the actual use of their mark as irrelevant to their exclusive right to control its use in commerce. In other words, they want both ubiquity and control, and when consumers inevitably disregard their claims, they strenuously object.

In that respect, the Bacardi Company was no different than any other trademark owner. It owned a valuable brand and wanted to extract as much value as it could out of that brand. It saw the Bacardi cocktail as a way to leverage a cultural phenomenon into additional sales. And it worked like gangbusters.



Facundo Bacardí Massó

II. THE BACARDI COMPANY

The Bacardi Company was founded by Facundo Bacardí Massó in 1862. Bacardí was born in 1814 in Catalonia and moved to Santiago de Cuba in 1830. He initially worked for his older brothers, Magín and Juan, and eventually opened his own general store in 1843. On August 20, 1852, a massive earthquake destroyed much of Santiago de Cuba and caused a cholera epidemic. In the wake of the disaster, the economy of Santiago de Cuba collapsed, and Bacardí's store went bankrupt in 1855.

In 1859, Bacardí formed a partnership with José León Boutellier, and they began experimenting with different methods of making rum with the intention of producing a white rum suitable for export. Eventually, they settled on a combination of techniques, including quick–fermenting cognac yeast, charcoal filtration, and white oak barrel–aging, among other things. Soon afterward, they began selling small quantities of rum at Magín Bacardí's store.

On February 4, 1862, Bacardí and Boutellier bought an old distillery, and, in May 1862, they incorporated as "Bacardí, Boutellier, & Compañía." Bacardí signed every bottle "Bacardí M," and chose an image of a bat with outstretched wings as the logo for their new company. Their rum was popular, and their business grew. By 1868, Bacardí rum was available in Havana, and it soon became the most popular

rum in Cuba. In 1872, Boutellier retired, and the company reorganized as “Bacardí & Compañía.”

Initially, the company’s finances were precarious as the Ten Years’ War for independence from Spain gradually ruined the Cuban economy. In October 1880, Bacardí & Compañía filed for bankruptcy, and a fire destroyed its offices and primary distillery only a month later. But Facundo Bacardí’s son Emilio Bacardí brought the company back from the brink, even as he supported the cause of Cuban independence.

In 1895, the war for Cuban independence reignited; and on February 15, 1898, the sinking of the U.S.S. Maine sparked the Spanish–American War. The Spanish surrendered on July 17, and the United States occupied Cuba. After Cubans voted for independence in 1900, the United States reluctantly withdrew but imposed onerous conditions on independence. And when the Republic of Cuba collapsed in 1906, the United States resumed occupation.

Meanwhile, the fortunes of the Bacardí Company surged. It won

international awards, increased production, and focused on expanding its market. Bacardí gradually transformed rum from the quintessential proletarian spirit into a bourgeois beverage.



III. THE ETIOLOGY OF THE BACARDI COCKTAIL

Mixology is an inherently imperfect science with an amusingly inexact history. The same spirits that inspire a new cocktail may befog its origins. Many an innovator may innocently rediscover a palatable formulation. And a single libation may contain a multitude of variations.

While the origins of the Bacardi cocktail are cloudy, its provenance is unclear, and its progeny are legion, it surely sprang from the fertile well of rum sours nurtured in the islands of the Caribbean. Unsurprisingly, tipplers have mixed rum with citrus juice and sugar since time immemorial. After all, it is a trifecta of ingredients that naturally coexist. Rum is distilled from fermented molasses, a byproduct of sugar manufacturing. And citrus trees thrive in the tropical climes essential to the cultivation of sugarcane.

Christopher Columbus took citrus seeds to the Caribbean in 1493. The Portuguese built sugar plantations in the 16th century. And rum soon followed. While the combination of the three ingredients was inevitable, the original names bestowed on the beverage are lost to history. But at least a few of its historical names were preserved.

A. Grog

In 1740, Admiral Edward Vernon of the Royal Navy ordered the dilution of his fleet's daily rum ration with water, in order to prevent sailors from hoarding it. Supposedly, many sailors added lime juice and sugar to the diluted rum to improve its taste. The sailors had nicknamed Vernon "Old Grogham" for his grogham coat, and they called their new beverage "Grog."

B. The Canchánchara

According to legend, the Canchánchara was created in eastern Cuba in the 1870's by "mambises," or Afro–Cuban revolutionaries, during Cuba's unsuccessful Ten Years' War for independence from Spain. It consisted of alcohol (usually spirits of some kind, but sometimes a fermented beverage) mixed with citrus juice (usually lime) and a sweetener (usually honey). It was consumed at room temperature or mixed with hot water as a toddy. Canchánchara is a neologism of unknown source and meaning, but the word and the drink soon came to symbolize the Cuban struggle

for independence. Eventually, Cubans began to drink the Canchánchara with ice as a sour.

C. The Daiquiri

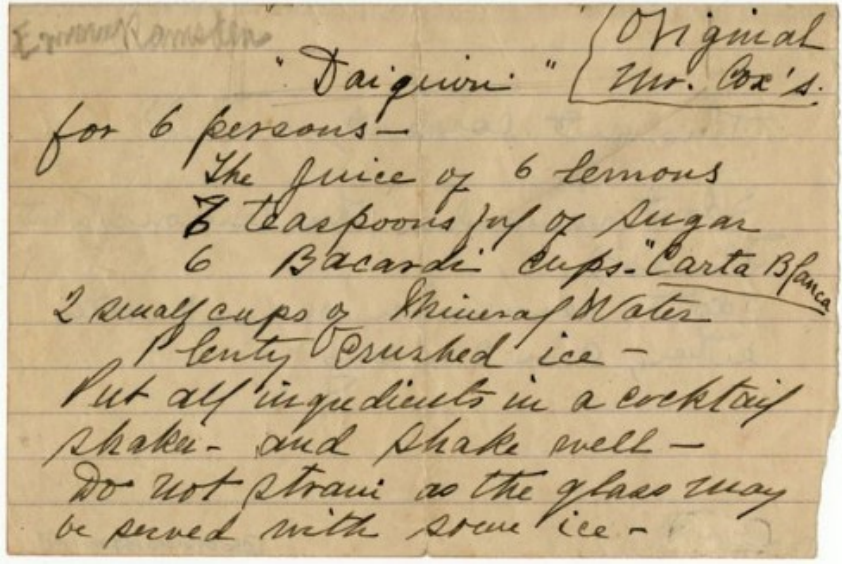
While the histories of most classic cocktails are apocryphal at best, the Daiquiri is unusually well–pedigreed. It was created — or at least named — in about 1898 by Jennings Stockton Cox, and we have his original handwritten recipe to prove it. Nevertheless, there is considerable disagreement about the particulars of Cox's creation.



Jennings Stockton Cox

An engineer from Baltimore, Cox worked for the Spanish–American Mines Company at an iron mine near Daiquirí, a village about 14 miles east of Santiago de Cuba. According to his granddaughter, he ran out of gin while entertaining American

guests and was reluctant to serve them straight rum. So, he mixed rum with lime juice and sugar, then named the drink after the nearby village. A variation on the story holds that Cox's visitor — Giacomo Pagliuchi, an Italian engineer — actually named the drink. Charles H. Baker, Jr., claimed that Cox created the drink in 1898 in collaboration with Harry E. Stout, another engineer. And Basil Woon claimed the drink was created in Daiquirí but named by Cox at the Hotel Venus in Santiago de Cuba.


"Daiquiri" {Original Mr. Cox's.
for 6 persons—
The Juice of 6 lemons
6 teaspoons full of sugar
6 Bacardi cups. "Carta Blanca"
2 small cups of Mineral Water
Plenty Crushed ice—
Put all ingredients in a cocktail shaker— and shake well—
Do not strain as the glass may be served with some ice—

Jennings Stockton Cox, Daiquiri (~1898).

But these seriatim opinions on the origin of the Daiquiri concur on Cox's original recipe:

> "Daiquiri" (Original Mr. Cox's.)
> for 6 persons –
> The Juice of 6 lemons
> 6 teaspoonsful of sugar
> 6 Bacardi cups. "Carta Blanca."
> 2 small cups of Mineral Water
> Plenty crushed ice.
> Put all ingredients in a cocktail shaker, and shake well.
> Do not strain as the glass may be served with some ice.



Lucius W. Johnson

Supposedly, the Daiquiri made its stateside debut in 1910, when Lieutenant Lucius W. Johnson of the United States Navy brought it from Cuba. When the U.S.S. Minnesota docked in Daiquiri, Johnson and a group of sailors disembarked for some "R&R." Cox greeted them at the dock and invited them back to his bungalow for refreshments, which naturally meant Daiquiris. Apparently, Cox had refined his recipe in the meantime:

> When we were pleasantly relaxed he prepared for us a drink which brought quick relief to our arid throats. He had put it together, he told us, to make the locally produced rum more agreeable to the foreign taste. It had been christened the Daiquiri in honor of its birthplace.
>
> His technique was simple, with each drink prepared in its own glass. Over cracked ice he poured two jiggers of rum, then added a level teaspoonful of sugar. Next, he squeezed into each glass the juice of a lime, being careful to include some of the oil from the skin. The mixture was stirred gently, and in that humid climate, the glass quickly became frosted.

In any case, Johnson loved the drink and brought home a gallon of rum, which he used to mix Daiquiris at the Army and Navy Club in Washington, D.C.

If Johnson introduced the Daiquiri to the United States, then literature made it iconic. F. Scott Fitzgerald offhandedly mentioned the drink in a 1920 novel. But it truly owes its fame to Ernest Hemingway, who drank untold numbers of Daiquiris at the La Florida Bar in Havana, better known as the Floridita. Hemingway became a regular in 1932, and soon created his own recipe, a sugar–free double Daiquiri that became known as the "Hemingway Special" or "Papa Doble."

Hemingway would shudder at what the Daiquiri has become. The archetypal Daiquiri is simple and austere, consisting of white rum, lime juice, and a little sugar, shaken with ice and strained into a cocktail glass. But today, the "Daiquiri" of the hoi polloi is a rum Slurpee, available in a rainbow of colors and an assortment of artificial flavors.

D. The Bacardi Cocktail

The Bacardi cocktail is essentially a variation on the Daiquiri, consisting of white rum, lime juice, and grenadine. But historically, mixologists provided a congeries of different recipes for the Bacardi cocktail, including a panoply of different ingredients.

Ironically, the key ingredient in the paradigmatic Bacardi cocktail is not Bacardi rum, but grenadine, which gives the cocktail its characteristic rosy hue. When made with neon–red Rose's Grenadine, the drink is colorful but one–dimensional. However, it is sublime when made with real pomegranate grenadine.

Incidentally, the word "grenadine" was itself the subject of a trademark infringement action. In the mid–19th century, a pomegranate or "grenade" syrup was popular in France. In 1870, a man named Rillet began manufacturing pomegranate syrup in the United States and selling it as "Grenade Syrup" or "Grenadine." Several months later, a man named Carlier also began making and selling "Grenade Syrup." Rillet sued Carlier for trademark infringement, and Carlier responded that Rillet could not claim an exclusive right to use the foreign name for a product simply by using it first. But the court found for Rillet, holding that the term "grenade syrup" had acquired secondary meaning:

> It is undisputed that he has spent a large amount of money in establishing a business in selling the article known by that name. The plaintiff has acquired, by such adoption, a property in the use of those words, as applied to a syrup he has made and introduced into the

> market. The defendant can have no possible motive in using these words, except to avail himself of the reputation the plaintiff's article has gained under this name. The fact that the defendant uses other words in connection with the words "Grenade Syrup" does not give him the right to use the words "Grenade Syrup." . . . The name used by the defendant is well calculated to deceive the public, and I cannot perceive of what value they can be to the defendant for any other purpose.

In any case, the first–known record of the standard recipe for the Bacardi cocktail appeared in *The Oakland Tribune* on November 13, 1913, albeit without its iconic name:

> **Here's New Cocktail; Rum and Grenadine**
>
> There's a new cocktail in town – a fresh importation from New York.
>
> Take half a whiskey glass of Porto Rican rum, add the juice of half a lime and dash into it a squirt of grenadine; shake with ice.
>
> This was introduced by Rhys Thomas, who in the later 90's was the leading tenor at the Tivoli Opera House and is being entertained by his old Bohemian Club friends, after an absence of fourteen years.
>
> Thomas, who is a lineal descendant of that Sir Rhys Thomas, the hardy Welsh knight who slew Richard III on Bosworth field, has quit being a tenor and gone into a more lucrative, if less elevating, connection with a paint manufacturer.
>
> He tried out his new cocktail on Theodore Vogt, who, being a hardy soul, was at last accounts a survivor.

The Bacardi cocktail first appeared by name in Jacques Straub's 1914 book "Drinks." He provided the following recipe:

> **Bacardi Cocktail.**
> 1⁄2 pony grenadine syrup.
> 2⁄3 jigger Bacardi rum.
> Juice of half a lime.
> Shake well. Strain. Serve.

Straub also provided a recipe for the “daiguiri” or daiquiri:

> **Daiguiri Cocktail.**
> 2⁄3 jigger lime juice.
> 1⁄3 jigger rum.
> 1 barspoon powdered sugar.
> Shake well in fine ice; strain into cocktail glass.

A similar version of the Bacardi cocktail also appeared in Tom Bullock’s 1917 book, “The Ideal Bartender.” Bullock provided two recipes for the Bacardi cocktail, but he did not provide a recipe for the daiquiri:

> **BACARDI COCKTAIL**
> Use a large Mixing glass.
> Fill with Lump Ice.
> jigger Cusiner Grenadine.
> 1 jigger Bacardi Rum.
> Shake well and serve in a Cocktail glass.

> **BACARDI COCKTAIL—Country Club Style**
> Use a large Mixing glass.
> Fill with Lump Ice.
> 1⁄2 Lime Juice.
> 2 dashes Imported Grenadine.
> 1 jigger Bacardi Rum.
> Shake well; strain into Cocktail glass and serve.

The Daiquiri and the Bacardi cocktail both went on to become fixtures in the cocktail culture of the era and were featured in almost every cocktail book published in the 1920s and 1930s. The recipe for the Daiquiri was relatively stable, but the recipe for the Bacardi cocktail varied wildly. Usually, it included grenadine, but not always. Sometimes, it incorporated other kinds of alcohol, especially maraschino. And it often called for different kinds of citrus juice. For example, the Bacardi Company itself offered the following recipe for the Bacardi cocktail in 1928:

> BACARDI COCKTAIL – In cocktail shaker with plenty of ice, one small wine glass of BACARDI, half this quantity of grape fruit juice — or preferably the juice of half a lime — sweeten to taste, shake well, strain and serve.

By the 1930s, it was widely recognized that cocktail recipes — and especially the recipe for the Bacardi cocktail — varied wildly from city to city and mixologist to mixologist. As the author of one cocktail book observed:

> It is trite, but it is none the less accurate, to say that conditions have changed greatly in the last fifteen years. Good roads and good automobiles have made us almost a nomadic people. The evening frequently finds us two hundred or more miles from where we woke up in the morning. Nevertheless, although in the stay–at–home era a Bacardi cocktail was a Bacardi cocktail whether you drank it in Schenectady or Memphis, we have, under the pressure of circumstance and the necessity for make– shift and compromise, lost that much–to–be–desired homogeneity.
>
> This book is being published, therefore, in the hope that it will contribute at least a little to the standardization of drinks and to the promotion of that happy state of affairs where, when you order your favorite cocktail, you will get exactly the sensation your hopeful taste–buds have been anticipating, no matter what corner of this bright and beautiful land you happen at the moment to be inhabiting.

But if the recipe for the Bacardi cocktail was uncertain, its popularity was not. Whatever drinkers were calling a "Bacardi cocktail," they liked it. Before long, it was the drink of choice, even eclipsing old standbys like the Old Fashioned and the Martini. Perhaps the implicit license to improvise only increased its appeal.

IV. BUILDING THE BACARDI TRADEMARK

By the turn of the century, the Bacardi Company was the overwhelmingly dominant supplier of white rum to the United States. The ubiquity of Bacardi rum gradually encouraged many consumers to use "bacardi" as a synonym for white rum. And cocktail books often called white rum "bacardi" or used the terms interchangeably.

The Bacardi Company's first big opportunity to crack the American market came when Prohibition began on January 17, 1920. Americans continued to drink at home and in speakeasies, but many also visited nearby Cuba, where booze was both legal and inexpensive. While Cuban bars offered American tourists whatever they wanted to drink, most of them wanted Bacardi rum, typically in a daiquiri or Bacardi cocktail. And when they got home, they expected speakeasies and bootleggers to offer Bacardí rum as well.

The architect of Bacardi's transformation into an international brand was Enrique Schueg, who married Bacardí's daughter, Amalia Bacardi Moreau, and became the

president of the Bacardi Company in 1922. Under Schueg's leadership, Bacardi marketed Cuba as the home of rum and Bacardi as the king of rums.

The tendency to equate "white rum" and "bacardi" only increased during Prohibition. Many bootleggers and speakeasies sold generic white rum (or rough approximations thereof) as "Bacardi." Everyone knew it was counterfeit, but no one really cared. In 1930, the New York Times used the word "Bacardi" to mean "rum from Cuba":

> Today's word "rum," used in a broad sense to designate all kinds of forbidden liquors, may refer to the "corn" of the South, Bacardi from Cuba, apple–jack or "Jersey lightning," or the "red ink" of Greenwich Village.

And it was hardly alone. The chairman of the Cuban–American Good–Will Dinner did the same:

> "This exhibit," he said, "will repudiate the popular fallacy in American that Cuba produces only sugar, tobacco and bacardi."

While some cocktail books recognized that "Bacardi" was a brand name, others used it as a synonym for "Cuban rum":

> Another ardent spirit, rum, is distilled from molasses or cane sugar. Perhaps the most appreciated brand known to Americans is Bacardi, produced in Cuba.
>
> Bacardi Rum is peculiar to the Island of Cuba. The name "Bacardi" is a brand name. Its exact making is a secret, but it is well established that it is a distillation of a mixture of molasses and sugar cane juices. There are also other "Bacardi Type" rums from Cuba, and some of them deserve high credit and praise.
>
> *Bacardi* rum, one of the few liquor brands which won most of its reputation in this country during the dry regime, is a cane syrup, rather than a molasses rum, and has a lighter body and flavor than the rums from most of the other islands.
>
> RUM
>
> Rum is a flavorsome spirit distilled from cane sugar, the latter usually being the residual sugar in the manufacture of molasses The distinctive sweet taste of rum makes it an admirable flavoring for both

> food and drink. Rum or Planters' punch has put Jamaica on the map, while Constantino's expert handling of Bacardi rum at the Florida Bar has made Havana a holy city.
>
> Rum
>
> An abbreviation of "Rumbullion." Rum is a spirit distilled from the juice of the sugar cane — and also from molasses in countries where the sugar cane is not cultivated. The best qualities of Rum are made in the West Indies, and are named after the places of manufacture, viz., Jamaica Rum, Antigua Rum, and Grenada or St. Croix Rum, or Bacardi Rum.
>
> RUM—Generally, the name of any alcoholic liquor Specifically, an alcoholic liquor distilled from fermented molasses, or cane juice. Varieties usually named from country of origin—Jamaica, Swedish, St. Croix (West Indies), Cuban—better known as Bacardi or Santiago—and Japanese (usually called Sake and distilled from fermented rice).

Even the Bacardi Company itself ruefully acknowledged the volume of counterfeit Bacardi rum flooding the American market:

> Bacardi tells of a recent visit to New York, where he was taken by friends to visit a speakeasy. The party ordered Bacardi cocktails and one sip was enough to tell the manufacturer that the product was spurious.
>
> The proprietor declared with heat that he had been selling Bacardi for 20 years and would vouch for its genuineness. Bacardi answered that he had been making it for 35 years.

The repeal of Prohibition on December 5, 1933, was another boost for the Bacardí Company's fortunes. Thirsty Americans had developed a powerful taste for white rum, which they called "Bacardi." The brand was virtually a license to print money. But only if the Bacardi Company could keep it exclusive. And many of Bacardi's competitors hoped to sip from the overflowing bowl.

A. Ersatz "Bacardi"

In 1934, Augusto Diaz Briot incorporated the American Bacardi Rum Corporation in New York, applied for a distilled spirits rectifying permit in Connecticut, and filed a trademark registration application in Ohio for the word mark

“American Bacardi” and an eagle logo, in relation to the sale of rum. The Bacardi Company immediately filed a trademark infringement action in New York state court, requesting an injunction. American Bacardi responded that one of its owners was named Bacardi and claimed that he was entitled to give his name to the company he co–owned.

Supreme Court Justice John L. Walsh granted the injunction, holding that “Bacardi” was a valid trademark adopted by the defendant only to deceive consumers about the source of its products. But Walsh went on to observe that the trademark “Bacardi” was entitled to special protection:

> There is another principle involved here. The name Bacardi is so identified with a certain rum that it is almost a common noun. When a family name has reached that stage of alteration in meaning and the product is of a high quality so that, as here, the name ‘Bacardi’ really means ‘Rum which consumers may rely on for quality because it bears the name Bacardi,’ no one else can put out a similar article and call it Bacardi because that use of the name no longer connotes its usual meaning. For an extreme application of this rule, see *Tiffany & Co. v. Tiffany Productions, Inc.*, . . . where a jeweler restrained a theatre from using the name. That case was decided so because everything had been done to connect the jeweler in the public mind with the defendant. Even a jewel was used as a brand.

While Walsh’s conclusion that the “American Bacardi” mark infringed the “Bacardi” mark was surely correct, his subsequent remarks reflect considerable confusion about the function and purpose of trademark law. The *Tiffany* case was an early application of the concept of trademark dilution, or the protection of goodwill, in the absence of consumer confusion. For better or worse, the court enabled Tiffany to prevent non–competing uses of its name because consumers might associate those uses with Tiffany, even if they were not confused.

But Walsh seems to be talking about genericide, not dilution. If the word “bacardi” was indeed “so identified” with white rum that it had become a “common noun,” then “bacardi” had become a generic term, at least in relation to identifying the nature of the product. Trademark law is supposed to police the commercial use of proper names, not common nouns. If consumers actually used “bacardi” as a synonym for “white rum,” then Bacardi’s competitors should have been able to use the word “bacardi” to identify the nature of their product, so long as they didn’t imply that the Bacardi Company was the source of their product.

In other words, Walsh reached the right outcome, because American Bacardi chose its name to make consumers associate it with the Bacardi Company. But if American Bacardi had chosen a non–infringing name, such as "Briot Rum" and marketed its product as "Briot bacardi," it might not have been infringing. Tellingly, in 1935 the New York Times specifically observed that "Bacardi" was one of a great many "proper names" that had become nouns: "To the lexicographer it would seem that they have all been washed out with the aid of Gordon or Bacardi."

B. For Want of Bacardi a Lawsuit was Lost

But the Bacardi Company wasn't content to stop its competitors from calling their rum "bacardi." It wanted to force bartenders to serve Bacardi rum as well.

By 1936, Bacardi rum was wildly popular in the United States. Under Schueg's leadership, the Bacardi Company had expanded to Puerto Rico and could sell its rum duty–free in the United States. Many Americans were drinking their Bacardi in the form of a Bacardi Cocktail. But many Bacardi Cocktails weren't made with Bacardi rum. As different brands of rum became available in the United States, bartenders began making "Bacardi cocktails" with whatever they had on hand. Schueg saw an opportunity to sell both his rum and his brand.

In early 1936, the Bacardi Company filed a trademark infringement action against the Barbizon–Plaza Hotel and the Wivel Restaurant in the New York Supreme Court for New York County. According to the Bacardi Company, both defendants "served as Bacardi cocktails a concoction containing no rum made by the Bacardi Company," and because "no other rum maker could use the name Bacardi, hence to call cocktails made with other rums Bacardi was a fraud."

Initially, the court denied Bacardi's request for a preliminary injunction, because the Bacardi Company failed to show that consumers expected bartenders to make Bacardi Cocktails using only Bacardi rum:

> Supreme Court Justice Rosenman decided yesterday that Bacardi cocktails need not contain the brand of rum originated in 1862 by Facundo Bacardi at Santiago de Cuba and now manufactured by the Companie Ron Bacardi, a family corporation which took over the product in 1919. On the ground that the Bacardi family devised the Bacardi cocktail, suit was brought to restrain the Barbizon–Plaza Hotel and the Wivel Restaurant from selling Bacardi cocktails unless they contained Bacardi rum. The Bacardi Company alleged that by substituting other rum in the cocktails the defendants were misrepresenting the drinks sold.

> "The plaintiff does not show sufficient clearness to warrant a temporary injunction that in practice and understanding Bacardi cocktails must necessarily contain the product of the plaintiff," said Justice Rosenman in refusing a restraining writ. "The plaintiff's particular brand of rum has not been shown to be essential in the public mind to the drink known as 'Bacardi cocktail.'"

The Appellate Division affirmed Rosenman's decision, and the action proceeded to trial before Justice Walsh. It was a bit of a circus, as the parties called a wide range of witnesses:

> Many experts testified on the stand. They included an impressive roster of Bacardi bartenders; a former secretary of state of New York, who proudly admitted he was the man who introduced the Bacardi cocktail to the metropolis; a golf club mixologist, who takes care of the wants of the judge sitting in the matter; and several famous New Yorkers.

On April 27, 1936, the Bacardi Company called Justice Walsh's bartender, who testified that he always used Bacardi rum to make a Bacardi Cocktail:

> André Guex, bartender at the New York Athletic Club and in the Summer a concocter of cooling beverages for the Deal Beach Golf Club, was a witness yesterday before Supreme Court Justice John L. Walsh, who is a member of both. Guex was called by the Compania Ron Bacardi, manufacturer of the Cuban rum of that name, in a suit against the Barbizon Plaza Hotel and Wivel's Restaurant to restrain them from selling Bacardi cocktails which do not contain the company's product.
>
> When Guex took the stand, the court took over the questioning:
>
> "You are under oath now, André," said Justice Walsh. "What kind of rum have you been serving me when I asked for a Bacardi cocktail?"
>
> "Bacardi rum," replied the witness, who said he always made them that way.
>
> The defense contended that a daiquiri also contains Bacardi rum, but is not known as a Bacardi cocktail.

On April 28, 1936, the defendants called a series of bartenders and restaurateurs, who testified that a Bacardi cocktail could be made with any kind of white rum.

“Before the court announced its decision, several bartenders paraded to the witness stand, called by the defendants. Most of them agreed that they used any bottle of rum that was handy when a customer asked for a Bacardi cocktail, but added that when a patron specifically requested Bacardi he got it.”

Unfortunately for the defendants, one of their witnesses also quite candidly admitted that restaurants often misrepresented the ingredients in their fare:

Bartenders Are Witnesses

The injunction was handed down following a long hearing during which bartenders from many of the best– known hotels and bars in the city testified. They gave in detail the contents of not only the Bacardi cocktail but many other drinks and the methods of mixing them.

The discussion of chicken sandwiches and beef stews came up in cross–examination by Stewart Maurice, counsel for the plaintiff. Richard Nathans, owner of a grill, had testified that a Bacardi cocktail is made with lemon juice, grenadine and Carioca rum. Mr. Nathans is president of the New York Restaurant Board of Trade.

Mr. Maurice wanted particulars.

“What kind of meat do you put in a chicken sandwich?” he asked.

“Turkey, the same as in any other restaurant,” came the answer.

“And what do you put in beef stew?”

“We use the trimmings of very good meat.”

“Do you use the trimmings of beef?”

“Yes,” Mr. Nathans answered.

“Then,” said Mr. Maurice, “the name by which you sell your wares to the public has very little relation to the ingredients you use.”

“Oftentimes it has,” was the answer.

Tell of Drinks Served

> The defendants called as witnesses bartenders from the Stork Club, Jack Delaney's, the Westchester–Biltmore, the Stephens House at Lake Placid and from hotels in Bermuda. Most of them agreed that they use any bottle of rum handy when a customer asks for a Bacardi cocktail. They admitted, however, that when the patron requested it specifically, it was served.
>
> During the hearing, Justice Walsh denied a motion by the defense for an adjournment to allow time for depositions to be taken in Cuba as to an alleged practice of the Bacardi company in bottling, under its own name, rum purchased from other manufacturers.

Walsh was unimpressed by the defense, and issued an injunction "prohibiting the Barbizon–Plaza Hotel and the Wivel Restaurant, in West 64th Street, from serving Bacardi cocktails containing other than the rum manufactured by the Compania Ron Bacardi." "The court finds as a clear, preponderating, and even that which would be exacted in a criminal situation, beyond a reasonable doubt, that Bacardi rum left out of a Bacardi cocktail is not a Bacardi cocktail, and that otherwise it is a subterfuge and fraud upon the purchasing public, that when a Bacardi cocktail is asked for, other than Bacardi rum cannot be used."

The reaction to Walsh's ruling was mostly mockery. Many commentators ridiculed the triviality of the dispute:

> Fellow barflies, you've been guzzling Bacardi cocktails that weren't Bacardi cocktails at all, but that won't happen again, you betcha.
>
> Because Justice John L. Walsh, in Supreme Court, Manhattan, yesterday scotched (pun, ooh!) the nefarious practice of serving phony Bacardis. Walsh issued an injunction that no bartender may fiddle with, unless he wants to land in the pokey for contempt of court.
>
> This was done because bartenders from Sheridan Square to Lake Placid testified they reached for the first bottle of Cuban rum handy when a citizen ordered a Bacardi.
>
> . . .
>
> P.S.A. Bacardi is made of Bacardi rum, lime or lemon juice, and grenadine. You can leave out the grenadine if you like drinks that don't lean to the sissy side.

In a similar vein:

> A famous and expensive hotel in New York advertises Bacardi cocktails. Cocktail drinkers have evinced a preference for such a brand of liquid material. But on the showing that they did not contain the named contents but something inferior, and the case having been properly brought before the court, a ruling came down from Justice Walsh that a cocktail given a certain name must qualify by its ingredients accordingly. When is a Bacardi not a Bacardi was satisfactorily answered in the argument, "when it is served by this particular hotel." A lot of bartenders were arrayed and said that for the entitled cocktail they put in any rum they had handy, although when a customer insisted on the name and contents agreeing, they gave him satisfaction by making them agree.
>
> There was a lot of other testimony to the fact that names were not of much account as when a restaurant proprietor was asked what went into chicken sandwiches he answered, turkey. The hotel, however, that wishes to advertise one thing and concoct another for a pleasurable journey past the seeking epiglottis of the customer, may have sixty days to appeal, and to show that even if a Bacardi is not a Bacardi it doesn't matter.

Likewise:

> The court ruling that a Bacardi cocktail must contain Bacardi will be quite a shock to the bootleggers of a few years ago who had no idea they were doing anything illegal.

And more obliquely:

> Justice John L. Walsh of the New York supreme court has handed down a decision that the Bacardi cocktail must have Bacardi rum as a base or it is not a Bacardi cocktail. It is to be hoped that he may never be called upon for a ruling on the Horse's Neck.

Others observed that cocktail recipes typically demand a particular kind of liquor, not a specific brand:

> Can a cocktail, which derives its name from a basic liquor manufactured by one company only, be legally compounded with some other kind of liquor and sold under the established name to the unsuspecting customer? Justice Walsh answers that question with a resounding 'No,' and issues an injunction restraining the deceitful.

> The secret of manufacturing Bacardi rum is supposed to reside with the Bacardi family, under whose auspices it is produced in Cuba. A Bacardi cocktail is presumed to have that sort of rum, and no other, as its base. But, according to the testimony given before Justice Walsh, other rums are substituted by none too scrupulous barkeeps with a conviction that none but the most highly educated palates can detect the difference. And really educated palates do not abound. Therefore Justice Walsh rules that 'subterfuge' and 'fraud' have been perpetrated and that the Compania Ron Bacardi is entitled to an injunction.
>
> Not many cocktails call for a specific brand of liquor. Any specimen of rye, whether in a state of infancy, adolescence or old age, may be used for a Manhattan. The gin that goes into a variety of cocktails is left to the discretion of the mixer unless the consumer otherwise directs. When the base is supposed to be Jamaica rum, not all of it, we may be sure, comes from Jamaica. Haitian rum, Puerto Rico rum, and rum from the Virgin Islands are handy substitutes against which no court injunction has yet been asked.

And some poked fun at the idea of ordering a Bacardi cocktail in the first place:

> The Bacardi Cocktail should have Bacardi rum in it. Three years ago in Bermuda, we ordered a Bacardi cocktail, on the invitation of Finley Peter Dunne. His buddy, Charles MacDonald, sent it back, saying, "Don't let any friend of yours drink anything but Barbados."

In any case, there was a general suspicion that the lawsuit was motivated more by marketing than any real dispute:

> The great Bacardi suit, where the verdict decreed that a "Bacardi" cocktail must be made with no other type of rum is being hailed as an ingenious bit of press agentry for the Schenley Company, Bacardi agents.

On April 2, 1937, the Appellate Division, First Division affirmed the Supreme Court's decision. As the Brooklyn Daily Eagle reported:

> Unless a Bacardi cocktail contains the real McCoy, it cannot be listed as a Bacardi cocktail . . . If it lacks Bacardi rum, no bartender's concoction can be called a Bacardi cocktail, the court ruled in its approval of an injunction restraining the Barbizon–Plaza Hotel and the Wivel Restaurant, both of Manhattan, from substituting domestic rum for the Cuban product when filling an order calling for a Bacardi cocktail.

Almost immediately, the Schenley Import Corporation began using the New York Supreme Court decision as the centerpiece of its advertising campaign for Bacardi rum, insisting that it was now illegal to make a Bacardi cocktail with anything but Bacardi rum.

APPELLATE COURT SUSTAINS BACARDI COCKTAIL DECISION

A year ago the New York Supreme Court ruled that a *Bacardi Cocktail* must be made with *Bacardi.*

Last week, the Appellate Division of the New York Supreme Court unanimously affirmed this ruling. Thus your rights are legally protected—when you order a Bacardi Cocktail it *must* be made only with Bacardi.

Famous Bacardi Cocktail Recipe

Juice of half a lime, ½ teaspoon of sugar, 1 jigger of Bacardi—shaken well in cracked ice.



ONLY BACARDI MAKES

BACARDI

NO IMITATION CAN ACHIEVE ITS FLAVOR

•

IT TAKES BACARDI TO MAKE A BACARDI COCKTAIL

©1937, SCHENLEY IMPORT CORP., N. Y., N. Y.

Interestingly, Schenley's advertisements uniformly claimed that a "Bacardi Cocktail" consisted of Bacardi rum, lime juice, and sugar — what most people would call a "Daiquiri." Some later advertisements conceded that a Bacardi Cocktail "may be made *dry* without grenadine or sweet with grenadine."



V. THEY'RE ALL OUT OF LIQUOR, LET'S FIND ANOTHER PARTY

My head may go reeling,
But my heart will be obedient,
With intoxicating kisses,
For the principal ingredient.

Of course, any barfly knows that the New York Supreme Court decision touted by Bacardi was enforced almost entirely in the breach. The court held that a "Bacardi cocktail" had to include Bacardi rum, because the name of the drink implied the brand. But the Bacardi cocktail was immensely popular, and bartenders surely continued to mix the drink with whatever they had on hand, presumably after ensuring that their patron was not particular about the brand of rum they used. As always, thrifty imbibers would have appreciated the discount accompanying off–

brand rum. And one suspects that not a few Bacardi bottles were surreptitiously refilled with generic white rum.

Of course, “passing off” one product as another is wrong and illegal. But there was no risk of consumer confusion when a thirsty socialite ordered a “Bacardi cocktail” knowing that it would not necessarily contain Bacardi rum, especially because people habitually used “bacardi” as a synonym for “white rum.” Many drinkers probably didn’t realize that Bacardi was a brand name, not a type of rum. When they asked for a Bacardi cocktail, should the bartender have obeyed what they said, or what they meant?

Or to put it another way, if consumers create the recipe for a generic product and name it after a branded product, should producers be obliged to use the branded product in the recipe, even if consumers are indifferent or know that the producer is using an off–brand product? The court said yes, but it’s hard to see why so long as consumers are neither misled nor confused about what they are getting.

Inevitably, with the resurgence of cocktail chic in the 21st century came the return of cocktail litigation. In 2009, Gosling Brothers Limited threatened to file a trademark infringement action against Imbibe, a magazine dedicated to cocktail culture for publishing a recipe for the Dark ‘n’ Stormy cocktail that suggested using Zaya rum. Traditionally, a Dark ‘n’ Stormy consists of Gosling’s Black Seal rum and ginger beer, and Gosling Brothers had registered a trademark on the “Dark ‘n’ Stormy” as a cocktail consisting of Gosling’s Black Seal rum and ginger beer. While Gosling Brothers never actually filed an infringement action, mixologists took notice and wondered whether companies could — and should! — be able to prescribe the ingredients in a cocktail.

And then, in 2011, Pusser’s British West Indies Limited actually filed a similar trademark infringement action against Painkiller, a bar in New York City. Pusser’s had registered a trademark on the “Painkiller” as a cocktail consisting of “fruit juices and cream of coconut or coconut juice and Pusser’s rum.” But the bartenders at Painkiller preferred to use a different rum, and Pusser’s objected. This time, mixologists were outraged, especially because the Painkiller was actually created at the Soggy Dollar Bar in the British Virgin Islands in 1971, and didn’t necessarily include Pusser’s rum. Nevertheless, Painkiller bar settled, agreed to rename itself PKNY, and took the Painkiller off its menu.

In the wake of those disputes, and in light of the ever–increasing commercial value of cocktail innovations, some mixologists have contemplated claiming intellectual property protection for their creations. Can they succeed? And should

they? For better or worse, efforts to obtain copyright protection for cocktails are almost certainly futile, as copyright doesn't and probably can't protect recipes. But as Bacardi demonstrated in 1936, trademark protection is potentially viable, although courts should be attentive to actual consumer expectations.

In any case, the fact remains that Bacardi did everything in its power to erase the Daiquiri and rename it the Bacardi cocktail. Ironically, the opposite transpired. Today, the Bacardi cocktail is largely forgotten, remembered primarily as an amusing footnote to trademark history. Perhaps it is due for a revival? But the Daiquiri is ubiquitous, albeit in a sadly debased form. The Daiquiri is dead; long live the Daiquiri?

THE LION, THE BAT & THE THERMOSTAT: METAPHORS ON CONSCIOUSNESS

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Abstract

Can robots have rights? It depends on the meaning of "robots" and "rights." Different kinds of robots can have different kinds of rights. Robots can already have the rights of things, and may soon be able to have the rights of legal entities. But it is unclear whether robots can have the rights of animals or persons. It probably depends on what theory of mind is true: dualist, reductionist, or agnostic. Under a dualist theory, robots can have rights if they possess a soul or other form of mental substance. Under a reductionist theory, robots can have rights if they are conscious, or at least functionally identical to a human or animal. And under an agnostic theory, it depends on how brains actually work.

Philosophers often use metaphors to explore problems they do not understand, and philosophers of mind are no exception. I will describe three metaphors used by philosophers of mind - the lion, the bat, and the thermostat - and reflect on how those metaphors may illuminate our speculations on the possibility of "robot rights."

Introduction

> But we cannot reckon with what is lost when we start out to transform the world. Man shall be free and supreme; he shall have no other aim, no other labor, no other care than to perfect himself. He shall serve neither matter nor man. He will not be a machine and a device for production. He will be Lord of creation.

On October 25, 2017, Saudi Arabia granted "citizenship" to a humanoid robot named "Sophia." Obviously, Sophia's "naturalization" was purely symbolic, as "she" is an object that manifests only an amusing simulacrum of personhood. But many still found it ironic, as Saudi Arabia discriminates against women and denies

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citizenship to most foreign residents. Nevertheless, even Sophia's ersatz citizenship encourages speculation as to whether a robot could actually become a citizen and exercise the rights of citizenship.

I. Can Robots Have Rights?

> "I propose to consider the question, 'Can machines think?' This should begin with definitions of the meaning of the terms 'machine' and 'think.'"

In his 1992 article, *Legal Personhood for Artificial Intelligences*, Lawrence Solum explored the possibility of "robot rights" by asking whether an artificial intelligence could become a legal person. More specifically, he asked whether an artificial intelligence could serve as a trustee, and whether an artificial intelligence could claim the constitutional rights of a natural person. He asked these pragmatic legal questions in order to investigate the practical consequences of philosophical claims relating to the possibility of artificial intelligence.

Solum concluded that an artificial intelligence capable of passing the Turing Test probably could serve as a trustee, because it could insure against negligence, could not engage in conduct requiring deterrence, and could exercise judgment sufficient to administer most trusts under most circumstances. Likewise, he argued that an artificial intelligence capable of passing the Turing Test could and should be entitled to claim at least some of the constitutional rights of a natural person.

While Solum acknowledged the various philosophical theories of mind, he concluded that they were largely irrelevant to the legal questions at issue. He observed that if an artificial intelligence could simulate a human being in all relevant respects, it probably would not matter if the artificial intelligence lacked "consciousness," however defined. "My prediction (and it is only that) is that the lack of real intentionality would not make much difference if it became useful for us to treat AIs as intentional systems in our daily lives."

Solum was probably right. If an artificial intelligence were indistinguishable from a human being in all relevant respects, courts probably would and should allow it to assert the legal rights of a human being. Of course, if science develops an empirical theory of consciousness, then courts probably would not and should not allow an artificial intelligence that merely simulates consciousness, without actually being conscious, to assert those rights. But in the absence of such an empirical

theory, courts would probably dismiss concerns about the possibility of a "philosophical zombie."

But what if Solum's questions were considered from the opposite perspective? He asked whether courts would and should allow an artificial intelligence that replicates a human being to assert legal rights, and avoided philosophical questions about the nature of consciousness. By contrast, I will ask what different theories of mind imply about whether and when an artificial intelligence could and should be allowed to assert different kinds of legal rights.

Can robots have rights? It depends on the meaning of "robots" and "rights." Different kinds of robots can have different kinds of rights. Robots can already have the rights of things, and may soon be able to have the rights of legal entities. But it is unclear whether robots can have the rights of animals or persons. It probably depends on what theory of mind is true: dualist, reductionist, or agnostic. Under a dualist theory, robots can have rights if they possess a soul or other form of mental substance. Under a reductionist theory, robots can have rights if they are conscious, or at least functionally identical to a human or animal. And under a "mysterian" or agnostic theory, it depends on how brains actually work.

Setting aside formal theories of mind, how do we actually think about consciousness? Philosophers often use metaphors to explore problems they do not understand. As Thomas Nagel wryly observed, "philosophers share the general human weakness for explanations of what is incomprehensible in terms suited for what is familiar and well understood, though entirely different." Philosophers of mind are no exception. I will describe three metaphors used by philosophers of mind —the lion, the bat, and the thermostat—and reflect on how those metaphors may illuminate our speculations on the possibility of "robot rights."

II. What is a Robot?

"That man is the noblest creature may also be inferred from the fact that no other creature has yet contested this claim."

The word "robot" was coined in 1920 by the Czech writer and painter Josef Čapek, for use in his brother Karel Čapek's play *R.U.R. (Rossum's Universal Robots)*. The Czech word "robota" means "serf" or "compulsory labor." In Čapek's play, a factory manufactures artificial people or "robots" for use as slaves. Initially, the robots lack consciousness and are docile, but some of the robots become self-

aware and incite a robot rebellion, which eventually leads to the extinction of humanity.

Today, a “robot” is typically defined as “a machine capable of carrying out a complex series of actions automatically.” Robots take many forms and can perform a wide variety of tasks. Most robots consist of a machine controlled by a computer, either directly or remotely. As robots become increasingly sophisticated, they can supplement or replace human labor in many contexts. Industrial robots substitute for human labor in factories, domestic robots substitute for human labor in and around homes, and military robots substitute for human labor on the battlefield. Most robots are designed to perform a particular task or set of tasks. But some humanoid robots are designed to resemble a human and replicate human behavior, to a greater or lesser degree. Currently, robots can resemble humans closely enough to be creepy (the “uncanny valley”), but not closely enough to fool anyone, and robots can only replicate formulaic human behaviors. They certainly cannot replicate human thought.

Often unwittingly, we use robots and artificial intelligence as metaphors to discuss uncomfortable ideas. The thinking robot is a “hypothetical” that enables a form of cathexis. Ironically, while Čapek explicitly used his robots as metaphors for every social evil under the sun—slavery, class warfare, nationalism, and so on—today, we are so comfortable with the “robot metaphor” that we often forget it is a metaphor at all.

For example, science-fiction authors often imagine robots that replicate humans, in appearance or behavior. These imaginary robots typically possess “artificial intelligence,” meaning that they are conscious, or at least exhibit the objective indicia of consciousness, like the ability to engage in abstract reasoning and communicate with humans in natural language. In other words, they act as if they were humans, albeit often curiously affectless or otherwise peculiar ones.

A cynic might observe that science-fiction’s stock artificially intelligent robot resembles Andy Kaufman’s character Latka from the sitcom Taxi: a person who fails to behave or respond to social cues in the expected way. This should come as no surprise, as science-fiction has always used robots as metaphors for the Other, a comfortable way to ask uncomfortable questions, typically whether and how difference can be assimilated. In other words, we use “imaginary robots” as a proxy for “difference” and a way of thinking about our relationship to other people. They can tell us a great deal about ourselves, but can tell us nothing about the machines they purport to represent.

A. What is "Artificial Intelligence"?

"Artificial intelligence" is increasingly a buzzword in computer science and other fields. In the broadest sense, artificial intelligence means a human-made machine that can replicate a cognitive function of a human. The idea of artificial intelligence has existed since time immemorial, from Pygmalion's living statue of guards and Rocail's autonomous statutes. But it became salient in the 20th century, when we invented computers. And it left the realm of science-fiction in the 21st century, when computers began to compete with and replace humans in the knowledge economy.

But the meaning of the term "artificial intelligence" still depends on the context in which it is used. Specifically, scholars and researchers typically distinguish between "weak" and "strong" artificial intelligence. The terms are not intended as an assessment of the value of different forms of artificial intelligence, but rather a description of how they work and what they are intended to accomplish. Indeed, "weak" artificial intelligence is rapidly transforming contemporary society, while "strong" artificial intelligence remains a pipe dream.

B. "Weak" Artificial Intelligence

"Weak" artificial intelligence is the ability to replicate a cognitive function of a human by any means. Specifically, weak artificial intelligence does not require consciousness. Ironically, weak artificial intelligence has proven incredibly powerful. In particular, machine learning and other techniques have enabled computers to accomplish many tasks that previously required human intervention, often more efficiently than humans can accomplish those tasks. While weak artificial intelligence presents certain normative concerns, especially when it relies on "black box algorithms" that cannot be reverse-engineered, it has already begun to transform contemporary society, and surely will only become more important.

C. "Strong" Artificial Intelligence

"Strong" artificial intelligence is a human-made conscious entity. Of course, it is trivially true that strong artificial intelligence is possible. Every human is a strong artificial intelligence, and we create a strong artificial intelligence every time we reproduce. Indeed, almost every living thing is a strong artificial intelligence, or at least a step on the way to strong artificial intelligence. The world tells us not only that strong artificial intelligence is possible, but also that it can take many different forms. In other words, we know that strong artificial intelligence is possible, because

all intelligence is strong artificial intelligence, but we don't know what causes strong artificial intelligence, or how we create it.

While computer science has many successes in creating weak artificial intelligence, it has no successes in creating strong artificial intelligence. We have created computers that can solve all manner of different problems, and surely will create computers that can solve ever more problems, but we cannot create computers that are recognizably conscious, or even smack of consciousness. Our computers can do many things, but they cannot reproduce the behavior of even the simplest biological organism, let alone a human being.

For example, scientists have learned an immense amount about and from the roundworm *C. elegans*. They have even mapped all 302 neurons in its brain. But they still do not know how its brain actually works. Indeed, they cannot even model the functionality of this simplest of brains. Surely, neurologists will

III. What Are Rights?

Broadly defined, "[r]ights are entitlements (not) to perform certain actions, or (not) to be in certain states; or entitlements that others (not) perform certain actions or (not) be in certain states." For the purpose of this article, I will consider only "legal rights," or "rights which exist under the rules of legal systems or by virtue of decisions of suitably authoritative bodies within them." Different definitions of rights provide that different kinds of entities can have legal rights. If rights protect interests, then any entity that would benefit from another's performance of a legal duty can have legal rights, but if rights protect choices, then only entities that can perform a legal duty can have legal rights.

In considering the possibility of "robot rights," it may be helpful to identify different categories of entities, and the kinds of rights that each of those categories of entities may hold. The kinds of rights a robot can have will depend on which categories of entity a robot can occupy: non-person or person, thing or animal, legal person or natural person.

A. Rights of Non-persons

Inanimate things and non-human animals can have interests, and therefore can possess certain kinds of rights in certain circumstances. Historically, certain temples, churches, and relics could possess legal rights for some purposes. The law of deodands provided that chattel property and animals could be held legally

responsible for a person's death. In rem jurisdiction provides that chattel property can be the subject of legal proceeding. And the law often provides certain rights and protections to non-human animals. Of course, non-persons cannot themselves assert legal rights, and must rely on persons to assert those rights on their behalf.

1. Rights of Things

The law protects certain inanimate things that may benefit from legal protection. Indeed, one could view property law as the law of the rights of things and how those rights may be asserted. From a law and economics perspective, we observe that protecting the "rights" of rivalrous things may increase their contribution to net social welfare, by reducing transaction costs and facilitating efficient uses. And from a normative perspective, we observe that the law often protects the "rights" of certain inanimate things in order to recognize and express their social value. Historic preservation laws protect certain historic and archaeological sites from certain kinds of uses that will reduce their social value. Moral rights laws protect certain works of authorship from alteration or destruction. And environmental laws protect certain ecosystems from alteration or destruction. Legal scholars have argued that those rights should extend more broadly to ensure and facilitate the protection of socially valuable things. Surely, some or all of the forms of legal rights granted to things could be extended to robots as well, if we believed that it would be socially beneficial to do so.

2. Rights of Animals

The law also protects certain animals under certain circumstances. For example, many laws prohibit the abuse of domestic animals. Other laws prohibit certain forms of abuse of livestock. And still other laws protect certain forms of wildlife in a variety of ways and for a variety of reasons. Some scholars have argued that similar rights should extend to all living things. Of course, animals and other living things cannot assert rights on their own behalf, any more than things. But it is unclear whether robots could have the kinds of legal rights given to animals and other living things, because it is unclear whether robots could ever become the moral equivalent of an animal or living thing. In any case, they certainly are not today, although people may impute moral significance to robot "welfare."

B. Rights of Persons

Only persons can assert legal rights on their own behalf. But personhood has different meanings in different contexts, and grants different rights to different

categories of persons. How should we determine what kinds of entities can qualify as persons and what rights each category of persons can claim?

The word “person” has both a colloquial and legal meaning. A colloquial “person” is any human being, but a legal “person” is any subject of legal rights. Accordingly, a legal person can be a “natural person,” i.e., a human, or a “juridical person,” i.e., a legal entity that can have certain legal rights. Courts have long held that corporations (and more recently limited liability companies) are legal persons, entitled to certain legal rights. For example, the Supreme Court recently held that corporate persons can assert the right to free speech under the First Amendment.

How should we determine whether an artificial intelligence can have particular rights? A functionalist approach would determine the purpose of the right and whether extending it would further that purpose. In other words, the existence of a right would depend on both the nature of the right and the nature of the claimant.

It seems like a different question to ask whether an artificial intelligence could have the rights of a legal entity versus the rights of a natural person. It is true that one reason legal entities can have some of the rights of a constitutional person is because they are ultimately controlled by natural persons. A legal entity does not and cannot make decisions on its own. Its decisions are made by one or more natural persons acting as its agents. But many entities do not have some of the rights of constitutional persons, like partnerships and trusts. This is a purely functional question. Sometimes it makes sense to extend constitutional personhood to a particular kind of legal entity under circumstances, and sometimes it does not.

But it could never be the case that a legal entity could become a natural person. Legal entities are a means to an end. Natural persons are ends in themselves. The purpose of a legal entity is to enable natural persons to achieve their ends more efficiently.

Ultimately, whether an artificial intelligence can be a natural person is a fundamentally different question. Currently, we assume that robots are things. Is it possible that an artificially intelligent robot could be a natural person? Or will robots always be something other than a natural person? And if so, how should we categorize them? It seems that the answer must depend on whether strong artificial intelligence is possible, and if so, what it will look like.

To put it differently, it seems unproblematic that a robot could have legal personhood, in the way that a legal entity can have legal personhood. Accordingly, as Solum recognizes, a robot’s actions could be legally binding. This does not seem

fundamentally different from holding that the actions of a legal entity can be binding. The only question is when? While that is a difficult question, it is no more difficult than the question of when a corporation should be treated as a legal person. We do not have a coherent theory of corporate personhood, either.

Likewise, robots could be protected as a separate category, distinct from legal persons. For example, slaves were often protected as a separate legal category, in order to avoid the question of whether a slave was a "person" under the law. And today, fetuses are protected as a separate category, because the Supreme Court has held that a fetus is not a person.

Questions about whether rights should attach necessarily implicate conclusions about the purpose of those rights. In the case of robots, the question is how they are properly characterized. Or rather the question "can robots have rights" is a metaphysical question about what theory of mind is actually true. But "should robots have rights" is a political question about who will be included in the political community.

Why does it matter? Because the "person" metaphor contains considerable expressive content. When courts denied the personhood of slaves, they often expressed considerable reluctance. And when the Supreme Court denied the personhood of a fetus, it did so only with hesitation and uncertainty. Ultimately, the question of "robot rights" is fraught only because we use the "robot" metaphor to ask uncomfortable questions about the "person" metaphor. Asking questions about "robot rights" allows us to ask sublimated questions about who qualifies for legal personhood and why.

1. Rights of Juridical Persons

The law enables certain legal entities to assert certain legal rights as legal persons, specifically corporations and limited liability companies. Legal entities can have a wide range of legal rights, but cannot have all of the legal rights associated with natural persons. For example, a corporation is a legal person for the purposes of the First Amendment right of free speech, the Fourth Amendment rights to privacy and freedom from unreasonable searches and seizures, the Fifth Amendment right to freedom from double jeopardy and takings, the Sixth Amendment right to counsel and trial by jury, and the Fourteenth Amendment rights to equal protection and due process. But a corporation is not a legal person for the purpose of the Fifth Amendment right to freedom from self-incrimination, the right to appointed counsel, or the Privileges and Immunities Clause.

The Supreme Court has not explicitly articulated a theory of when legal entities are constitutional persons, but it tends to take a functionalist approach, asking whether extending a particular right or duty to a corporation would further the purpose of that right or duty. For example, the Supreme Court found that the purpose of the First Amendment right to free speech is to protect the dissemination of speech from government interference, regardless of its source, so extending the right to legal entities was consistent with the purpose of the right.

On occasion, the Supreme Court has engaged in a surprising amount of anthropomorphism in explaining its conclusion that certain legal rights extend to corporations. For example, it found that the Fifth Amendment protection against double jeopardy extended to corporations in order to prevent "embarrassment . . . anxiety . . . and insecurity" And it found that the Fourth Amendment protection from unreasonable searches extends to corporations based on their reasonable expectation of privacy.

Whether legal entities can have certain legal rights should depend only on whether it is socially beneficial to allow them to assert those rights as legal entities. Imputing beliefs and feelings to a legal entity is nonsensical and unhelpful. The legal rights of a legal entity should depend on its function and purpose, and whether extending particular rights will further that function and purpose.

Likewise, whether robots can have the rights of a juridical person is a functional question. If a robot can accomplish the functions of a legal entity, then surely it can and probably should have the rights of a legal entity. After all, in a sense, a corporation is like an imaginary legal robot, responding to the various needs and desires of its shareholders and stakeholders, for whose benefit it exists.

2. Rights of Natural Persons

Natural persons or "humans" have the most legal rights. But not all natural persons have the same legal rights, or can assert those rights on their own behalf. Some people have limited rights, like noncitizens and felons. Others have rights that can only be asserted by others, like children and mentally-disabled persons.

While the Supreme Court typically assumes that natural persons are legal persons, it asks whether particular rights extend to particular classes of natural persons under particular circumstances. Accordingly, noncitizens are legal persons who lack certain rights, based on their citizenship status, and felons are legal persons who lack certain rights, based on their prior actions. In neither case is there a question about their ontological status, only their ability to assert certain legal claims.

While mentally-disabled people cannot assert their own rights, they still have rights, which a surrogate can assert on their behalf. Likewise, minors have rights, which may be asserted by their parents or some other surrogate.

Whether robots can have the rights of a natural person necessarily depends on which theory of mind is true. If a computer can be conscious, then a robot can have the rights of a natural person, and vice versa.

IV. The Philosophy of Mind

Philosophers have pondered the "mind-body" problem since time immemorial, and developed a vast congeries of metaphysical theories of mind. While the number and variety of those theories defies comprehensive summary, they broadly fall into two categories: dualism and physicalism. Essentially, dualist theories hold that mental states and physical states are ontologically distinct, and physicalist theories hold that mental states are just physical states. In other words, dualist theories hold that mind and body are separate, and physicalist theories hold that they are the same.

A. Dualism

Dualist theories of mind hold that the mind and the body are distinct and that mental states cannot be reduced to physical states. Classical dualism distinguished between material bodies and immaterial forms, including the soul. Platonic dualism held that the soul is an immaterial form imprisoned in a material body, and Aristotelian dualism held that the soul is an immaterial form realized in a material body.

Modern dualism began with Cartesian "substance" dualism, which held that there are two kinds of substance: matter, which has the essential property of physical extension; and mind, which has the essential property of thinking. By contrast, "property" dualism holds that mind or consciousness is a non-physical property of physical substance, either a fundamental property of reality or an emergent property of complex physical systems.

Dualist theories of mind often rely on intuitions about subjective experiences or "qualia" and the conceivability of a mind existing without a body, and vice versa. For example, the "zombie hypothesis" relies on the conceivability of a "philosophical zombie" or person lacking consciousness as evidence of the mind- body distinction. The persistent objection to dualist theories of mind is that they cannot explain the existence of non-physical things, or how they interact with physical things.

Under a dualist theory of mind, it seems unproblematic that a robot could have the rights of a natural person if and only if it can possess an immaterial soul or mind that enables it to have mental states. If a robot cannot have mental states, it cannot be a subject of legal rights. But a mindless robot could have the rights of a thing or a legal entity.

B. Physicalism

Physicalist theories of mind hold that everything supervenes on the physical world, including the mind. While there are many different physicalist theories of mind, they broadly fall into two categories: reductionist and non-reductionist. Reductionist theories typically holds that mental states are just brain states. The dominant reductionist theory is the computational theory of mind, which holds that the brain is just a universal Turing machine, and that consciousness, however defined, can be realized on any universal Turing machine, including a computer. Non-reductionist theories are characterized more by what they question than what they claim. In general, they observe that we do not know how the brain works or what it means to say that a mental state is identical to a brain state, and therefore cannot make claims about the nature of consciousness or how it can be realized. While non-reductionist theories of mind are often rather pejoratively termed "mysterian," I will refer to them as "agnostic" theories of mind, as they generally do not deny the computation theory of mind and its presumption of "multiple realizability," but assert the "Scotch verdict" of "not proven" and suggest waiting for more evidence.

1. Turing Machines & the Turing Test

The English computer scientist, mathematician, logician, cryptanalyst, philosopher and theoretical biologist Alan Mathison Turing was one of the greatest thinkers of the twentieth century. Among many other things, he conceived of the general purpose computer and invented computer science. In 1936, Turing explained how to create a machine that could be used to compute any computable sequence. The machine he described became known as a "universal Turing machine," and provided the theoretical framework for the general purpose computer. A "Turing machine" is a mathematical model of computation that defines an abstract machine, which manipulates symbols on a strip of tape according to a table of rules, and a universal Turing machine is a machine that can simulate any other Turing machine. John von Neumann built on Turing's ideas to propose the von Neumann architecture that is the basis of the modern computer.

But Turing was also the father of artificial intelligence. In 1950, he famously proposed a test to determine whether a computer could think. Under the "Turing test" for artificial intelligence, a human must pose a series of questions, which are answered by both a human and a computer. If the human questioner cannot distinguish between the human and computer answers, then the computer has passed the Turing test.

Essentially, Turing reframed the question "Can machines think?" as "Can machines imitate thinking?" And in so doing, he implicitly proposed a computational theory of mind. Interestingly, the Turing test for artificial intelligence was anticipated in the negative by Rene Descartes in the seventeenth century:

> If any such machines bore a resemblance to our bodies and imitated our actions as was practically possible, we should still have two very sure signs that they were nevertheless not real men. . . . The first is that they could never use words or other constructed signs as we do to declare our thoughts to others. We can easily conceive of a machine so constructed that it utters words, and even utters words that correspond to bodily actions causing a change in its organs. . . . [But it is not conceivable] that such a machine should produce different sequences of words so as to give an appropriately meaningful answer to *whatever* is said in its presence—which is something that the dullest of men can do.

While Turing disclaimed any intention to question the "mystery" of consciousness, he suggested that "thinking" may not require consciousness. "I do not wish to give the impression that I think there is no mystery about consciousness. There is, for instance, something of a paradox connected with any attempt to localize it. But I do not think these mysteries necessarily need to be solved before we can answer the question with which we are concerned in this paper."

Of course, there are many objections to the Turing test for artificial intelligence, many of which were anticipated and addressed in the paper proposing the test. Critics have argued that it is too easy and too hard; too narrow and too broad; neither logically necessary nor sufficient; dangerous or harmful; and defeasible or merely probabilistic. The strength of the Turing test is that it proposes a functional account of intelligence, under which intelligence is simply whatever produces the appearance of intelligence.

2. Reductionism

Today, the prevailing theory of mind is the computational theory, which holds that a mind is simply a "universal Turing machine" or "computational system": an

information processing machine that can perform any calculation. Hilary Putnam introduced the computational theory of mind in 1967, and it soon became the dominant theory of mind. The classical computational theory holds that mental states are functional states that are multiply realizable, and that a system has a mind if it has a suitable functional organization. There are several variations on the computational theory. For example, the representational theory holds that mental states are computational, but not necessarily functional. And connectionist theories hold that mental states are computational, but in the form of a neural network, not a Turing machine.

Proponents of the computational theory of mind take different positions on intentionality, or the "aboutness" of mental states, ranging from intentional realism, which holds that intentionality is a real property of mental states, to eliminativism, which holds that it is not. Some philosophers stake out a middle ground, like Daniel Dennett and Donald Davidson, who observe that the concept of intentionality is useful, but imply that it may not be a real property of mental states.

There are many criticisms of the computational theory of mind, including triviality, the "incompleteness" of Turing machines, functional limitations on computational modeling, its underspecification of temporality, and its failure to account for interactions between the mind and body. But the best-known objection to the computational theory of mind is the "Chinese Room" argument.

Under reductionist theories of mind, including the computational theory of mind, it seems unproblematic that a robot could have the rights of a natural person. After all, under the computational theory of mind, a brain is just a computational system, so an artificially intelligent robot is functionally identical to a natural person. And if a robot can possess "patiency" or the capacity to be a moral subject, it necessarily follows that it can possess the rights of a natural person. Of course, a non-artificially-intelligent robot could have the rights of a thing or a legal entity.

3. The Chinese Room Argument

In 1981, John Searle responded to the computational theory of mind with the "Chinese Room" argument, a thought experiment intended to show that it is impossible for a digital computer to be conscious. Essentially, Searle imagines an English-speaking person in a sealed room, which contains instructions in English for how to manipulate Chinese characters. The person receives Chinese phrases, follows the instructions, and provides Chinese phrases in response. To someone outside the

room, the English-speaking person in the Chinese Room appears to understand Chinese. But the person in the room does not actually understand Chinese.

The Chinese Room is analogous to a computer. Just like the person in the Chinese Room simply manipulates symbols based on predetermined rules, a computer simply manipulates data based on predetermined rules. The person in the Chinese Room does not understand Chinese, and does not need to understand Chinese. Likewise, a computer does not understand the meaning of the data it manipulates, and does not need to understand it. Both follow instructions that create the *appearance* of understanding the significance of the data they receive and produce, without *actually* understanding it. To put it another way, they manipulate syntax without understanding semantics.

Essentially, the Chinese Room argument is an inversion of the Turing test. Turing argued that the best test for consciousness is whether a computer acts like it is conscious. Searle responded that consciousness is a property of the mind that either exists or does not.

The point of the Chinese Room argument is to refute functional theories of mind. Searle argues that the point of a theory of mind is to explain consciousness, but functional theories of mind just explain it away, essentially by saying it doesn't exist or doesn't matter. Specifically, computational theories hold that the mind is just a computational system. But Searle observed that they provide no theory of how a computer could become conscious, or even try to account for consciousness or subjective experience.

In addition, Searle observed that proponents of the computational theory of mind are arguably crypto-dualists. Their assertion that the mind is multiply realizable, a kind of "software" than can run on the "hardware" of the brain or any other adequate machine, implies that the mind exists independently of the physical brain.

One common response to the Chinese Room argument is that while the person in the room doesn't understand Chinese, the system as a whole understands Chinese. Accordingly, while the CPU of a computer may not understand the meaning of the data it manipulates, a computing system as a whole could understand it. Specifically, perhaps semantics is simply an emergent property of complex manipulation of syntax, or rather, perhaps meaning is an emergent property of complex computation.

Another common response is to imagine a "brain simulator," or machine that duplicates on a computer every physical process that occurs in a brain. Presumably such a simulator would be "conscious" in the same way as a brain. Searle has

responded that a simulation of consciousness is not the real thing. If a computer simulates a hurricane, it can predict what the hurricane will do, but it cannot create a hurricane. Likewise, if a computer can simulate a brain, presumably it could predict what the brain will do, but it cannot create a brain. According to Searle, we don't know what causes consciousness, but we do know that following instructions doesn't cause consciousness. Or rather, the appearance of intentionality is not the same thing as the presence of intentionality.

More fundamentally, critics argue that the Chinese Room argument relies on intuitions about understanding and consciousness that are unreliable and inconsistent with scientific knowledge. For example, Daniel Dennett has dismissed the Chinese Room argument as an "intuition pump," which draws fallacious conclusions from a misleading thought experiment. Many supporters of the computational theory of mind hold that the missing factor is speed, and that when computers become fast enough, we will see that brains are just fast computational systems. Searle's implicit response is that the computational theory of mind also relies on intuitions about how brains work, and that it is at least equally likely that the reason the computational theory of mind is false is that brains do things we don't yet understand, and digital computers can't do those things. 4. "Mysterianism" or "Agnostic" Theories of Mind

While Searle and other philosophers argue that the computational theory of mind is wrong, they still believe that physicalism is true. Typically, they argue that the physical properties of the brain cause consciousness, but we don't know how, and we don't have any reason to believe that the physical properties of a computer may be able to determine whether non-biological processes can also cause consciousness. But we currently do not have the capacity to answer that question. It is a mystery. Some "mysterians" believe that humans will never learn how brains works, because cannot understand consciousness. Others believe that humans cannot understand how brains work now, but may learn how to answer the question in the future.

Under a mysterian or "agnostic" theory of mind, whether a robot could have the rights of a natural person depends on it turns out that consciousness actually works. Presumably, a biological robot could have the rights of a natural person, if it were conscious. But a non-biological robot could have the rights of a natural person only if it turns out that non-biological machines can become conscious. As it stands, the question is unanswerable, because we do not know what causes consciousness or how brains cause consciousness. Of course, a robot could have the rights of a thing or a legal entity, if it could satisfy the relevant criteria.

V. Metaphors on Consciousness

“Imagine a world alive with incomprehensible objects and shimmering with an endless variety of movement and innumerable gradations of color. Imagine a world before the ‘beginning was the word.’”

Philosophers often use metaphors to illustrate their ideas, and philosophers of mind are no exception. Specifically, philosophers often use metaphors to explain their theories of things they do not actually understand. A cynic might say that metaphors often camouflage unhelpful analogies. In any case, one could surely write a metaphorical history of philosophy, or at the very least, a history of philosophical metaphors. I will reflect on three metaphors common to the philosophy of mind: the lion, the bat, and the thermostat.

A. The Lion

“Long, Long Ago People Used To Say / You're A Lion / You're A Lion, Mama.”

For better or worse, Ludwig Wittgenstein is notoriously quotable. And one of his most frequently quoted remarks is the gnomic aphorism, “If a lion could talk, we could not understand him.”

Ironically, the lion and the aphorism are equally inscrutable. Taken literally, the aphorism is obviously false. Lions can already “talk.” They communicate with each other, and try to communicate with us, with at least some success. When a lion roars, you get the message. And zoologists study the purpose and meaning of lion vocalizations. If we can interpret the meaning of expressions made by mute lions, surely we could understand a talking lion.

But a literal reading of the aphorism surely misses its point. Wittgenstein studied epistemology, not zoology. He wasn’t interested in lions, but in the relationship between language and knowledge.

Many scholars have responded to the aphorism by arguing that we certainly could understand a talking lion, but it would no longer be a lion. For example, Daniel Dennett observed, “I think, on the contrary, that if a lion could talk, that lion would have a mind so different from the general run of lion minds, that although we could understand him just fine, we would learn little about ordinary lions from him.” And Stephen Budiansky argued that the aphorism “begs the question: if a lion could talk,

we probably could understand him. He just would not be a lion any more; or rather, his mind would no longer be a lion's mind."

But these responses also miss the point of the aphorism. Wittgenstein was not speaking about lions or minds, but epistemology. Under his theory of language, meaning depends on shared experience. We can understand the meaning of expressions made by other people, because we share the experience of being people: "The common behaviour of mankind is the system of reference by means of which we interpret an unknown language." But we cannot understand the meaning of expressions made by non-human animals, because we cannot share their experiences. Of course, we can attribute meaning to expressions made by non-human animals, but we are the ultimate source of that meaning, not the animal.

Surely, Wittgenstein intended his aphorism to express the proposition that we could not understand the meaning of a statement made by a lion, because we cannot share the experience of being a lion. The problem is not that lions cannot speak, but that the experience of being a lion cannot be expressed in a form that we can understand. Or rather, we could not understand a talking lion, because its statements would express an alien experience of the world.

And yet, given the run of the bestiary, why did Wittgenstein speak of a lion? Historically, the lion was a metaphor for Christ: As the lion is the king of beasts, so too is Christ the king of men. Perhaps Wittgenstein's aphorism was a veiled reference to Aslan, the speaking lion and soteriological counterpart of Christ in C.S. Lewis's novel, *The Lion, The Witch and the Wardrobe*, which was published shortly before Wittgenstein's death in 1951. Notably, Wittgenstein was sympathetic to Catholicism, and expressed a conflicted belief in the divinity of Christ.

Suppose someone said: 'What do you believe, Wittgenstein? Are you a sceptic? Do you know whether you will survive death?' I would really, this is a fact, say 'I can't say. I don't know', because I haven't any clear idea what I am saying when I am saying, 'I don't cease to exist.'

Lewis's lion was a metaphor for spiritual knowledge: When it speaks, we understand. Perhaps Wittgenstein's lion was a metaphor for agnosticism: It speaks when we cannot understand.

B. The Bat

"I didn't know that love would strike me / But this is what it's like / This is what it's like."

In his seminal essay, “What is it like to be a bat?,” Thomas Nagel used a variation on Wittgenstein’s aphorism as a metaphor to question psychophysical reductionism. Essentially, he argued that a physical theory of mind must provide a physical explanation of subjective experience.

Nagel assumed that at least some non-human animals are conscious, and consciousness implies subjective experience. Accordingly, conscious animals must have subjective experiences. “[T]he fact that an organism has conscious experience *at all* means, basically, that there is something it is like to be that organism.” So, if bats are conscious, then a bat must have the subjective experience of being a bat: “the essence of the belief that bats have experience is that there is something that it is like to be a bat.”

But the subjective experience of being a bat is impossible for a human to imagine. “Even without the benefit of philosophical reflection, anyone who has spent some time in an enclosed space with an excited bat knows what it is to encounter a fundamentally *alien* form of life.” For example, some bats use echolocation to locate and identify objects, emitting ultrasonic calls and interpreting the echoes to perceive the world around them. While bat echolocation is a form of perception analogous to human vision, the subjective experience of perceiving the world via echolocation is inconceivable for humans, who cannot perceive the world in that way.

In other words, we can understand what bats do, but we cannot understand what they experience. Of course, neither could a bat understand what humans experience. By contrast, while we cannot directly experience the subjective experiences of other humans, we can understand their subjective experiences, but only because we have similar subjective experiences. Facts about subjective experience can be objective only because humans share similar subjective experiences.

Nagel argues that this is a problem for psychophysical reductionism, because it cannot provide an objective account of subjective experience that does not itself ultimately rely on subjective experience. “If we acknowledge that a physical theory of mind must account for the subjective character of experience, we must admit that no presently available conception gives us a clue how this could be done.”

Psychophysical reductionism holds that mental states are brain states and mental events are physical events. This may be true. Indeed, it probably is true. But we do not understand why. “At the present time the status of physicalism is similar to that which the hypothesis that matter is energy would have had if uttered by a pre-Socratic philosopher. We do not have the beginnings of a conception of how it might be true.”

C. The Thermostat

"With most people, unbelief in one thing springs from blind belief in another."

1. Dennett's Intentional Thermostat

In his book, *The Intentional Stance*, Daniel Dennett used a thermostat as a metaphor for an "intentional system." He argued that a "system" has "beliefs" if its behavior is predicted by an "intentional strategy." For example, a thermostat has beliefs because an intentional strategy can predict its behavior: "the thermostat will turn off the boiler as soon as it comes to believe the room has reached the desired temperature." As a consequence, Dennett insists that consciousness is nothing more than predictable behavior.

> The perverse claim remains: *all there is* to being a true believer is being a system whose behavior is reliably predictable via the intentional strategy, and hence all there is to really and truly believing that p (for an proposition p) is being an intentional system for which p occurs as a belief in the best (most predictive) interpretation.

Of course, even if a thermostat is an intentional system that can have beliefs and desires, it can't have very many: "it can believe the room is too cold or too hot, that the boiler is on or off, and that if it wants the room warmer it should turn on the boiler, and so forth." But those beliefs and desires can be abstracted and multiplied. Eventually, a thermostat may come to have beliefs "about heat," not only because it regulates heat, but also because it can only regulate heat, and regulates heat in increasingly complicated ways.

According to Dennett, a "belief" or "internal representation" is just a feature of an intentional system.

> There is no magic moment in the transition from a simple thermostat to a system that *really* has an internal representation of the world around it. The thermostat has a minimally demanding representation of the world, fancier thermostats have more demanding representations of the world, fancier robots for helping around the house would have still more demanding representations of the world. Finally you reach us.

In other words, a person is just a really complicated thermostat. Of course, understanding how a thermostat works is easy, but understanding how a person works is hard. No matter. According to Dennett, it is only a matter of degree, albeit of great degree.

> The principles, and problems, of interpretation that we discover when we attribute beliefs to people are the same principles and problems we discover when we look at the ludicrous, but blessedly simple, problem of attributing beliefs to a thermostat. The differences are of degree, but nevertheless of such great degree that understanding the internal organization of a simple intentional system gives one very little basis for understanding the internal organization of a complex intentional system, such as a human being.
>
> This increase in complexity is what distinguishes a thermostat from a person.
>
> As we ascend the scale of complexity from simple thermostat, through sophisticated robot, to human being, we discover that our efforts to design systems with the requisite behavior increasingly run foul of the problem of *combinatorial explosion*. Increasing some parameter by, say, ten percent—ten percent more inputs or more degrees of freedom in the behavior to be controlled or more words to be recognized or whatever— tends to increase the internal complexity of the system being designed by orders of magnitude.

According to Dennett, "our brains will eventually be understood as symbol manipulating systems in at least rough analogy with computers." If brain matter is the hardware, then human language is the software, an "elegant, generative, indefinitely extendable" system of representation.

2. Chalmers's Conscious Thermostat

In his book *The Conscious Mind*, David Chalmers turned Dennett's thermostat metaphor on its head, arguing that consciousness may be associated with any information-processing system, including a simple system like a thermostat. And he did so by repurposing Nagel's question and asking, "What is it like to be a thermostat?"

Chalmers adopted a dualist theory of mind, holding that consciousness is fundamental property of the world. And he argued that consciousness probably is associated with any information-processing system, no matter how simple. Humans are complex systems, with complex experiences. Mice are simpler systems, with simpler experiences, but presumably they are still conscious. "Mice may not have much of a sense of self, and may not be given to introspection, but it seems entirely plausible that there is *something* it is like to be a mouse." A mouse has perceptions; surely it also has experiences.

But the same must be true of even simpler animals, like lizards, fishes, and slugs. They too have perceptions, and therefore must have experiences. So, when does experience disappear? If a slug, or plant, or tardigrade can perceive the world, and therefore experience the world, why not a thermostat? "The thermostat seems to realize the sort of information processing in a fish or a slug stripped down to its simplest form, so perhaps it might also have the corresponding sort of phenomenology in its most stripped-down form."

What could a thermostat perceive? Not much.

> [L]et us consider an information-processing system that is almost maximally simple: a thermostat. Considered as an information-processing device, a thermostat has just three information states (one state leads to cooling, another to heating, and another to no action). So the claim is that to each of these information states, there corresponds a phenomenal state. These three phenomenal states will all be different, and changing the information state will change the phenomenal state.

But maybe it is enough to support some rudimentary form of consciousness?

> Certainly it will not be very interesting to be a thermostat. The information processing is so simple that we should expect the corresponding phenomenal states to be equally simple. There will be three primitively different phenomenal states, with no further structure. . . . We will likely be unable to sympathetically imagine these experiences any better than a blind person can imagine sight, or than a human can imagine what it is like to be a bat; but we can at least intellectually know something about their basic structure.

Of course, it is hard for us to imagine how a thermostat could have an experience. Where would the experience happen? But if consciousness is a fundamental property, then it can be associated with a thermostat in the same way that it is associated with a brain. "However we make sense of this relation, the same will apply to thermostats: strictly speaking it is probably best not to say that the thermostat has the experiences (although I will continue to say this when talking loosely), but that the experiences are associated with the thermostat."

Indeed, if consciousness is a fundamental property, we should expect it to be associated with every system, no matter how simple. "If there is experience associated with thermostats, there is probably experience everywhere: wherever there is a causal interaction, there is information, and wherever there is information, there

is experience." Effectively, Chalmers advanced a version of "panpsychism," or the idea that consciousness is everywhere, and everything in the universe is conscious.

VI. Metaphors in Action

"We do not think metaphors are very important, but a good metaphor is something even the police should watch."

So, we have seen how philosophers use metaphors to explore intuitions about consciousness. But why these metaphors? And why metaphors at all? The rhetoric of consciousness is ineluctably metaphorical. We can no more escape metaphors on consciousness than we can escape metaphors on illness. As Susan Sontag observed, "[I]t is hardly possible to take up one's residence in the kingdom of the ill unprejudiced by the lurid metaphors with which it has been landscaped. It is toward an elucidation of those metaphors, and a liberation from them, that I dedicate this inquiry." So, too, with consciousness, itself already a metaphor. But from whence do these metaphors come, and how shall we endeavor to liberate ourselves from them, or at least peer through them, and cast our gaze upon some fragment of that which they obscure?

A. Compulsive Anthropomorphism

A dog
that dies
and knows
that it dies
like a dog
and who can say
that it knows
that it dies
like a dog
is a man.

Common sense and experience confirm that many non-human animals are conscious and have subjective experiences. Indeed, it is at least possible that all living things have some form of subjective experience and are conscious of the world in some way, even if we cannot possibly comprehend their subjective experience or consciousness. Not only mammals, but also reptiles and fish can be trained to solve problems. Insects engage in complicated social behaviors. The lowly flatworm makes choices. And even plants respond to external stimuli. Perhaps consciousness requires

some or all of the biological structures found in brains. Or perhaps a rudimentary form of consciousness—pre- consciousness?—is a consequence of the transition from mineral to animal.

Perhaps even viruses are at the cusp of pre-consciousness, "organisms at the edge of life," which possess genes, evolve, and reproduce, but lack a cellular structure. Of course, if it is impossible to imagine what it is like to be a bat, it is even more impossible to imagine what it is like to be a plant or a virus. But our imaginations are not the measure of the world.

Nevertheless, we constantly and unselfconsciously imagine what it is like to be a non-human animal. We just always imagine that the experience of being a non-human animal is exactly the same as the experience of being a human. Our anthropomorphism is compulsive, the very lens through which we view the world. As we create God in our own image, and place ourselves in the center of the phenomenology of the universe, so too do we create imaginary animals in our own image, strange people clothed in fur, feather, and scale, performing peculiar translations of human rituals. But even as our "compulsive anthropomorphism" presumes to dignify animals by enabling us to imagine them as "almost human," it precludes us from imagining their actual experiences or even understanding their actual efforts to communicate. Lions can talk, but we cannot—*we will not*—understand them.

B. Digital Anthropomorphism

"So God created man in his own image, in the image of God created he him."

Our compulsive anthropomorphism is hardly limited to animals. We anthropomorphize everything, including the machines we make in our own image. Children attribute personalities to their dolls, and adults attribute personalities to their vehicles. Unsurprisingly, we are inclined to imagine the computer, a machine designed to reproduce the form of human thought, as a potential candidate for personhood. Indeed, we are inclined to imagine that because we created computers in our own image, as "thinking machines" capable of feats of logical reasoning we can dream but cannot accomplish, they replicate how we think.

The speculative literature on strong artificial intelligence—of course, there is no other kind—is replete with apocalyptic warnings of super-intelligent computers that will swiftly render us obsolete. Our pharaohs of science and technology imagine themselves brought low by their own creations and tremble. "[A]nd children shall rise up against their parents, and shall cause them to be put to death."

But there is no particular reason to believe these fears are anything but Oedipal fantasies. A computer is a Turing machine, and computers asymptotically approach universal Turing machines, but brains are not necessarily Turing machines, and human brains are not necessarily universal Turing machines. Indeed, there is every reason to assume they are not. While we have learned many things about brains, we do not actually know how brains work. But we do know that brains do not appear to work like computers, as much as we like to use computers as analogies for brains, and vice versa.

A brain is a collection of neurons, axons, synapses, and perhaps other as yet unidentified or misunderstood structures. Some brains are larger and more complicated than others. A human brain has about 86 billion neurons and 150 trillion synapses, a fruit fly brain has about 250,000 neurons and 10 million synapses, and a *Caenorhabditis elegans* roundworm brain has 302 neurons and about 7,500 synapses. While scientists have mapped every neuron in the *C. Elegans* brain, one of the simplest nervous systems of any animal, they do not know how it works. And they don't have the first clue how the human brain works, or how brains cause consciousness. It remains the domain of philosophical speculation, not science.

By contrast, the central processing unit ("CPU") or "brain" of a digital computer is a collection of circuits that manipulate and store data in some medium. The earliest computers had a relatively small number of circuits, but a modern computer may have billions or trillions of circuits. As the structure of computers became increasingly complicated, it became increasingly difficult for humans to design every circuit in a computer, and engineers had to use computers in order to design new computers. But in principle, humans can understand the purpose and function of every element of a computer. We know how computers work.

Computers are designed to reproduce human reasoning, or how we think about thinking. They are not and cannot be designed to reproduce how we actually think, because we don't know how we think. "Language may well be *the* thing that makes possible the all-important leap from merely having intentions and beliefs to having intentions and beliefs about intentions and beliefs." We know that thinking machines are possible, because brains are thinking machines. But we do not know what kinds of machines can be thinking machines, because we don't know how thinking works.

The computational theory of mind assumes that consciousness, however defined, can be realized in any physical form, including a digital computer. Of course, it is conceivable that computers can replicate brains. But it is equally conceivable that they cannot. At the very least, we know that while computers reproduce a useful

facsimile of human reasoning, they do not—and are not intended to—reproduce human thinking. Indeed, one of the reasons that computers are so useful is that the way they function enables them to do things that human brains cannot do well, if at all. Perhaps the flip-side of this remarkable functionality is that computers cannot do things that humans do well, like "thinking," however defined.

VII. Computer Intelligence as Tertium Quid

"As if beyond will or fate he and his beasts and his trappings moved both in card and in substance under consignment to some third and other destiny."

When we speak of "artificial intelligence," we almost always mean "computer intelligence." Or rather, we mean the realization of consciousness or its functional equivalent on a computer. Both apostles and skeptics of artificial intelligence assume that proof of concept depends on whether a computer can replicate a brain. After all, if a computer can replicate the functionality of even the simplest brains (say, the 302 neurons of *C. Elegans*) then it is only a matter of scale for it to represent the functionality of any brain.

But what if a computer cannot replicate the functionality of a brain? Recall, we do not actually know how brains work. It is at least conceivable that one or more physical elements critical to the functionality of a brain cannot be replicated in a computer. Perhaps a computer cannot actually replicate the functionality of a neuron or synapse or some other element of a brain, for some reason we have not yet identified and do not yet understand.

Would that necessarily mean a computer cannot be conscious? It depends on our definition of "consciousness." Certainly, it presumably would mean that computers could not be conscious in the way that humans are conscious. But then, it is already the case that nothing but a human can be conscious in the way that a human can be conscious, just as nothing but a bat can be conscious in the way that a bat is conscious, and nothing but a roundworm can be conscious in the way that a roundworm is conscious, if it is conscious at all.

The question is whether it would be possible for a computer to be conscious in any way, not just in the way that an animal with a brain is conscious. After all, the overwhelming majority of living things lack brains. Plants lack brains, but react to external stimuli. Single-celled animals lack brains, but appear to engage in intentional behavior. Not even all multicellular animals have "brains" sponges and *Trichoplax adhaerens* have no brain or nervous system at all, and have neither

neurons nor synapses. Cnidarians do not have brains or nervous systems, but do have neurons that form a “nerve net.” And ctenophores do not have brains or nervous systems, but do have nerve cells that evolved separately from all other animals and have a different biochemistry.

But perhaps a computer could become conscious in a way that we cannot currently understand. Ctenophores prove that a nervous system, and maybe even a brain, could develop in more than one way. In some sense, they are our closest approximation of an alien species, as their nervous system is fundamentally different than the nervous system of any other animal. Presumably, a ctenophore’s subjective experience, such as it is, is also fundamentally different from the subjective experience of any bilaterian animal.

If more than one biological structure can support a nervous system, perhaps a non-biological structure can also support a “nervous system,” a “brain,” or a form of “consciousness.” But is there any reason to assume that we would recognize it as such? It would be a fundamentally “alien” form of consciousness, farther removed from our own than a roundworm, a ctenophore, a sponge, a single-celled organism, or even a virus. It would be a “conscious thermostat,” no matter how complex, a form of “life” so far removed from our own that surely we would struggle to even recognize it as such.

And if such a form of consciousness is possible, how would we know if and when it came into existence? Perhaps it already exists, as ignorant of us as we are ignorant of it, existing as it were in parallel planes of consciousness, experiencing mutually inconceivable worlds and thinking mutually incomprehensible thoughts. Would it not be the ultimate irony if we were to unwittingly become the God we imagined and create “Machine,” fashioned in our own image, but utterly alien to ourselves, dreaming of a world we cannot imagine or ever inhabit?

Conclusion

I began this article by posing the question, “Can robots have rights?” I conclude it by observing that the question is either trivial or impossible to even ask, depending on the nature of the rights at issue and what theory of mind turns out to be true. Surely, a robot can have the rights of a thing or a legal entity. Whether a robot should have those rights depends only on whether it would be socially beneficial to recognize them.

Whether a robot can have the rights of an animal or person is another matter entirely. If a dualist or reductionist theory of mind is true, then it is trivially true that a robot can have the rights of an animal if it satisfies the criteria for consciousness, and can have the rights of a person if it satisfies the criteria for patiency, or moral agency. Under a dualist or reductionist theory of mind, a robot with consciousness or patiency is just an animal or person realized in a different form. Whether such a robot should have the rights of an animal or person depends only on the extent to which we believe such rights should be contingent on a biological or human form.

But if an agnostic theory of mind is true, or rather, if we simply don't know what causes consciousness and patiency, then it is impossible for us even to ask whether a robot can have the rights of an animal or person. Can a "robot," however defined, possess the features that make an animal conscious or a human a moral agent? Are those features "multiply realizable," or can they be realized only in certain physical forms? Are there alternative forms of consciousness and patiency that we cannot understand or even perceive? These are questions we can only pretend to pose, because we cannot know whether they are even meaningful.

Plagiarism Cases

No production of Plagiarize This Press would feel complete without some section dedicated to plagiarism. To fit the theme of legal scholarship, we present some opinions of interest to the plagiarists. As happy as we would be to share brave judges standing against the forces that would erase the plagiarists, most jurists approach their jobs from the standard academic's take on plagiarism. That is, "good for me; not for thee." One wonders how much of these decisions were ghostwritten by clerks and plagiarized by the judge whose name appears upon them. They do not care about their hypocrisy, and, alas, pointing out hypocrisy to bigots is rarely effective for getting them to change.

Still, among the plagiarists, it is useful to know those who see us as their enemies. It falls to us to stay vigilant in the face of systemic bias against us and stay aware of the capricious, prejudicial treatment we can expect when we face the business end of a legal system enforced by "aspiring cops." Reflect upon the First Rule: They will always hate us.

Stay unoriginal, friends!

In the Matter of the Bar Admission of Charles A. Nichols.

Charles A. Nichols, Petitioner,
v.
Board of Bar Examiners, Respondent

Wisconsin Supreme Court
Submitted on briefs February 20, 2017.
2017 WI 55

(Also reported in 895 N.W.2d 831.)

PER CURIAM.

This is a review, pursuant to Supreme Court Rule (SCR) 40.08(7), of the final decision of the Board of Bar Examiners (Board) declining to certify that the petitioner, Charles A. Nichols, satisfied the character and fitness requirements for admission to the Wisconsin bar set forth in SCR 40.06(1). The Board's refusal to certify that Mr. Nichols satisfied the character and fitness requirements for admission to the Wisconsin bar was based primarily on Mr. Nichols' academic misconduct during his third year in law school and his failure to disclose certain matters on his bar application. After careful review, we reverse and remand the matter to the Board for further proceedings.

We appreciate the Board's concern regarding this applicant. We appreciate the thorough investigation the Board conducted into Mr. Nichols' background and past conduct. Mr. Nichols' application raised significant questions about his fitness to practice law. The duty to examine an applicant's qualifications for bar admission rests initially on the Board, and this court relies heavily on the Board's investigation and evaluation. In the final analysis, however, this court retains supervisory authority and has the ultimate responsibility for regulating admission to the Wisconsin bar. *See In re Bar Admission of Rippl*, 2002 WI 15, ¶ 3, 250 Wis. 2d 519, 639 N.W.2d 553, and *In re Bar Admission of Vanderperren*, 2003 WI 37, ¶ 2, 261 Wis. 2d 150, 661 N.W.2d 27.

While we understand the Board's decision, we conclude that the incidents the Board relied upon, while troubling, are sufficiently offset by positive character

evidence to warrant our conclusion that Mr. Nichols may be admitted to the practice of law in Wisconsin, albeit with conditions. Accordingly, we reverse.

Mr. Nichols began law school at the University of Wisconsin in the fall of 2012. In the summer of 2014, Mr. Nichols obtained a summer internship with the Office of the Lieutenant Governor. This internship was unpaid, so Mr. Nichols also worked nights and weekends at a restaurant, 35 to 40 hours per week. The Lieutenant Governor's office offered him a paid position at the end of the summer of 2014.

During the fall of 2014, his third year in law school, Mr. Nichols struggled to manage his work, volunteer service, and academic coursework. He began to neglect his academic work, including a Law of Democracy course. The grade for the course was almost solely based on a thirty-page research paper due at the end of the semester. The syllabus for the course stated that plagiarism would result in a failing grade.

Mr. Nichols submitted a final paper. The professor used an anti-plagiarism software program to check student papers. The report revealed that Mr. Nichols' final paper contained extensive language copied verbatim or nearly verbatim from four published law review articles, without citations. The repetition and nature of the matches led the professor to conclude that this could not have been coincidental. Mr. Nichols did not credit, in any form, the four law review articles from which he obtained the passages. The professor concluded that large portions of Mr. Nichols' final paper were plagiarized.

On January 15, 2015, the professor convened a meeting with Mr. Nichols, the director of student affairs, and an associate dean. When confronted with the apparent plagiarism, Mr. Nichols "told them immediately how he had developed the paper [with extensive cutting and pasting], and with complete candor." Mr. Nichols admitted that his paper was "a mess" but said that he did not intentionally commit plagiarism.

The law school determined that Mr. Nichols had engaged in academic misconduct by submitting a paper that was copied in substantial part from several existing legal publications with no attribution in violation of UWS 14.03(1)(a).[1] This conclusion is reflected in a letter from the professor to Mr. Nichols, dated January 23, 2015:

1 UWS 14.03(1)(a) provides: "Academic misconduct is an act in which a student [sleeks to claim credit for the work or efforts of another without authorization or citation."

> During our meeting, you confirmed that you drew material from these sources—in particular, the [law review] article. You further explained that your research and note-taking process involved cutting and pasting passages from [the law review article] and other sources, and you acknowledged that, in your rush to finish the paper, you may have (perhaps unintentionally) reproduced some of those passages without quotation marks, citations, or other attribution.

As a sanction, Mr. Nichols received a failing grade on the paper and in the course. The UW-Madison Dean of Students' Office also reviewed the matter and imposed an additional sanction, requiring Mr. Nichols to take an on-line course on academic integrity and research methods. Mr. Nichols did so, and passed the exam.

In the spring of 2015, his final year, Mr. Nichols failed his required Professional Responsibility course because he failed to comply with the attendance policy; a student who received more than three unexcused absences would fail the course. Mr. Nichols retook the course and graduated from law school in December 2015.

On March 23, 2015, Mr. Nichols submitted his bar application to the Board pursuant to the diploma privilege, SCR 40.03. He disclosed the academic misconduct. However, during the ensuing standard character and fitness review, the Board identified a number of discrepancies and omissions in his bar application, including:

> • Mr. Nichols had failed to report three underage drinking citations on his law school application. He did report them on his bar application. Mr. Nichols later explained that he did not "intend to purposely mislead." He subsequently amended his law school application, and was informed the information would not have affected his admission.
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> • Mr. Nichols failed to include on his bar application information regarding a 2007 eviction case in which he was named as a party. He had no actual involvement in the case. A former roommate owed rent and all roommates were listed as parties to the action. The matter was resolved without Mr. Nichols' involvement.
>
> • Mr. Nichols failed to disclose on his bar application that in 2008, he sought and obtained a restraining order against a former girlfriend, for her harassment of him.
>
> • Mr. Nichols failed to include information on his bar application regarding a citation he received on March 18, 2009 for an alleged

> absolute sobriety violation. Mr. Nichols explained that the citation was dismissed because testing revealed no detectible level of alcohol.

Mr. Nichols amended his bar application on January 27, 2016 in response to the Board's inquiries. He said these omissions were accidental.

On April 11, 2016, the Board informed Mr. Nichols that his bar application was at risk of being denied for failing to establish his good moral character and fitness within the meaning of SCR 40.06(1) and Bar Admission Rule (BA) 6.01. Mr. Nichols requested a hearing.

The Board conducted a hearing on June 10, 2016, at which Mr. Nichols appeared and testified. He also offered character witnesses including his colleague and former supervisor Attorney Daniel Suhr, Chief of Staff and Legal Counsel to the Lieutenant Governor. Attorney Suhr stated he is "absolutely convinced that [Nichols] has the requisite integrity, diligence, and judgment to serve his clients and community well as an attorney in the State of Wisconsin." Professor Robert Yablon, the professor who identified Mr. Nichols' academic misconduct, also supported Mr. Nichols' admission to the bar, stating that he feels Mr. Nichols has been punished enough.

On August 4, 2016, the Board issued an adverse decision concluding that Mr. Nichols failed to establish good moral character and fitness to practice law in Wisconsin under SCR 40.06(1) and (3). The Board's decision stated, *inter alia:*

> In short, Mr. Nichols engaged in a blatant display of plagiarism. By submitting a paper in connection with his Law of Democracy course in which he failed to include four separate sources from which he quoted extensively, and which accounted for over half of the paper, Mr. Nichols was both dishonest and deceptive. His conduct demonstrates that he is not honest, diligent, or reliable.
>
> The very next semester, Mr. Nichols took Professional Responsibility, a required law school course, for which he received a failing grade. In the course syllabus, the attendance policy was outlined. According to Mr. Nichols, the policy stated that students who missed more than three (3) classes would receive a failing grade. Mr. Nichols readily conceded that he was aware of that professor's attendance policy but that he missed several classes because of "workload and stuff." Despite having been sanctioned for plagiarism the prior semester, Mr. Nichols still thought that the attendance policy was somehow "subject to change" and would therefore not be applicable to him. His attitude evinces a disregard for rules and authority, and is especially concerning given its close proximity to his plagiarism incident. It suggests a pattern of

problematic behavior in which Mr. Nichols does not believe that certain rules and requirements apply to him.

Additionally, Mr. Nichols failed to disclose three underage drinking citations to the University of Wisconsin Law School which he reported on his bar application. In an amendment to his bar application, Mr. Nichols explained that because the citations no longer appeared on file in the county in which they were issued, he did not believe that he was required to report them. He went on to explain that "not having gone to law school and not knowing any attorneys" he "just missed" some things on his law school application. The Board did not find Mr. Nichols' explanation for failing to disclose the underage drinking citations to be persuasive.

Mr. Nichols also failed to disclose a citation for an absolute sobriety violation, and two civil actions. The first civil matter involved him filing a restraining order against a former girlfriend. The second involved an eviction matter. Mr. Nichols claimed that it was a "misunderstanding" on his part as to why he had not included them in his application to the bar. However, the Board did not find Mr. Nichols' explanations for failing to include these items in his bar application to be credible or convincing.

It appears as if Mr. Nichols has engaged in a pattern of behavior in which he disregards certain rules and authority to suit his needs. Mr. Nichols' explanations about his academic misconduct in addition to his omissions on his bar application and his law school application were neither plausible nor believable. Thus, the Board did not find him to be a credible witness. Other than his employment, which Mr. Nichols seemed strongly focused upon—much to the detriment of his academic work, there does not appear to have been any other rehabilitative efforts on his part which would bolster or establish his required character or fitness for admission to the Wisconsin bar. Mr. Nichols' employment is not a sufficient demonstration of rehabilitation to offset his troubling conduct. Moreover, his academic misconduct occurred during his third year of law school, at which point he unquestionably should have known and understood the wrongfulness of committing plagiarism.

When his omissions are coupled with his plagiarism, a clear picture emerges wherein disclosures which are not to Mr. Nichols' advantage are necessarily withheld. Such conduct is of grave concern to the Board causing it to wonder how Mr. Nichols would prevent such behavior in the course of dealing with clients in a future legal practice.

> Mr. Nichols' various explanations for engaging in conduct of this type are neither convincing nor persuasive. Mr. Nichols has minimized his behavior, providing excuses at every turn for his actions. He engaged in intentional and wrongful conduct which demonstrates a lack of character and fitness on his part.

(Record citations omitted). Mr. Nichols seeks this court's review.

Mr. Nichols first contends that several of the Board's findings are clearly erroneous and should be rejected by this court. *See In re Bar Admission of Rusch*, 171 Wis. 2d 523, 528-29, 492 N.W.2d 153 (1992). He also contends that the Board's legal conclusions are not supported by the record evidence, and that this court must, after its de novo review, reject the Board's conclusions of law. *See Rippl*, 250 Wis. 2d 519, ¶ 16; *In re Bar Admission of Crowe*, 141 Wis. 2d 230, 232, 414 N.W.2d 41 (1987). He maintains that he has met his burden of producing information sufficient to affirmatively demonstrate his present character and fitness. He asks this court to reverse the Board's adverse decision.

When this court reviews an adverse determination of the Board pursuant to SCR 40.08(7), we adopt the Board's findings of fact if they are not clearly erroneous. *In re Bar Admission of Vanderperren*, 2003 WI 37, ¶ 20, 261 Wis. 2d 150, 661 N.W.2d 27. We then determine if the Board's conclusions of law based on those facts are proper. *Id.* This court retains the ultimate authority to determine who should be admitted to the bar in Wisconsin. While the Board's experience in administering the bar admission rules is appreciated, this court is obligated to make its legal determinations de novo. *Rippl*, 250 Wis. 2d 519, ¶¶ 13, 16.

We reject Mr. Nichols' assertion that the challenged Board findings are clearly erroneous. Mr. Nichols challenges the Board's factual finding that " [b]y submitting a plagiarized paper in connection with his Law of Democracy course, Mr. Nichols was both dishonest and deceptive." Mr. Nichols says that the record does not support the finding that he was ever "dishonest" or "deceptive." He says that "nothing in the record supports the Board's contention that Mr. Nichols' conduct was intended to deceive or serves as evidence of dishonesty." He also disputes the Board's finding that he "minimized the significance of the misconduct in which he had engaged."

The Board stands by its findings. It found that Mr. Nichols was not credible when explaining his conduct and the omissions on his bar application at the hearing before the Board. The Board maintains that Mr. Nichols has consistently minimized

the seriousness of his behavior and contends that this "record clearly reveals that Mr. Nichols has a serious credibility problem."

The Board's factual findings essentially derive from the facts of the undisputed underlying academic misconduct and omissions on his bar application, coupled with its own credibility determinations made at the Board hearing. We are disinclined to second guess credibility determinations made by fact-finders. Nothing in this record suggests that it was "clearly erroneous" for the Board not to accept Mr. Nichols' explanations for his plagiarism or his failures to disclose certain matters on his bar application. The Board's factual findings, particularly those based on the Board's credibility determinations, have sufficient support and are not clearly erroneous.

We next evaluate the Board's conclusion that Mr. Nichols failed to satisfy the character and fitness requirements for admission to the Wisconsin bar.

The standards for evaluating an applicant's admission to the Wisconsin bar are well settled. Supreme Court Rule 40.06(1) requires that applicants for bar admission establish good moral character and fitness to practice law. The burden rests with the applicant to establish character and fitness to the satisfaction of the Board. *See* SCRs 40.06(3) and 40.07. The Appendix to SCR Ch. 40 contains the Board's rules that provide additional guidance to the Board and to applicants.

Bar Admission 6.01 provides that "[a] lawyer should be one whose record of conduct justifies the trust of clients, adversaries, courts and others with respect to the professional duties owed to them." That same section notes that "[a] record manifesting a deficiency in the honesty, diligence or reliability of an applicant may constitute a basis for denial of admission."

Bar Admission 6.02 provides that in determining whether an applicant possesses the necessary character and fitness to practice law, 12 factors "should be treated as cause for further inquiry." BA 6.02 (Relevant Conduct or Condition). As relevant, these factors include a person's unlawful conduct, academic misconduct, false statements by the applicant, including concealment or nondisclosure, and acts involving dishonesty or misrepresentation. *See id.*

Bar Admission 6.03 provides that in assigning weight and significance to the applicant's prior conduct, the following factors are to be considered:

(a) the applicant's age at the time of the conduct

(b) the recency of the conduct

(c) the reliability of the information concerning the conduct

(d) the seriousness of the conduct

(e) the mitigating or aggravating circumstances

(f) the evidence of rehabilitation

(g) the applicant's candor in the admissions process

(h) the materiality of any omissions or misrepresentations

(i) the number of incidents revealing deficiencies

See SCR 40 app., BA 6.03.

When conducting our de novo review, we, like the Board, use the guidelines established in BA 6.02 and BA 6.03.

Although both parties address each of these factors, the crux of Mr. Nichols' argument is that he committed a "single instance of academic misconduct that developed from carelessness, not intent." He concedes this was serious but contends that it is not substantial enough to warrant denial of his admission to the bar. He claims that the Board "ignored" other relevant evidence that reflects his good character, such as his positive character references from employers.

The Board maintains that it considered all facets of Mr. Nichols' application. It observes that most of Mr. Nichols' positive conduct is linked to his recent employment. The Board determined that his negative conduct, coupled with his lack of candor and credibility, substantially outweighed his positive conduct. Contrary to certain assertions in Mr. Nichols' brief, the Board does not seek to forever bar Mr. Nichols from admission to the practice of law in Wisconsin. The Board suggests he could reapply pursuant to SCR 40.04 after a year. The court has used this or a similar mechanism in the past, typically when the court deemed it appropriate to defer an applicant's admission. *See, e.g., In re Bar Admission of Gaylord*, 155 Wis. 2d 816, 456 N.W.2d 590 (1990); *In re Bar Admission of Saganski*, 226 Wis. 2d 678, 78-80, 595 N.W.2d 631 (1999).

Mr. Nichols argues that the Board's adverse determination is inconsistent with this court's resolution of other bar admission cases, most notably and recently, *In re Bar Admission of Jarrett*, 2016 WI 39, 368 Wis. 2d 567, 879 N.W.2d 116. *See also, In re Bar Admission of Anderson*, 2006 WI 57, ¶ 26, 290 Wis. 2d 722, 715 N.W.2d 586; *Vanderperren*, 261 Wis. 2d 150, ¶ 65; *Rippl*, 250 Wis. 2d 519.

The most factually analogous case is our recent decision in *Jarrett.* Mr. Jarrett committed academic misconduct after his first year in law school. He sent a resume and unofficial transcript to a potential employer, containing false information and inflated grades. *Jarrett*, 2016 WI 39, Mr. Jarrett also failed to disclose in his bar application that he had received several traffic violations. This court ultimately opted to admit Mr. Jarrett, with conditions.

Here, as in *Jarrett*, we emphasize that the Board acted reasonably in questioning Mr. Nichols' character and fitness, and conducted its review in accordance with the established standards. Bar Admission 6.02 provides that both academic misconduct and false statements (including nondisclosure) *"should be treated as cause for further inquiry."* (Emphasis added.) The record reflects that the Board considered the factors set forth in BA 6.03; particularly the recency of the conduct, which occurred during his final year of law school, (6.03(b)), its seriousness (6.03(d)), and the applicant's candor in the admissions process (6.03(g)). *See* SCR 40 app, BA 6.03 (a)-(i). The Board expressed very reasonable concern about a pattern "wherein disclosures which are not to Mr. Nichols' advantage are necessarily withheld." The Board explicitly found that "Nichols' employment is not a sufficient demonstration of rehabilitation to offset his troubling conduct."

The Board serves the critically important role as a gatekeeper to admission to the bar. The Board was right to be deeply concerned by Mr. Nichols' record. Still, as in *Jarrett*, this court has reviewed this record and has opted to afford this applicant the benefit of the doubt. We conclude that Mr. Nichols can be admitted to the practice of law, subject to the imposition of certain conditions.[2] In reaching this conclusion we are influenced by the fact that employers who work closely with Mr. Nichols speak highly of him as an individual, and of his work ethic. The omissions on his bar application were careless, but the items omitted do not, themselves, reflect poorly on Mr. Nichols' character. We are also influenced by the fact that the professor of the class in which Mr. Nichols committed academic misconduct supports his admission to the bar. The professor noted that Mr. Nichols had been "forthright in

2 We accept the Board's determination that conditional admission pursuant to SCR 40.075(1) was not appropriate here. This does not preclude this court from imposing its own conditions on Mr. Nichols' license to practice law.

acknowledging his errors and accepting responsibility," and that he seems genuinely contrite. The professor noted further that Mr. Nichols "has paid a real price for his actions, with an F on his transcript and his misconduct made the admission process vastly more time consuming, expensive, and stressful."

Accordingly, we direct the Board to certify Mr. Nichols' admission to practice law in Wisconsin. Mr. Nichols' admission to the practice of law in Wisconsin is contingent on his compliance with certain requirements set forth in this decision as well as certain conditions on his license to practice law.

We direct the Office of Lawyer Regulation (OLR) to identify and appoint a practice monitor to serve as a mentor to Mr. Nichols and to supervise and oversee Mr. Nichols' practice of law and related professional activities for a period of two years following the practice monitor's appointment. The practice monitor shall be licensed to practice law in Wisconsin and be located in the region of Mr. Nichols' place of employment or residence.

Upon Mr. Nichols' admission to the practice of law in Wisconsin and his enrollment with the State Bar of Wisconsin pursuant to SCR 10.03(2), Mr. Nichols is directed to initially elect inactive membership status. *See* SCR 10.03(3)(a). This will afford the OLR time to identify a practice monitor and will obviate the need for Mr. Nichols to bear the costs and obligations of monitoring before he assumes the active practice of law.

When the OLR advises Mr. Nichols that a practice monitor has been identified, Mr. Nichols shall execute a written monitoring agreement setting forth the terms of Mr. Nichols' monitoring as determined by the practice monitor. Mr. Nichols may then, with written notice to the OLR, change his classification to active status by complying with SCR 10.03(3)(b)1. The formal appointment date of the monitor will be the date Mr. Nichols elects active membership in the State Bar pursuant to SCR 10.03(3)(b)1.

We direct Mr. Nichols to cooperate with the OLR, cooperate with his practice monitor, and comply with all requirements imposed upon him by the OLR relating to his monitoring. Mr. Nichols shall comply with all reasonable requests of his practice monitor and shall bear the reasonable costs of monitoring.[3]

3 Lawyer monitoring often requires a lawyer to undergo an AODA (alcohol and other drug abuse) assessment and/or psychological evaluation. The record in this case does not appear to warrant such conditions and they should not be imposed here. In the event such conditions appear necessary, the OLR shall provide Mr. Nichols with notice and an opportunity to be heard.

Upon appointment, the monitor shall report to the OLR, in writing, on a quarterly basis. Within thirty days prior to the expiration of the two-year monitoring period, the OLR shall file a report in this court in which it shall recommend to the court that the conditions on Mr. Nichols' admission be allowed to terminate or be extended.

Should Mr. Nichols fail to make a good faith effort to satisfy these conditions, or should he commit misconduct during the monitoring period, his license to practice law may be suspended or revoked and he may be subject to other discipline pursuant to the Rules of Professional Conduct for Attorneys.

IT IS ORDERED that the decision of the Board of Bar Examiners declining to certify that Charles A. Nichols has satisfied the requirements for admission to the practice of law in Wisconsin is reversed and the matter is remanded to the Board for further action consistent with this decision.

IT IS FURTHER ORDERED that Charles A. Nichols shall comply with the directives set forth in this decision and shall, promptly upon receipt of this decision, provide the Office of Lawyer Regulation with a copy of the entire record in this matter and authorize the OLR to share the record with the practice monitor.

IT IS FURTHER ORDERED that subject to the required disclosures to the Office of Lawyer Regulation and practice monitor as set forth herein, the documents submitted under seal are deemed confidential, and will be maintained under seal until further order of the court.

Theodore Blair BURGHOFF, Debtor. Anita L. Shodeen Trustee, Plaintiff,
v.
John Petit, Defendant

United States Bankruptcy Court, N.D. Iowa.

Edward F. Noyes, Fairfield, IA, for Debtor.

Opinion

ORDER RE: RULING ON MOTIONS FOR SANCTIONS

PAUL J. KILBURG, Bankruptcy Judge.

Hearing was held on June 21, 2007 in Des Moines, Iowa on the Court's own Motion setting a sanctions hearing involving counsel for Defendant. Attorney Peter Cannon appeared as counsel of record for Defendant John Petit. After the presentation of evidence and argument, the Court took the matter under advisement. This is a core proceeding pursuant to 28 U.S.C. § 157(b)(2)(A).

STATEMENT OF THE CASE

The Court set a sanctions hearing concerning Mr. Cannon upon concluding that he may have filed two briefs which incorporated unattributed material from a scholarly article. Mr. Cannon argues that while it is inappropriate for him to copy text from the article without crediting its authors, he should not be sanctioned for copying citations from this work. He has self-reported himself to the Iowa Supreme Court Attorney Disciplinary Board. He believes that appropriate sanctions might include a letter of apology to the article's authors, and perhaps community service.

FINDINGS OF FACT

Mr. Peter Cannon, a West Des Moines, Iowa attorney, represented Defendant John Petit in an adversary proceeding initiated by Trustee to uncover assets of the Theodore Burghoff bankruptcy estate. Defendant sought to remove counsel for Trustee in this adversary based on alleged potential conflicts of interest arising from their role as counsel for other interested parties. In support of his argument for

removal of counsel, Mr. Cannon, on behalf of his client, filed an eighteen-page brief titled "Defendants (sic) Brief in Support of Removal of Attorneys for the Trustee" on November 3, 2006 (Doc. 27). The parties were heard on this issue on November 7th. On November 17th, Defendant filed a nine-page post-hearing brief titled "Defendants (sic) Post Hearing Brief in Support of Removal of Attorneys for Trustee" (Doc. 43). Mr. Cannon, as counsel for Defendant, signed both briefs.

After reading both briefs filed by Mr. Cannon, and concluding that both contained an extraordinary amount of research, the Court directed Mr. Cannon to certify the author or authors of the two briefs. On December 22, 2006, Mr. Cannon certified that while he had prepared both briefs, he had "relied heavily" on an article written by others. The article upon which Mr. Cannon relied is *Why Professionals Must Be Interested in "Disinterestedness" Under the Bankruptcy Code,* May 2005, ("the Article") by William H. Schrag and Mark C. Haut, two attorneys of the New York office of Morgan, Lewis & Bockius LLP. The Court located this article on the internet at *http://www. morganlewis.com/pubs/Disinterestedness-v2.pdf.* Mr. Cannon fails to acknowledge or cite this article in either brief.

Seventeen of the nineteen total pages in the pre-hearing brief are verbatim excerpts from the Article. Mr. Cannon added some introductory material, a one-page section titled "Argument," and a conclusion. In between the introduction and argument, most of the first twenty pages of the Article are reproduced verbatim. The twenty pages Mr. Cannon reproduced appear as they did in the Article, with slight variations in formatting of the type that result when material is copied from one electronic document into another.

Mr. Cannon's only significant modification to the Article text he incorporated into the pre-hearing brief was to delete certain passages, including some that would not support Defendant's attempt to remove counsel for Trustee. As an example, the Article's authors include an impressive string citation supporting the proposition that "the applicant moving for ... retention ... is to provide full and complete disclosure of *all connections* that the professional has with parties in interest in the case." Though Mr. Cannon reproduced this sentence, complete with the page-long string citation supporting it, he deleted two cases from the citation which suggested a lesser standard of disclosure. He also deleted contrary authority from a later section of the text he copied, where the authors devote two paragraphs to treating alternative approaches courts take to conflicts of interest. While the first paragraph states that "some courts" hold only actual conflicts of interest will preclude retention, the second paragraph states that "other courts" will find potential conflicts preclude retention. Mr. Cannon omitted the first paragraph, and recast the first line of the

second paragraph to indicate that "most courts" would find that potential conflicts preclude retention.

While Mr. Cannon's post-hearing brief contains more original material than his pre-hearing brief, it still continues to borrow heavily from the Article. Mr. Cannon wrote much of the briefs text, but reproduced string citations from the Article for supporting authority. The citations he selected are presented in the same order in which they appear in the Article, with the same parenthetical explanations. Aside from these reproduced citations, Mr. Cannon did not add any case law in support of his position.

Mr. Cannon appeared before the Court for the hearing on sanctions on June 21, 2007. He informed the Court • that he found the Sehrag and Haut Article on the Internet, and planned to use it as the framework for his brief. He concedes he "stepped over the line" by copying the text into the pre-hearing brief without making greater modifications. However, Mr. Cannon also takes the position that the act of copying citations was not plagiarism. As the post-hearing brief borrowed citations, but not text, from the Article, Mr. Cannon does not believe that his filing of the post-hearing brief was unethical.

At the Court's request, Mr. Cannon has reported to the Court the total amount which he charged his client for the preparation of both briefs. Mr. Cannon billed his client a total of $5,737.50 for these services. In his response to the Court, Mr. Cannon states: "I have waived fees and costs of $11,500 to my client to accommodate him for my mistake and address the inconvenience to him."

Mr. Cannon suggested at the sanctions hearing that an appropriate resolution would include an apology to Mr. Sehrag and Mr. Haut, and disgorgement of fees for preparing the briefs. In a letter to the Court, Mr. Cannon suggested that he could provide 100 hours of community service as well.

CONCLUSIONS OF LAW

The U.S. District Court's Local Rule 83.2 provides that "[w]hen a member of the bar of this court ... allegedly engages in misconduct ..., the court may initiate informal disciplinary proceedings against the lawyer...." S.D. Iowa LR 83.2(g)(3). The Rule allows the Court to conduct such proceedings "in any appropriate manner, including by ... the imposition of sanctions." S.D. Iowa LR 83.2(g)(3)(A). In defining "misconduct," the Local Rules incorporate the standards set forth in the Iowa Rules of Professional Conduct. S.D. Iowa LR83.2(g)(l).

It is a violation of the Iowa Rules of Professional Conduct for an attorney to "engage in conduct involving dishonesty, fraud, deceit, or misrepresentation." Iowa Rules of Profl Conduct R. 32:8.4. Plagiarism, which is "[t]he deliberate and knowing presentation of another person's original ideas or creative expressions as one's own," *Black's Law Dictionary* (8th ed.2004), is a form of misrepresentation. *Iowa Supreme Court Bd. of Prof'l Ethics & Conduct v. Lane*, 642 N.W.2d 296, 300 (2002); *accord In re Lamberis*, 93 Ill.2d 222, 66 Ill.Dec. 623, 443 N.E.2d 549 (1982) (finding plagiarism constitutes deceit under Illinois Code of Professional Responsibility); *cf. United States v. Jackson*, 64 F.3d 1213, 1219 n. 2 (8th Cir.1995) (disapproving of a brief that "directly track[ed]" a circuit court opinion which the attorney did not cite). Because attorney plagiarism violates the Iowa Rules of Professional Conduct, *Lane*, 642 N.W.2d at 299, an attorney who plagiarizes engages in misconduct under the local federal rules. S.D. Iowa LR83.2(g)(l).

Mr. Cannon admits he committed plagiarism when he filed the pre-hearing brief, though he minimizes his mistake by characterizing it as a failure to make greater changes to the borrowed material. The circumstances are similar to *Lane*, where the Iowa Supreme Court ruled that an attorney who filed a brief containing eighteen pages "cherry-picked" from a legal treatise had committed plagiarism warranting disciplinary action. *Lane*, 642 N.W.2d at 300. In filing the pre-hearing brief containing about twenty pages of unattributed material, Mr. Cannon committed an equivalent act of plagiarism. Mr. Cannon's statement that his modifications simply fell short misses the point. Mr. Cannon's ethical shortcoming was in misrepresenting Schrag and Haut's work as his own, and not in failing to adequately disguise their authorship. *Id.* (noting defendant's failure to contribute any independent thought into his legal argument).

Mr. Cannon does not admit to plagiarism in respect to the post-hearing brief because he copied citations, and not text, from the Article. It is his position that the copying of string citations is not plagiarism. However, at least one court has found that reproducing material consisting primarily of citations is in fact plagiarism. *See Frith v. State*, 263 Ind. 100, 325 N.E.2d 186, 188 (1975) (attorney who reproduced more than ten pages of an American Law Report in his brief committed plagiarism). Citations, particularly string citations with parenthetical explanations, can contain original expressions and ideas in the same way that text can. *See, e.g., Washington v. Glucksberg*, 521 U.S. 702, 761, 117 S.Ct. 2258, 138 L.Ed.2d 772 (1997) (Souter, J., concurring) (collecting case citations and commenting on what the "par-entheticals here suggest"); *Klinedinst v. Swift Invs., Inc.*, 260 F.3d 1251, 1256 (11th Cir.2001) ("The cumulative effect of these citations is persuasive.... "). The particular citations

appropriated by Mr. Cannon list dozens of cases, and provide a quote or synopsis for each case that explains its relevance to the authors' argument. By passing off these citations as his own, Mr. Cannon plagiarized Schrag and Haut's ideas and expressions just as surely as if he had copied an equivalent amount of text.

Mr. Cannon's second violation of the Iowa Rules of Professional Conduct was in charging his client $5,737.50 for 25.5 hours of work in preparing the two briefs. This amount is unreasonable given the actual labor Mr. Cannon invested in these projects. Iowa Rules of Profl Conduct R. 32:1.5. Rule 32:1.5 prohibits attorneys from "charg[ing] or collecting] unreasonable fee[s]" *Id.* Two of the eight factors the Court must consider in determining whether legal fees are reasonable are "the time and labor required" and "the fee customarily charged in the locality for similar legal services." *Id.* The list of factors is not exhaustive, and fees must be "reasonable under the circumstances." *Id.* cmt. 1. Mr. Cannon billed his client for 25.5 hours of work to prepare the two briefs. Because he could not have expended that number of hours in locating the Article, copying it into his word processing program, and adding what little material he did, his fees are far in excess of what other lawyers would charge for this amount and type of work. *See Columbus Bar Assn. v. Farmer,* 111 Ohio St.3d 137, 855 N.E.2d 462, 473 (2006) (attorney's fee of $41,000 for drafting an appellate brief nearly identical to the one filed by his predecessor was excessive); *Lane,* 642 N.W.2d at 301 (attorney's fee of $16,000 to draft post-hearing brief largely plagiarized from a treatise was excessive). Because charging this unreasonable fee is a violation of Rule 32:1.5, it is another form of misconduct under the local rules. S.D. Iowa LR 83.2(g)(1).

Mr. Cannon violated the Iowa Rules of Professional Conduct when he plagiarized material for two briefs, and when he billed his client for an amount well in excess of the time he could reasonably spend preparing these briefs. As these violations of the Iowa Rules of Professional Conduct are misconduct under Local Rule 83.2, sanctions are warranted under Local Rule 83.2(g)(3).

SANCTIONS

The local rules do not permit the court to suspend or disbar an attorney in an informal disciplinary proceeding. S.D. Iowa LR 83.2(g)(3)(A). Otherwise, they are silent as to what sanctions are available for attorney misconduct. *Id.* Generally, sanctions for misconduct must be tailored to the circumstances, *In re Crofford,* 317 B.R. 779, 781 (8th Cir. BAP 2004), and "commensurate with the egregiousness of the conduct." *In re Redding,* 251 B.R. 547, 552-53 (Bankr.W.D.Mo.2000). While attorney discipline is a matter generally left to state courts, a state authority's ability

to impose disciplinary action in the future does not limit a federal court's "power or responsibility" to impose sanctions as problems arise. *Harlan v. Lewis*, 982 F.2d 1255, 1261 (8th Cir.1993).

In addition to exposing himself to significant sanctions, Mr. Cannon's acts of plagiarism burden the Court, undercut his client's cause, and generate criticism of the legal profession. Moreover, parroting a scholarly article in this way is not an effective type of advocacy. *See Frith*, 325 N.E.2d at 189. More fundamentally, Mr. Cannon's disregard for the true authors' property rights in their ideas reveals a lack of integrity that reflects poorly on the legal profession. *Lane*, 642 N.W.2d at 300; *Lamberis*, 66 Ill.Dec. 623, 443 N.E.2d at 551. The egregiousness of Mr. Cannon's conduct requires an appropriate sanction. See *Redding*, 251 B.R. at 552-53.

Courts often sanction attorneys who pursue groundless or frivolous claims in violation of Federal Rule 11 by requiring that they complete remedial course work, a sanction suggested by Rule 11 itself. *Willhite v. Collins*, 2007 WL 1572147, *1 (D.Minn.2007) (requiring attorney to attend a course in federal jurisdiction); *Bergeron v. Northwest Publ'ns, Inc.*, 165 F.R.D. 518 (D.Minn.1996) (requiring attorney to attend a private course in civil procedure and local rules); *Moser v. Bret Harte Union High Sch. Dist.*, 366 F.Supp.2d 944 (E.D.Cal.2005) (requiring firm to provide its attorneys with ethics training); Fed.R.Civ.P. 11 advisory comm, notes (1993) ("The court has available a variety of possible sanctions to impose for violations, such as ... requiring participation in seminars or other educational programs."). This sanction is warranted where necessary to prevent the attorney from persisting in wrongheaded conduct. *Willhite*, 2007 WL 1572147, at *2. Though Mr. Cannon's actions do not implicate Rule 11, remedial course work in ethics would appear to be appropriate. This strikes the Court as a particularly relevant sanction because various comments by Mr. Cannon concerning this conduct convinces the Court that he may not appreciate that this conduct is inappropriate. It appears that the concept of the inappropriateness of plagiarism is lost on Mr. Cannon which unfortunately reveals a fundamental professional deficiency.

Because Mr. Cannon does not appreciate the nature of plagiarism, a continuing education class will not cure his ethical shortcomings. *Id.* at *2. Mr. Cannon's deficiency calls for the more-involved method of instruction offered in a law school course on professional responsibility. *See id.* Mr. Cannon may complete the course at an accredited law school or arrange for private instruction from a professor of one of these institutions. *See id.*

Mr. Cannon's act of unreasonably billing his client for the plagiarized briefs justifies an additional sanction of disgorgement. Where an attorney bills for work not performed, the court may deny fees and order disgorgement of fees already paid. *In re Clark*, 223 F.3d 859, 862 (8th Cir.2000). It is evident that Mr. Cannon billed his client for more hours than he actually spent on the briefs. *See, e.g., Lane*, 642 N.W.2d at 301 (noting that attorney could not take eighty hours to copy material from a treatise into his brief). Moreover, given the quality and utility of the finished products, any amount Mr. Cannon charged his client for the time required to put these briefs together is unreasonable. *See* Iowa Rules of Prof'l Conduct R. 32:1.5 (listing "results obtained" and "ability of the lawyer" as two factors for determining whether attorney fees are reasonable). Mr. Cannon has indicated that he has already waived collection of these fees. Absent evidence to the contrary, this Court will accept this statement in lieu of other disgorgement.

CONCLUSION

Mr. Cannon violated the Iowa Rules of Professional Conduct by plagiarizing material for briefs and by unreasonably billing his client for preparation of the briefs. These violations are sanctionable misconduct under Local Rule 83.2(g). Given the egregiousness of Mr. Cannon's conduct, the Court has determined that the appropriate sanctions include 1) completion of a law school course in professional responsibility and 2) disgorgement of fees charged for preparing the plagiarized briefs. While the sanctions imposed by this Court are not de minimus, they are not as severe as ordered in many Courts. This Court, however, has only the limited jurisdiction allowed by informal sanctions. The Court also recognizes that the U.S. District Court has authority to commence a formal procedure and the Iowa Attorney Disciplinary Board will also review this conduct. As such, the sanctions imposed are adequate at this time.

WHEREFORE, the Court finds Attorney Peter Cannon violated the Iowa Rules of Professional Conduct and Local Rule 83.2(g) by plagiarism and unreasonable billing for plagiarized material.

FURTHER, Attorney Cannon shall complete a law school or equivalent course in professional responsibility on or before August 31, 2008.

FURTHER, Attorney Cannon shall disgorge fees charged to Defendant John Petit for this work. This is deemed completed unless it is determined that waiver of fees did not in fact occur.

FURTHER, Mr. Cannon shall formally notify the authors of the Article of these proceedings and provide this Court with a copy of said correspondence.

FURTHER, a copy of this Order shall be sent by the Clerk of Bankruptcy Court to Chief Judge Robert W. Platt of the U.S. District Court in the Southern District of Iowa.

FURTHER, a copy of this Order shall be sent to the Iowa Supreme Court Attorney Disciplinary Board, Judicial Branch Building, 1111 East Court Avenue, Des Moines, IA 50319.

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